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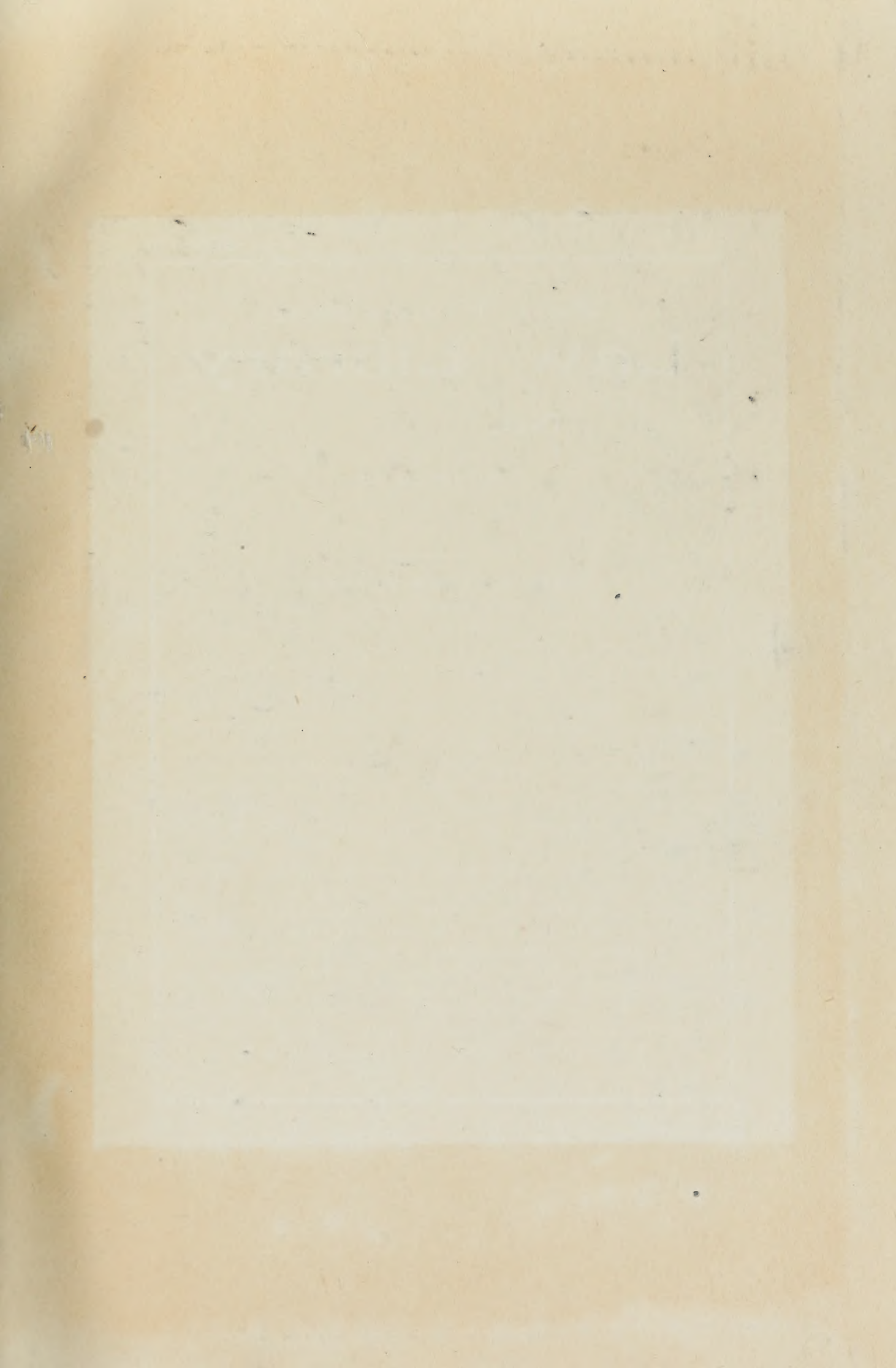
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No. 1899

IN THE

United States Circuit Court
of Appeals

FOR THE NINTH CIRCUIT

CATHERINE D. STEAD ET AL.,
Complainants and Appellants,

VS.

ISABELLA M. CURTIS ET AL.,
Defendants and Appellees.

THE APPELLANTS' BRIEF

IN SUPPORT OF THEIR MOTION TO VACATE THE JUDG-
MENT AND THE ORDER DENYING THEIR
PETITION FOR REHEARING

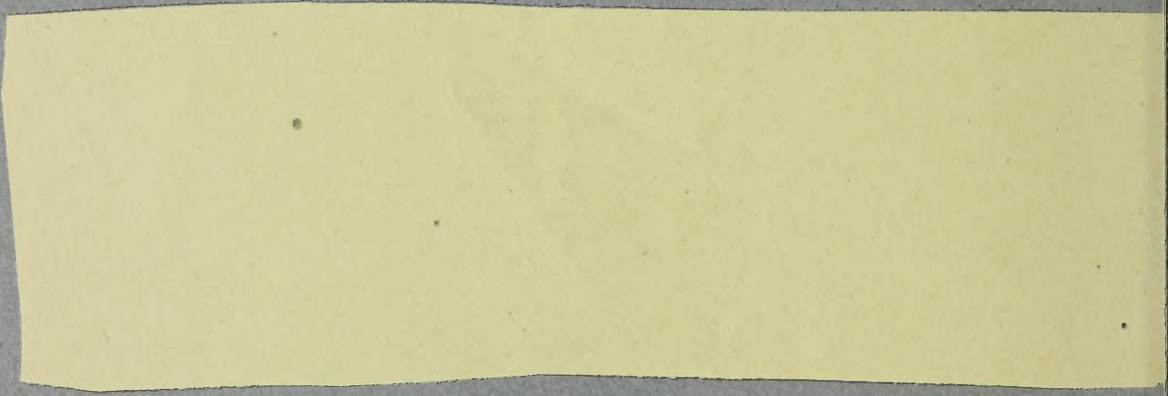
APPENDIX

SHOWING THE MOTION AND NOTICE OF HEARING.

FILED

AUG 27 1912

HORACE W. PHILBROOK,
Solicitor for Appellants.



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SHOWING THE MOTION AND NOTICE OF HEARING.

No. 1899

IN THE

**United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT**

CATHERINE D. STEAD, HORACE W.
PHILBROOK as Administrator with the
Will Annexed of the Estate of Joseph P.
Wilson, Deceased, SERENA K. WILSON,
ELIZABETH A. BURGAN and FRANK-
LIN S. BURGAN as Her Husband, ELL-
WOOD J. WILSON, MARTHA E. DOW-
ELL and GEORGE W. DOWELL as Her
Husband, and JOSEPH P. WILSON, JR.,
Complainants and Appellants,

vs.

ISABELLA M. CURTIS and JOHN M.
CURTIS as Her Husband, ELIZABETH
M. MUIR MUGAN and WILLIAM G.
MUGAN as Her Husband, JOHN M. CUR-
TIS, WILLIAM G. MUGAN, THE
JACOB Z. DAVIS ESTATE COM-
PANY, JEAN MCGREGOR BOYD, JEAN
MCGREGOR BOYD as Trustee of the Trust
Estate Created by Herself and Alexander
Boyd, Deceased, GEORGE DAVIS BOYD,
HENRY ST. CLAIR BOYD, EDWARD
W. HOPKINS, JOHN F. BOYD, THE
ROSENBLATT COMPANY, E. MARTIN
& CO., MAURICE ROSENTHAL, THE
REGENTS OF THE UNIVERSITY OF
CALIFORNIA, and THE BOARD OF
TRUSTEES OF THE LELAND STAN-
FORD JUNIOR UNIVERSITY,
Defendants and Appellees.

THE APPELLANTS' BRIEF

IN SUPPORT OF THEIR MOTION TO VACATE THE JUDGMENT AND THE ORDER DENYING THEIR PETITION FOR REHEARING.

THE MOTION STATED

§ 1. The appellants are respectfully applying by motion for relief as follows: That the herein designated order and also the herein designated judgment of this Court in this cause, made and entered at the present term of this Court, and against the appellants and in favor of the appellees, be vacated and set aside, to-wit: the order made and entered on December 4, 1911, denying the petition of the appellants for a rehearing, and the judgment made and entered on October 2, 1911, declaring the decree appealed from to be affirmed.

§ 2. The said motion and its grounds, and the notice of the hearing thereof, are in writing and have been duly filed, and for further convenience, as shown at the end hereof, in an Appendix.

POINTS INVOLVED

§ 3. Obviously, the following points are involved, arising in the order here stated, viz.: 1. The lawful power of the Court to grant the said relief; and 2. On such power existing, the Court's legal duty to grant the said relief. We therefore show both those points, and in the above order.

FIRST

I

THE COURT'S LAWFUL POWER TO GRANT THE SAID
RELIEF

§ 4. Both the judgment and the order which the appellants respectfully ask to have vacated and set aside, were made and entered at the present term of the Court; and the following is an elementary rule of law which has been long settled, viz.:

§ 5. During the entire term of the Court at which they were made or entered, all judgments, decrees and orders of the Court "are in the breast of the Court," are only *coming into being (in fieri)*, are absolutely subject to the Court's control; and at any time during such term the Court has full and unquestionable power to vacate and set aside, either of its own motion, or on petition or motion of an injured party, any such judgment, decree, or order. The following are some of the numerous authorities by which this point has been long settled:

Bronson v. Schulten, 104 U. S. 410;
Goddard v. Ordway, 101 U. S. 745;
Henderson v. Carbondale &c. Co., 140 U. S. 26, 40;
Ex parte Lange, 18 Wall. (U. S.) 163;
Doss v. Tyack, 14 How. (U. S.) 297, 313;
Timmons v. Garrison, 4 Humph. (Tenn.) 148, 150;
Railroad Company v. Elder, 149 Ill. 174;
Niles v. Parks, 49 Ohio St. 370;
Clendenning v. Conrad, 91 Va. 410, 418;
Townshend v. Chew, 31 Md. 247;
Preston v. McCann, 77 Md. 30, 33;

Bradley v. Slater, 58 Neb. 555;
Bradley v. Slater, 55 Neb. 336;
Rich v. Thornton, 69 Ala. 473;
Underwood v. Sledge, 27 Ark. 295;
Moore v. Taylor, 1 Ida. 635;
Gwinn v. Parker, 119 N. Car. 19;
Halyburton v. Carson, 80 N. Car. 16;
Faircloth v. Isler, 76 N. Car. 49, 51;
Ashby v. Glasgow, 7 Mo. 320;
Hesse v. Seyp, 88 Mo. App. 67, 72;
Woodward v. Woodward, 84 Mo. App. 330.

For examples:

In *Bronson v. Schulten*, 104 U. S. 410, 415, the Court say:

“It is a general rule of the law that all the judgments, decrees, or other orders of the courts, however conclusive in their character, are under the control of the court which pronounces them, during the term at which they are rendered or entered of record, and they may then be set aside, vacated, or annulled by that court.”

In *Timmons v. Garrison*, 4 Humph. (Tenn.) 148, 150, decided in 1843, the Court say:

“That during the term the judgments and decrees of the court are in the breast of the judge, and may be changed, modified or overruled, has been so often held that it would be a waste of time to expatiate upon the question.”

In *Clendenning v. Conrad*, 91 Va. 410, 418, the Court say:

“Until the Court adjourns for the term, no one, unless expressly authorized to do so, can

act under a decree or judgment entered at that term, except at his peril. During the term all the proceedings are in the breast of the Court, and under its control, and liable to be stricken out, altered or amended during the term, and that without notice to the parties." (Citing authorities.)

In *Moore v. Taylor*, 1 Ida. 635, the Court say:

"Proceedings during the term are considered only as *in fieri*, and subject to the control of the court, and no rights can be considered as fully settled and determined until they pass beyond the control of the court by the adjournment of the term."

In *Ashby v. Glasgow*, 7 Mo. 320, the Court say:

"When a final judgment is rendered in a cause, it may, during the term at which it was rendered, be set aside; for during the term all the proceedings are in the breast of the Court, and they may be altered or vacated as justice requires."

In *Faircloth v. Isler*, 76 N. Car. 49, 51, the Court say:

"All the proceedings of the Court are *in fieri*, subject to be amended, modified, or annulled, until the expiration of the term, at which period, in legal contemplation, all the judgments of the Court are delivered."

In *Halyburton v. Carson*, 80 N. Car. 16, the Court say:

"It is familiar learning that all the proceedings of a court of record are *in fieri*—under the absolute control of the judge, subject to be amended, modified, or annulled at any time before the expiration of the term in which they are had or done." (Citing authorities.)

In *Woodward v. Woodward*, 84 Mo. App. 330, the Court say:

“It is the well-recognized general rule of law in this and other jurisdictions that all judgments, decrees, and other orders, however conclusive, are under the control of the Court which pronounces them, during the term at which they are rendered or entered of record, and they may then be set aside, vacated, or annulled by that Court. During the term, which in legal contemplation is but a single day, everything is *in fieri*.” (Citing authorities.)

II

COURTS OF EQUITY POSSESS THE SAME POWER

§ 6. Courts of equity, as fully as courts of common law, possess the power to vacate their decrees or orders at any time during the term at which such decrees or orders are made or entered. This is self-evident; and the following are among the numerous authorities by which it is settled:

Doss v. Tyack, 14 How. (U. S.) 297, 312;
Goddard v. Ordway, 101 U. S. 745;
Henderson v. Carbondale &c. Co., 140 U. S. 26, 40;
Burch v. Scott, 1 Bland (Md.) 112, 120;
Thruston v. Devecmon, 30 Md. 217;
Pattison v. Josselyn, 43 Miss. 373, 378;
Clendenning v. Conrad, 91 Va. 410;
Kelty v. High, 29 W. Va. 381;
Bishop v. Aborn, 16 R. I. 568.

For examples:

In *Burch v. Scott*, 1 Bland (Md.) 112, 120, the Court say:

“It has been the long established usage of the Court of Chancery, to consider all its orders and decrees as completely within its control and open to be altered, revised, or revoked during the whole term at which they are passed, on motion or by petition.”

In *Pattison v. Josselyn*, 43 Miss. 373, 378, the Court say:

“It can not be controverted that the Chancery Court has the discretion, at the same term at which a final decree is pronounced, for good cause, to alter or modify it or to set it aside altogether.”

III

APPELLATE COURTS POSSESS THE SAME POWER

§ 7. Appellate courts, as fully as any other, possess the lawful power to vacate their judgments, decrees, and orders, at any time during the term at which such judgments, decrees, or orders are made or entered. This also is self-evident; and the following are among the authorities by which it is settled:

Goddard v. Ordway, 101 U. S. 745;

McRaven v. McGuire, 9 Sm. & M. (Miss.) 35;

Faircloth v. Isler, 76 N. Car. 49, 51 (quoted in § 5 above).

In *McRaven v. McGuire*, 9 Sm. & M. 35, for example, the point decided is thus stated in the syllabus:

“The judgments of the high court of errors and appeals are, during the term at which they

are rendered, subject to the control of the Court; and the individual opinions of one of the judges may be recalled and changed, if he becomes satisfied of error."

IV

THE COURT MAY PROPERLY EXERCISE SUCH POWER WITHOUT NOTICE

§ 8. While appellants' present motion is made on notice duly given to the appellees, yet, as illustrating the character and extent of the Court's power to vacate and set aside its judgments, decrees, or orders at any time during the term at which they are made, it appears that such power may properly be exercised without notice. This is *held*, in the following cases:

Rich v. Thornton, 69 Ala. 473;
Smith v. Robinson, 11 Ala. 270;
Clendenning v. Conrad, 91 Va. 410, 418;
Hesse v. Seyp, 84 Mo. App. 67, 72.

V

THE MOTION TO VACATE THE JUDGMENT AND THE ORDER MAY BE GRANTED AT EITHER THE PRESENT OR A LATER TERM

§ 9. Since the appellants' present motion to vacate and set aside the judgment and the order denying a rehearing is entered at the present term, it may properly be granted at either the present or at a later term. This also is self-evident. The following are some of the authorities by which it is settled:

Goddard v. Ordway, 101 U. S. 745;
Railroad Company v. Elder, 149 Ill. 174;
Niles v. Parks, 49 Ohio St. 370;
Preston v. McCann, 77 Md. 30, 33.

VI

SUCH RELIEF GRANTS A REHEARING

§ 10. It is self-evident that the effect of granting the relief sought by the present motion will simply be to grant a rehearing of the cause.

In *Underwood v. Sledge*, 27 Ark. 295, the Court say:

“It is well settled that a Court has control over its orders and judgments during the term at which they are made, and, for sufficient cause, may modify or set them aside * * ; and when an order or judgment of a court is set aside, at the same term of the court at which it was rendered, the whole suit or matter stands precisely as if no such consideration had been had or entered of record, and all parties interested are remitted back to such rights and remedies as they had before the making of the orders or judgments so vacated.”

SECOND

THE COURT'S LEGAL DUTY TO GRANT THE SAID RELIEF

I

THE ORDER DENYING APPELLANTS' PETITION FOR RE-
HEARING EXPRESSLY FINDS AND ADJUDGES THAT
SAID PETITION OUGHT TO BE GRANTED

§ 11. The said order denying appellants' petition for a rehearing, omitting only the title of the Court and cause, is as follows:

"Order Denying Petition for Rehearing.

"On consideration of the petition, filed on the 31st day of October, A. D. 1911, on behalf of the appellants for a Rehearing of the above entitled cause, and the Court being fully advised in the premises, and in accordance with the opinion of this Court this day rendered and filed, it is ordered that the said Petition for a Rehearing be, and hereby is denied."

—*The Court's Minutes of Dec. 4, 1911.*

§ 12. Observe, now, the following: The order (§ 11 above) *refers expressly* to "the petition, filed on the 31st day of October, A. D. 1911, on behalf of the appellants for a Rehearing of the above entitled cause," and also *refers expressly* to "the opinion of this Court this day rendered and filed," and also *says expressly* that it is the Court's *intention* to make the order "*in accordance with the opinion of this Court this day rendered and filed.*"

§ 13. Turning, then, to that “petition filed on the 31st day of October, A. D. 1911,” etc., and to that “opinion of this Court this day (Dec. 4, 1911) rendered and filed,” we find the following, to-wit: The appellants’ said petition for a rehearing properly sets forth and demonstrates, among other things—and the said “opinion of this Court” *expressly finds and declares it to be all true*—that this Court, in rendering the said judgment on October 2, 1911, *wholly overlooked and utterly forgot three of the five independent grounds of this suit that were properly specified and submitted for decision by the appellants, and also wholly overlooked and utterly forgot the entire argument of said three overlooked grounds by appellants’ counsel, and, further, that every one of said overlooked grounds is worthy of consideration and, if to be decided as appellants had claimed they respectively ought to be decided, would entitle the appellants to the recovery of all the immense property for which they sue in this cause.* The said “opinion of this Court” may be conveniently seen in—

Stead v. Curtis, 191 Fed. Rep. 529-542.

§ 14. The said order denying appellants’ petition for rehearing therefore *expressly finds and adjudges that the said petition ought to be granted.* This we will now prove.

II

THE COURT’S AUTHORITY TO ACT ON PETITIONS FOR REHEARING IS NOT ARBITRARY

§ 15. The following must command universal assent, and is settled law: The authority of a Court to act on

petitions for rehearing is not arbitrary, but is to be exercised with legal discretion, that is to say, in subordination to legal principles and rules. Here we cite the following:

Railway Co. v. County Railway Co., 26 Fed. 411;
Lee v. Bude &c. Ry Co., L. R. 6 C. P. 576, 580;
Tug &c. Co. v. Circuit Judge, 75 Mich. 360, 362;
Morgan v. Morgan, L. R. 1 P. & D. 647;
Rook's Case, 5 Coke, 99 (b);
Coke's Institutes on 29th Chapter of Magna Charta,
 p. 50;
Rex v. Wilkes, 4 Burr. 2539;
Attorney General v. Downing, Wilm. 1, 17;
Osborn v. U. S. Bank, 9 Wheat. 866;
Tripp v. Cook, 26 Wend. (N. Y.) 143, 152;
Faber v. Bruner, 13 Mo. 543;
Dooley v. Barker, 2 Mo. App. 328;
Norris v. Clinkscapes, 47 S. Car. 498;
Abbott v. L'Hommedieu, 10 W. Va. 700;
Bailey v. Taaffe, 29 Cal. 423.

For examples:

In *Railway Co. v. County Railway Co.*, 26 Fed. 411, the Court say:

“The application for a re-argument, it is true, is addressed to the discretion of the Court. The exercise of such discretion, however, is not wilful, but is governed and determined by certain well-established principles. * *

“The grounds on which courts ordinarily listen to such applications are stated by the Court of Appeals of New York in *Marine Nat.*

Bank v. City Nat. Bank, 59 N. Y. 73. They are: (1) upon all allegations that any question decisive of the case, and duly submitted by counsel, has been overlooked by the Court; or (2) that the decision," etc.

In *Lee v. Bude &c. Ry. Co.*, L. R. 6 C. P. 576, 580, the Court say:

"It was intended that the Court should exercise a discretion, that is, a judicial discretion regulated according to known rules of law. That is the meaning of the expression as usually found in the books."

In *Rex v. Wilkes*, 4 Burr. 2539, the Court say, by Lord Mansfield:

"But *discretion*, when applied to a court of justice, means *sound discretion guided by law*. It must be governed by rule, not by humour; it must not be arbitrary, vague, and fanciful; but legal and regular."

Sir Edward Coke, in the *Institutes*, treating of the 29th chapter of Magna Charta, says:

"The law is called *rectum* (straight or right), because it discovereth what is tort, crooked, of wrong, for as right signifieth law, so tort, crooked or wrong, signifieth injury. * * Hereby the crooked cord of what is called discretion appeareth to be unlawful, unless you take it as it ought to be, Discretion is to discern *by law*, what is just."

In *Rooke's Case*, 5 Coke 99 (b), the Court say:

"And notwithstanding the words of the commission give authority to the commissioners

to do according to their *discretions*, yet their proceeding ought to be limited and bound with the rule of reason and law. For discretion is a science or understanding to discern between falsity and truth, between wrong and right, between shadow and substance, between equity and colorable glosses and pretenses, and not to do according to their wills and private affections."

In *Osborn v. United States Bank*, 9 Wheat. (22 U. S.) 866, the Court say, by Chief Justice Marshall:

"Judicial power, as contradistinguished from the power of the laws, has no existence. Courts are the mere instruments of the law, and can will nothing. When they are said to exercise a discretion, it is a mere legal discretion, a discretion to be exercised in discerning the course prescribed by law; and, when that is discerned, it is the duty of the Court to follow it."

In *Tug &c. Co. v. Circuit Judge*, 75 Mich. 360, 362, in ordering a mandamus to compel the granting of a new trial, the Court say:

"It is said that a new trial in this case was not a matter of right, but was within the discretionary power of the Circuit Court; that the Circuit Judge exercised that discretion, and that this Court can not review it. * *

"The discretion vested in the Circuit Court in this matter is a legal one, as all the authorities concede. Now, what is understood by legal discretion? Certainly it is not an arbitrary one. When exercised arbitrarily by a court, it becomes an abuse of legal discretion. It must be conceded that the Circuit Court has no right or power to exercise its discretion in any such way. * *

"A legal discretion is one that is regulated

and governed by well-known and established principles of law. It can never be used or invoked to destroy nor to deprive a party of his property rights. Those are absolute, and no court is vested with the power to destroy these, nor to deprive a party of them, except as public necessity may require; and that is not this case.

“Legal discretion can only be exercised in securing to a party his absolute rights and in their protection in some way; and when the discretion of a court is used for any other purpose, it becomes arbitrary and oppressive, and can never be regarded when so used as anything but an abuse of discretion, which is itself a violation of the law, both tyrannical and intolerable.”

III

BY RENDERING A PORTION OF THE DECISION ON APPELLANTS' PETITION FOR REHEARING, THE COURT HAS DENIED TO THE APPELLANTS A HEARING OF THE CAUSE

§ 16. As already pointed out (§§ 11-13), the Court, in its said order denying the appellants' petition for a rehearing, has expressly found and declared—and such also is the actual fact—that *this Court*, in rendering its judgment (on October 2, 1911), *wholly overlooked and forgot three of the five independent grounds of this suit and the entire argument of the said overlooked grounds by the appellants' counsel.*

§ 17. What else did the Court do in the case on December 4, 1911? The Court then rendered on that day *a supplemental decision*, in which the Court has purported to take up and decide the grounds of this suit that

were left unconsidered in rendering the judgment; and in so doing, this United States Circuit Court of Appeals has denied to the appellants a hearing of their cause. This we will now prove.

§ 18. As hereinafter shown (§ 30), all the authorities agree that, in appellate courts, a defeated party is entitled to a rehearing on showing that the Court, in rendering the judgment, overlooked any decisive ground which such party duly submitted for decision.

§ 19. That unanimous agreement of the authorities plainly indicates that such settled rule of law is an expression of a fundamental principle of natural justice. That principle is very obvious. A court's rendition of its judgment is necessarily a deliberate act; and hence wherever such judgment has been rendered upon wholly overlooking and ignoring any material ground and after having forgotten even that such a ground was argued or submitted for decision, although such ground is decisive of the case and the defeated party actually invoked such ground and argued it and submitted it for decision,—in every such case the judgment rendered has necessarily denied to the defeated party a hearing of his cause.

§ 20. In this particular case, the appellants have never, in any degree whatever, waived a hearing. On the contrary, the appellants' counsel, on March 3, 1911—six months prior to the said wrongful rendition of judgment—orally argued to the Court the entire case as fully as he was allowed to do.

*An Appellate Court's Judgment is Wrongful and Void
When Made on Denial of Oral Argument*

§ 21. As just pointed out (§ 19), the said order made on December 4, 1911, denying the petition of the appellants for a rehearing, has expressly admitted and conclusively established the fact that, as regards three of the five independent grounds of this suit, the said judgment of this Court against the appellants, rendered on October 2, 1911, was rendered without allowing the appellants a hearing.

§ 22. Therefore there applies to the case a fundamental principle of universal operation, and the following settled rule of law that is an expression of that principle: Any judgment of a court made against a party without allowing him a hearing, is wrongful and void. This rule applies to judgments of appellate courts, and, by virtue of it, any judgment of an appellate court made against a party without allowing him an *oral argument* of the grounds of his case, is arbitrary, wrongful, and void. It will be sufficient to cite the following authorities:

Queen v. Archbishop of Canterbury, 1 Ellis & Ellis 545;

Capel v. Child, 2 Cr. & J. 558;

Luco v. DeToro, 88 Cal. 27;

Railroad Co. v. Townsite Co., 42 Kan. 104;

De Votie v. McGerr, 14 Colo. 577;

Brown v. Hummel, 6 Pa. St. 91;

State v. Beverman, 59 Kan. 591;

Meredeth v. People, 84 Ill. 482;

Thompson v. People, 144 Ill. 378;
O'Brien v. People, 17 Colo. 563;
Ellerbe v. State, 75 Miss. 532;
Hovey v. Elliott, 167 U. S. 413.

For examples:

Queen v. Archbishop of Canterbury, 1 Ellis & Ellis 545, was a suit for a mandamus to compel the Archbishop to hear a case that had been appealed to him from a lower tribunal. The appeal had been taken in writing, and the appellant had filed with the Archbishop, with the appeal, a written statement of the grounds of the appeal, and the Archbishop, upon a careful consideration of the record, including the said written grounds filed by the appellant, had decided the case against the appellant, but without allowing him an oral hearing.

The Court *held* that, *because the Archbishop had denied the appellant a hearing*, his judgment was absolutely void, and granted the mandamus prayed for. In so deciding, the Court say:

(By Lord Campbell, C. J.)

“No doubt the Archbishop acted most conscientiously, but we all think he has taken an erroneous view of the law. He was bound to hear the appellant, and he has not heard him. It is one of the first principles of justice that no man should be condemned without being heard. We do not say whether the Archbishop’s decision was right or wrong. We say only that he has not heard the petitioner. The appellant here has not been heard. Without any communication with him, his judge decides against him. We think the mandamus

to hear the appeal must go, as in our opinion there has been no hearing.”

(By Wightman, J.)

“It is not our duty to give an opinion upon the merits of the petition: We merely say that *ex debito justicie* every one has a right to be heard before he is condemned.”

(By Crompton, J.)

“I have not been able to entertain any doubt that we are bound to issue this mandamus. Where a statute of this kind gives an appeal, it gives, by implication, a right to be heard upon the appeal. Even if the Archbishop should direct that all appeals to him must be in writing, still he must hear the appellant upon those written appeals. Here the appeal has not been heard, and the mandamus must issue to the Archbishop to hear it.”

(By Hill, J.)

“This mandamus is for an inquiry to be made by the Archbishop. The question for us is, is the Archbishop, under the statute, bound to hear the appeal, and if so, what is a hearing? What does the law require in such a case? Invariably, that the parties who are to be liable to a judgment shall be heard. This is a principle, which has been laid down in numerous decisions in all the courts. * * When we look at the petition here, we find that the appellant denies that his admissions were to the effect stated by the Bishop. That is the

question which he submits to the judgment of the Archbishop. He has a right to be heard before the Archbishop to argue that question; and the Archbishop can not give judgment until that question has been argued before him."

In *Capel v. Child*, 2 Cr. & J. 558, a statute expressly authorized a Bishop, whenever certain facts "shall appear to the satisfaction of any Bishop, either *of his own knowledge*," etc., to take away from the vicar certain of his income and to employ it for other uses. The Bishop, claiming to proceed under that statute, had made an order which expressly recited that the requisite facts appeared to him "*of his own knowledge*," and thereupon diverted from the vicar certain of his income. But the Bishop had not given to the vicar an opportunity of a hearing; and the Court therefore held the Bishop's order to be void. In so deciding, the Court say:

(By Lord Lyndhurst, C. B.)

"According to every principle of law and equity, such judgment could not be pronounced, or, if pronounced, could not for a moment be sustained, unless the party (the vicar) in the first instance had the opportunity of being heard in his defense, which in this case he had not."

(And by Bayley, B.)

"When the Bishop proceeds on his own knowledge, I am of opinion also that it can not possibly, and within the meaning of this Act, appear to the satisfaction of the Bishop, and '*of his own knowledge*,' unless he gives the party an opportunity of being heard, in

answer to that which the Bishop states *on his own knowledge* to be the foundation on which he proceeds. Is it not a common principle in every case which has in itself the character of a judicial proceeding, that the party against whom the judgment is to operate should have an opportunity of being heard?"

In *Hovey v. Elliott*, 167 U. S. 413, the Court say:

"The fundamental conception of a court of justice is condemnation only after hearing. To say that courts have inherent power to deny all right to defend an action and to render decrees without any hearing whatever, is, in the very nature of things, to convert the court exercising such an authority into an instrument of wrong and oppression, and hence to strip it of that attribute of justice upon which the exercise of judicial power necessarily depends."

In *Brown v. Hummel*, 6 Pa. St. 91, the Court say:

"The first judgment on earth was on summons and hearing. Where art thou, Adam? and, Hast thou eaten? etc., preceded the ejection of Adam and Eve from their beautiful inheritance, the Garden of Eden. And the proudest legislator may learn wisdom from such an example."

In *Rex v. Chancellor*, 1 Str. 565 (quoted and adopted by the Court in *Cooper v. Board*, 108 Eng. C. L. R. 181, and also by the Court in *Railroad Tax Cases*, 13 Fed. 765), the Court say (by Fortesque, J.):

"The objection of a want of notice can never be got over. The laws of God and man both give the party an opportunity to make his defense. I remember to have heard it observed by a very learned man upon such an occasion,

that even God himself did not pass sentence upon Adam, before he was called upon to make his defense. ‘Adam, where art thou? Hast thou not eaten of the tree whereof I commanded thee that thou shouldst not eat?’ And the same question was put to Eve also.”

§ 23. Even Omniscience, then, does not pass judgment against a human being without allowing him a prior hearing. And that passage of the Book of Genesis expresses also the spontaneous and universal sentiment of every sane human being that has ever existed. Every judge on the face of the earth may well “learn wisdom from such an example.”

The Fact That a Further Appeal May Be Taken Does Not Vary the Case

§ 24. It is also plain that it is no answer to the objection to say that a further appeal to another Court may be taken.

In *Capel v. Child*, 2 Cr. & J. 558, for instance, the Court say (by Lord Lyndhurst, C. B.):

“Then it was said, in answer to the argument urged at the bar, that the party had a right to appeal to the Archbishop. I apprehend the right to appeal to the Archbishop makes no difference in this case. Where there is an authority to pronounce a judgment, and an appeal is given from that judgment when it is pronounced, the party against whom the judgment is pronounced has a right to be heard on the original judgment; he has a right to be heard before the original judgment is pronounced, for the purpose of preventing that judgment from being pronounced; and the circumstance of its (the right of appeal) having been given, makes, in that respect, as I apprehend, no difference whatever.”

*The Act of Congress Creating the Court Expressly
Gives the Right to Argue Orally the Entire Case*

§ 25. The Act of Congress by which this Court has been created, expressly directs, in the passage quoted in § 26 *post*, that the court shall “establish all rules and regulations for the conduct of the business of the Court,” etc. And thereupon, long prior to the commencement of this suit, this Court duly enacted a *rule*, of which the following is a part (Rule 25):

“ORAL ARGUMENTS.

“1. The plaintiff in error or appellant shall be entitled to open and conclude the argument of the case.”

IV

THIS UNITED STATES CIRCUIT COURT OF APPEALS HAS
DENIED TO THE APPELLANTS THE RIGHT TO
PETITION FOR REHEARING

§ 26. The Act of Congress which has created this Court (Act of March 3, 1891, sec. 2: 26 Stats. 826) provides:

“The Court shall have power to establish all rules and regulations for the conduct of the business of the Court within its jurisdiction as conferred by law.”

§ 27. And the Court thereupon, and prior to the present suit, has enacted a *rule*, as follows (Rule 29):

“A petition for rehearing may be presented within thirty days after judgment.”

§ 28. Take, now, the fact stated in § 17 above. What, then, is the case on this point. The Court rendered and entered its judgment on October 2, 1911, and *at that time*, decided only two of the five grounds of the suit. By the Rule just quoted, the right of the appellants to petition for a rehearing was made to expire on November 1, 1911. Afterward, on December 4, 1911, without even the pretense of giving opportunity for a hearing, the Court rendered a *supplemental decision*, deciding or purporting to decide grounds of the suit that were previously overlooked and left undecided. In short, *the Court deliberately and wrongfully withheld, kept back, three-fifths of the decision until after the expiration of the time within which the appellants were allowed to petition for a rehearing.*

§ 29. The Court has, therefore, wrongfully deprived the appellants of the right to petition for a rehearing; and that right of which the appellants have thus been wrongfully deprived, is an important right given *by law*, that is, by a *rule* enacted by the Court under the express direction of the law that created the Court.

V

THE APPELLANTS' RIGHT TO A REHEARING IS ESTABLISHED BY THE VERY ORDER DENYING THE REHEARING

§ 30. It is fully proved, in points "II," "III," and "IV" above (§§ 15-29), that a petitioner for a rehearing is of right entitled to have his petition granted when he shows, in his petition, that the Court, in rendering the

judgment against him, overlooked any ground or question that was decisive of the case and that he duly submitted for decision. And that such is the settled rule, is shown by the unanimous agreement of the authorities, some of which are the following:

2 Cyc. 215;

18 Enc. Pl. & Pr. 35;

Railway Co. v. County Railway Co., 26 Fed. 411;

Kirby v. Telegraph Co., 4 S. Dak. 439;

Smith v. Walker, 57 Mich. 488;

Hardin v. Melton, 28 S. Car. 38, 49;

Mount v. Mitchell, 32 N. Y. 702;

Fosdick v. Hempstead, 126 N. Y. 652;

Haywood v. Dawes, 81 N. Car. 9;

Andrews v. Crenshaw, 4 Heisk. (Tenn.) 151;

State v. Eaton, 6 Kan. App. 95;

Rule of Court, 116 Mo., Appendix, p. 4;

Davis v. Clark, 2 Mont. 394;

Derby v. Gallup, 5 Minn. 119;

Hintrager v. Hennessy, 46 Ia. 605;

Brown v. Pickard, 4 Utah 294;

Railroad Co. v. Gibbes, 24 S. Car. 61;

Frost v. Weatherbee, 23 S. Car. 370.

For examples:

In *2 Cyc.* 215, in the treatise on *Appeal and Error*, the text states the rule of law as without exception and as follows:

"Points and Authorities Overlooked. A rehearing will be granted if the Court has overlooked material points or decisive authorities duly submitted by counsel." (Citing authorities.)

In the *Encyc. of Pl. & Pr.*, vol. 18, p. 35, in the treatise on *Rehearing*, the text also states the rule of law as without exception and as follows:

“A rehearing will be granted where it is shown that some question decisive of the case and duly submitted by counsel has been overlooked by the Court.” (Citing authorities.)

Railway Company v. County Railway Company, 28 Fed. Rep. 411, directly to the point, is quoted in § 15 above.

In *Smith v. Walker*, 57 Mich. 488, the Court say:

“The Court will always regard a motion for rehearing with favor, which will call our attention to something contained in the record or briefs of counsel that has been inadvertently or otherwise overlooked or omitted, which is material to be considered in making a proper disposition of the case, or which will challenge our attention to a misapplication of the law.”

In *Kirby v. Telegraph Company*, 4 S. Dak. 439, in granting a rehearing, the Court say:

“But appellant’s counsel calls our attention to another question, which was alluded to in the oral argument, and but lightly referred to in his brief, which may have some material bearing upon the merits of the case, and which was not considered by the Court. The question is * * (The Court here state the question.) Counsel for appellant contend * * (The Court here state the contention.), and our attention is called to a large number of decisions in support of this contention. In view, therefore, of the great importance of the case, * * and in order that a full determination may be had of all questions in controversy in this action, we shall grant a rehearing as prayed for.”

In *Hardin v. Melton*, 28 S. Car. 38, 49, the Court say:

“To entitle a party to a rehearing after judgment pronounced by this Court, it should appear in the petition filed for that purpose that this Court overlooked some fact or some question of law material to the case, as presented by the appeal.”

In *Marine Nat. Bank v. City Nat. Bank*, 59 N. Y. 73, the Court quote and adopt the language of the Court in *Mount v. Mitchell*, 32 N. Y. 72, as follows:

“Motions for re-argument should be founded on papers showing clearly that some question decisive of the case, and duly submitted by counsel, has been overlooked by the Court,” etc.

In *Fosdick v. Hempstead*, 126 N. Y. 652, the Court again quote and re-affirm the same language, and say concerning it:

“Many years ago the Court announced the rule that should govern in this class of motions.”

The Right to Rehearing Does Not Require Proof That the Former Decision Was Wrong

§ 31. To entitle a party to a rehearing, it is unnecessary for him to demonstrate that the former decision was wrong. This is shown in §§ 22, 23 above, and in the language of the decisions quoted in § 22 above; and it is proved also by the general course of all appellate courts, where it appears that the courts, after granting the rehearing, sometimes re-affirm the former decision, and sometimes reverse it. In *Morrow v. Weed*, 4 Ia. 123, speaking on this point, the Court say:

“In this case a rehearing was granted upon the petition of the plaintiff and appellee. The granting a rehearing in our present practice is now but a re-argument and reconsideration, on the petition of the party, or when the Court itself desires it. The cause is set down, technically for re-argument. In neither case does it necessarily imply that the Court is convinced that it has fallen into error. In the present cause, the rehearing was granted for several reasons. * * We have been willing, therefore, to reconsider the cause—to look at it more in detail, and see if we have fallen into error.”

VI

THE SAID JUDGMENT AND ORDER OF THIS COURT HAVE
THROUGHOUT DENIED AND OVERTHROWN
BOTH JUSTICE AND LAW.

§ 32. In the appellants' petition for rehearing filed on October 31, 1911, and above mentioned, this is expressly made the main ground and is expressly pointed out and proved. The supplemental decision which was thereupon made on December 4, 1911, and is above mentioned, both omits to answer that ground and is a further example of it. The very fact that such ground exists—that this United States Circuit Court of Appeals has in this cause fundamentally and throughout and in every particular, precisely as did the Court below, denied to the complainants and appellants both justice and the law—forbids them, in addressing the very Court that has done such wrong, to go into any further detail of proof of it. The principle here involved was stated by Pascal, in the twelfth *Provincial Letter*, as follows:

“It is a strange and tedious war when violence attempts to vanquish truth. All the efforts

of violence can not weaken truth, and only serve to give it fresh vigor. All the lights of truth can not arrest violence, and only serve to exasperate it. When force meets force, the weaker must succumb to the stronger; when argument is opposed to argument, the solid and the convincing triumphs over the empty and the false; but violence and verity can make no impression on each other.

“Let none suppose, however, that the two are, therefore, equal to each other; for there is this vast difference between them, that violence has only a certain course to run, limited by the appointment of Heaven, which overrules its effects to the glory of the truth which it assails; whereas verity endures forever, and eventually triumphs over its enemies, being eternal and almighty as God Himself.”

§ 33. The case of these complainants and appellants, set forth in their bill of complaint, is in the highest degree a just and righteous cause; and on the facts properly set forth in that bill—and which constitute the case before this Court—the law clearly and beyond any room for doubt entitles these appellants to the judgment of this Court in their favor, so as to give them, by means of this suit, the recovery of their said property of upwards of three million dollars in amount and value; and all this is fully shown and proved and step by step demonstrated in the appellants' Brief which was filed in compliance with the command of Rule 24 of the Court. These appellants, in asking for such judgment in their favor, have asked for only their plainly just and righteous and plainly lawful rights, and, in their said Brief, have made their said rights plain, manifest, and indisputable; and any lawful and fair treatment of the case as it was presented to this

Court will so demonstrate. In this case no doubtful or difficult problem has been presented to this Court for solution, nor has any problem been presented, nor is any involved, that a fair mind can decide against these appellants. But, by the judgment and the order denying a rehearing, both of which the appellants here ask to have vacated and set aside, and by the two opinions of this Court, one filed with the said judgment and the other with the said order, and on respectively October 2, 1911, and December 4, 1911, all lawful treatment of the case has been refused and denied, and, in lieu of lawful treatment, this cause has been subjected to a treatment unjust, unlawful, and unrighteous in a degree and of a kind that would beat down and destroy any cause and any principle or provision of law—that is, under which the most righteous cause and the clearest and strongest legal right would have no chance whatever. The argument of this case for the complainants, as given in their said Brief, and as given before the Court orally on March 3, 1911, neither has been nor can be fairly, lawfully, or justly met. In short, the only result that the appellants have obtained by their appeal has been to suffer from this Court a more deliberate infliction of the same wrongs that were inflicted upon them by former Judge Cornelius H. Hanford in the Court below. These appellants are native born citizens of the United States; they have the right to be fairly treated and to have their cause fairly treated in and by this Court of the United States; and they here claim and demand that right.

The complainants and appellants respectfully demand the relief prayed for by the motion filed herewith, and stated also in § 1 above.

HORACE W. PHILBROOK,
Solicitor for Appellants.

San Francisco, Cal.,

August, 1912.

CERTIFICATE

I certify that the accompanying motion of the appellants, above stated, and the foregoing brief in support thereof, are well founded, and that neither the said motion nor the said brief is interposed for delay.

HORACE W. PHILBROOK,
Counsel for Appellants.

APPENDIX

The following, omitting only the title of the Court and of the cause, is a copy of the motion (and notice of hearing) referred to and supported in the foregoing brief:

(Title of Court and Cause.)

MOTION BY APPELLANTS TO VACATE THE JUDGMENT AND THE ORDER DENYING APPELLANTS' PETITION FOR REHEARING; AND NOTICE OF HEARING.

To the United States Circuit Court of Appeals for the Ninth Circuit and to the Judges Thereof; and to the Appellees and Their Solicitors:

The appellants respectfully move that the hereinafter designated order and also the hereinafter designated judgment of this Court in this cause, made and entered at its present term and against the appellants and in favor of the appellees, be vacated and set aside, to-wit: the order made and entered on the 4th day of December, 1911, denying the petition of appellants for a rehearing, and the judgment made and entered on the 2nd day of October, 1911, declaring the decree appealed from to be affirmed.

This motion is made on all and singular the following grounds:

1

The appellants are suing for the recovery of their property—all properly designated in their bill of complaint and of the amount and value of nearly three and one-half million dollars (\$3,483,912.00), and all of which has been wrongfully seized and withheld by the appellees by means of certain void, fraudulent, and otherwise

wrongful pretended probate proceedings and judgments of the Superior Court of the State of California in and for San Francisco. On the said pretended probate proceedings and judgments being found either void or voidable by this suit, the appellants are of right and justly entitled to recover their said property by this suit; and they have properly shown and claimed on the record, and have properly shown and fully proved in their Brief filed and served in compliance with Rule 24 of the Court, five independent grounds on every one of which and by virtue of the law, the said pretended probate proceedings and judgments ought to be by the Court in this suit declared void and set aside and the appellants' said property restored to them; and every one of said grounds is by itself sufficient to such end. The appellants by their counsel orally argued all the said grounds to this Court on the 3rd day of March, 1911, and on that day submitted this cause and the said grounds to this Court for decision and judgment. Thereupon, this Court, in rendering the said judgment against the appellants and in favor of the appellees on October 2, 1911, filed a written opinion which purported to set forth the grounds of said judgment; and the said written opinion is throughout and in every particular and in the highest degree unjust and unfair. Also, in the making of said written opinion and in the rendition of said judgment, three of the said five grounds of this suit and the entire argument thereof made on the part of the appellants, were by the Court wholly overlooked and forgotten and left unmentioned. Thereupon, on October 31, 1911, the appellants filed their said petition for rehearing, and therein properly complained of and showed the injustice

III

and unfairness of said judgment and also complained and showed that, as above mentioned, the Court had, in the rendition of said judgment, wholly overlooked and forgotten three of the said five grounds of the suit and the said entire argument thereof, and prayed to have the said wrongful judgment set aside and to be allowed a hearing of their cause. Thereupon, without allowing the appellants any opportunity for a hearing, the Court, on December 4, 1911, made and entered the said order declaring said petition to be denied, and in the said order and without controverting any of the grounds of said petition, has expressly found and declared that, as hereinbefore stated, the Court had, in rendering said judgment, wholly overlooked and forgotten and left unmentioned three of the five fundamental grounds of the suit, and in the said order and on its face has also expressly found and declared that each of said three overlooked grounds is a ground decisive of the case and worthy to be considered and decided, and, instead of allowing to the appellants a hearing, has, in denial of any hearing or judicial consideration, set forth against the appellants and in favor of the appellees an utterly unfair and unjust discussion and purported decision of the said three overlooked grounds. And therefore the said order denying a rehearing expressly recites on its face and establishes that the appellants' said petition for rehearing ought not to be denied and ought to be granted.

2

The said judgment and the said order denying a rehearing have been made in violation of law and justice, have denied to the appellants a hearing of their cause,

and have denied to them that fair and just consideration of their cause that is absolutely essential to the fundamental conception of a court of justice.

3

The said judgment and order of this Court are but a continuation of the extreme and gross injustice that was done to the complainants (these appellants) by the Court from which the appeal was taken. In that Court, the Court below, this suit was regularly heard and fully argued before Judge Edward S. Farrington, there regularly presiding, and submitted to him for decision and judgment, and was thereupon held under consideration by him for more than one year. When the said Judge Farrington was about to render decision, Circuit Judge William W. Morrow, one of the judges of this Court, suddenly and without cause and without the consent of any of these appellants, interposed on February 5, 1910, and ordered this suit taken away from Judge Farrington, and called in former Judge Cornelius H. Hanford, of Seattle, and assigned him to dispose of this suit on February 14, 1910. Thereupon said Cornelius H. Hanford sat as judge of the Court below on February 14, 1910, for the purpose of disposing of this suit, and then immediately made the fact manifest and indisputable that he then sat as judge of this case, not to give it any judicial consideration, but to deny to the complainants both justice and law and to strike down their cause. This the said Judge Cornelius H. Hanford then did by forthwith vacating, on February 14, 1910, an order which the said Judge Farrington had made in this suit and by which said order certain defendants (appellees here) were re-

strained from prosecuting, during the pendency of this suit, a later suit which they had commenced against these appellants in the said Superior Court of the State of California on the same subject matter that is involved in this suit. And immediately thereupon the said Judge Cornelius H. Hanford arbitrarily denied to these complainants any hearing of this suit, and thereupon, without allowing any hearing, entered a decree dismissing this suit on February 19, 1910. It is from that wrongful decree that this suit has been appealed by these appellants to this Court.

This motion is made on all the papers, records, and files of this Court in this cause.

Notice is here given that this motion will be brought on for hearing in the Court Room of ^{said} ~~the~~ United States Circuit Court of Appeals in San Francisco, on the 4th day of September, 1912, at the opening of the said Court, or as soon thereafter as counsel can be heard.

This motion is supported by a printed brief of points and authorities served herewith.

I certify that this motion is well founded and is not interposed for delay.

HORACE W. PHILBROOK,
Solicitor for Appellants.

(Filed and served in San Francisco on August 27, 1912.)



IN THE

United States Circuit Court of Appeals

NINTH CIRCUIT.

CATHERINE D. STEAD, et al.,

Complainants and Appellants,

VS.

ISABELLA M. CURTIS, et al.,

Defendants and Appellees.

ANSWER OF JEAN MCGREGOR BOYD,
GEORGE DAVIS BOYD, AND HENRY
ST. CLAIR BOYD TO APPELLANTS'
MOTION TO VACATE ORDER DENY-
ING PETITION FOR REHEARING.

JOHN S. PARTRIDGE,
Solicitor and of Counsel for Jean
McGregor Boyd, et al., Appellees.

No. 1899.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS

NINTH CIRCUIT.

CATHERINE D. STEAD, et al.,

Complainants and Appellants,

VS.

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Defendants and Appellees.

ANSWER OF JEAN MCGREGOR BOYD,
GEORGE DAVIS BOYD, AND HENRY
ST. CLAIR BOYD TO APPELLANTS'
MOTION TO VACATE ORDER DENY-
ING PETITION FOR REHEARING.

I.

In this matter, the decision of the Court affirming the action of the Circuit Court, was rendered October 2, 1911. A petition for a rehearing was presented, and denied December 4, 1911. The present "Motion by Appellants to Vacate the Judgment and Order Deny-

ing Appellants' Petition for a Rehearing" was filed August 27, 1912.

There is nowhere, so far as we know, any warrant in the rules, the statutes or decisions warranting any such motion as this. We have always understood that the order of this Court denying a petition for a rehearing was final, unless a *certiorari* was issued by the Supreme Court.

Rule 32 of this Court provides:

"In all cases finally determined in this Court, a mandate or other proper process in the nature of a *procedendo* shall, upon the payment of any costs due in the case, be issued, as of course from this Court, to the court below, for the purpose of informing such court of the proceedings in this Court, so that further proceedings may be had in such court as to law and justice may appertain. Such mandate, if not stayed by the order of the Court, shall be issued on the expiration of thirty days from the date of such final determination unless within said time a petition for rehearing be filed, in which case the mandate shall be stayed until five days after the determination of such petition."

And rule 29 reads as follows:

"A petition for rehearing may be presented within thirty days after judgment. It must be printed, and briefly and distinctly state its grounds, and be supported by certificate of counsel that in his judgment it is well founded, and that it is not

interposed for delay. Twenty printed copies must be filed with the clerk of this Court."

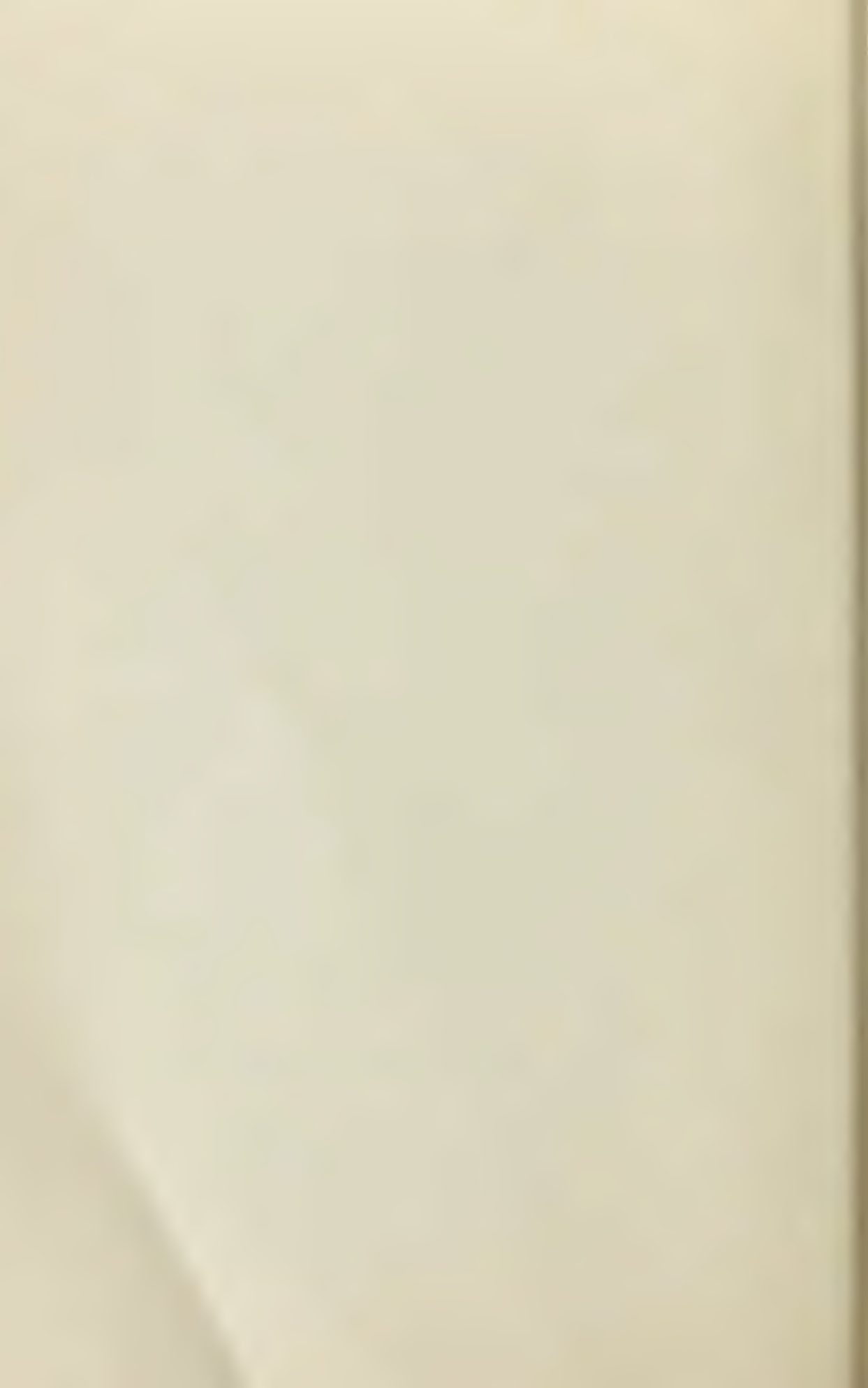
In *Crabtree v. McCurtain*, 66 Fed. 1, the Court of Appeals for the Eighth Circuit, held that no petition for a reargument should be entertained after the time fixed by the rules for the retention of the mandate, unless the counsel were not informed of the decision, or could not have ascertained, with reasonable diligence, that it had been rendered.

II.

It is very difficult to follow counsel in the reasons given for a reopening of this case. The first decision of this Court was principally upon the ground that there was no jurisdiction below to entertain the suit. If that was so, then there was no need to consider the other points made. But upon the petition for a rehearing, this Court patiently explains the reasons why an ancient statute relied upon can have no bearing upon the case. The two decisions dispose of every proposition made. And prior to the present litigation, these complainants had persistently exhausted every possible resource in the State courts.

We respectfully submit that there should be an end to this litigation.

JOHN S. PARTRIDGE,
Solicitor and of Counsel for Jean
McGregor Boyd, et al.



No. 1899

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

CATHERINE D. STEAD et al.,
Appellants,

VS.

ISABELLA M. CURTIS et al.,
Appellees.

BRIEF FOR APPELLEES.

Appeal from the Circuit Court of the United States for the Northern
District of California by Complainants from the Final
Decree Sustaining the Demurrers of Defendants, and
Dismissing Their Original Amended Bill.
(On Rehearing.)

J. C. CAMPBELL,

WALTER SHELTON,

Solicitors for Appellees Isabella M. Curtis, John M. Curtis,
Elizabeth M. Muir Mugan, William G. Mugan, and the
Jacob Z. Davis Estate Company.

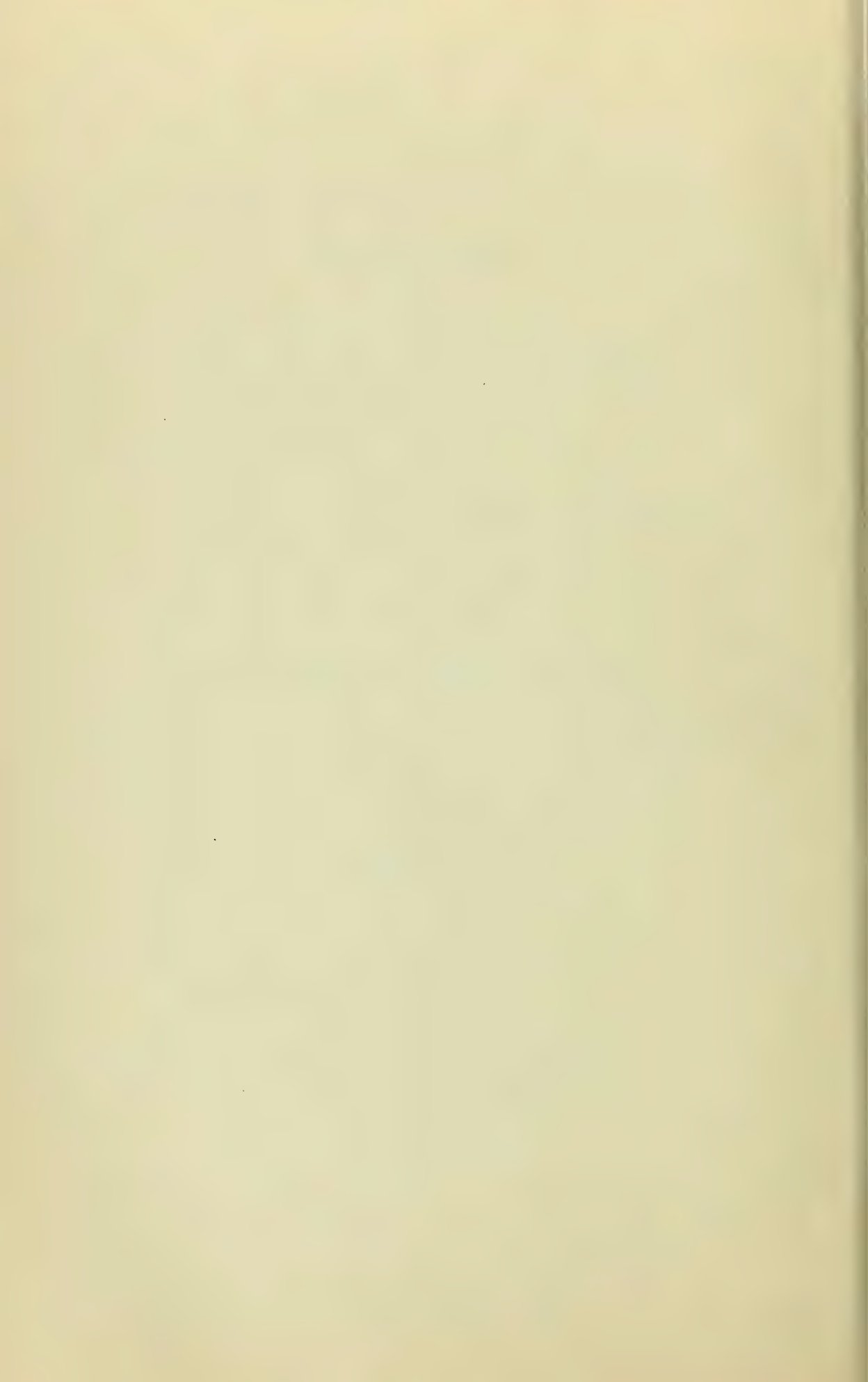
Filed this.....day of February, 1913.

FRANK D. MONCKTON, Clerk.

By.....Deputy Clerk.

FILED

JAN 31 1913



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No. 1899

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

CATHERINE D. STEAD et al.,	}
<i>Appellants,</i>	
VS.	
ISABELLA M. CURTIS et al.,	
<i>Appellees.</i>	}

BRIEF FOR APPELLEES.

Appeal from the Circuit Court of the United States for the Northern
District of California by Complainants from the Final
Decree Sustaining the Demurrers of Defendants, and
Dismissing Their Original Amended Bill.

STATEMENT OF THE CASE.

1. *Introductory.*—This appeal has already been the subject of frequent consideration by this court, and the facts and issues therein presented must undoubtedly be familiar. This statement is therefore made very brief, containing simply an outline of the material facts in issue with references to the transcript and serving as an explanatory index of the discussion to follow.

2. *Relief Sought.*—The first and fundamental purpose of this suit is to have it determined that

Jacob Z. Davis died intestate. The United States Circuit Court sitting in California was asked by original bill in equity to take jurisdiction of this suit and decide, without any probate judgment or order to that effect and with a valid probate decree to the contrary, that Jacob Z. Davis died leaving no will and that appellants, as his heirs, are therefore entitled to his estate. This result is sought upon the following statement in the amended original bill of complaint.

3. *Demise of Deceased.*—While a resident of the City and County of San Francisco, State of California, Jacob Z. Davis died on the 28th day of October, 1896, leaving estate in said City and County of the value of more than \$1,000,000 (Trans. pp. 195-208).

4. *Will and Petition for Probate.*—Shortly thereafter, on the 16th day of November, 1896, appellees, Mrs. Muir and Mrs. Curtis, filed their petition in the Superior Court of the City and County of San Francisco, praying that the following document, then and there produced, be admitted to probate as the last will and testament of Jacob Z. Davis, deceased:

“Oct 1st 1896

I Jacob Z Davis Will and bequeath every thing I have in this world to my beloved nieces
Lizzie Muir and Belle Curtis

JACOB Z. DAVIS.”

(Trans. pp. 223, 226, 227.)

5. *Probate Proceedings and Decree.*—Thereupon the clerk of said court issued, signed and sealed, a notice to the effect that on November 30, 1896, at 10 o'clock A. M., at the courtroom of Department 10 of the Superior Court, said will would be proved. At the time set for such hearing appellants appeared and filed certain written grounds of opposition to said petition setting forth that appellants were heirs of decedent and that said will was a forgery, which said petitioners answered to the effect that said will was valid, having been written entirely by the hand of said Jacob Z. Davis. Appellants thereupon demanded a jury, and after a trial of forty-six days beginning on May 17, 1897, and ending August 16, 1897, a verdict was rendered against appellants as contestants, and by judgment entered upon said verdict on the 17th day of August, 1897, said will was admitted to probate, and said petitioners were appointed administratrices with the will annexed. They then took possession of the property belonging to said estate as such administratrices and continued so to hold said property until distributed to them by final decree on May 4, 1904. (Trans. pp. 231, 234, 237, 253, 343, 229, 291).

6. *Objections to Jurisdiction of Probate Court. Lack of Citation.*—It is alleged, however, that said judgment of probate is wholly void and not merely voidable, for several reasons. In the first place it is said that no notice of the hearing of said petition

for probate was ever given as required by Section 1303 of the Code of Civil Procedure, and that no proof of the giving of such notice was ever made. This allegation is made, however, in the face of the fact that after the appearance of appellants on the very day set for hearing in said notice and after a trial of forty-six days, and while appellants were still before the court, the decree was made and entered finding that proof of service of notice as required by said Section 1303 had been made, and notwithstanding the further fact that appellants were present and took an active part in said hearing and at that time were occupying the position of plaintiffs invoking the probate jurisdiction of said court and asking it to declare said will a forgery (Trans. pp. 232, 233, 234, 237, 343).

7. *Probate Jurisdiction. Lack of Necessary Parties.*—The second ground upon which appellants seek to have this court treat the probate decree as wholly void, is based upon the averment as to lack of notice above set forth, and the further statement that decedent left surviving him certain heirs besides appellants who never appeared in said court “in any proceeding or case for the admission of said pretended will to probate or in any contest of said pretended will or in any proceeding or case in anywise relating to the admission of said pretended will to probate”. This averment is made in flat contradiction of a subsequent statement in the bill that *all* of the heirs of said Jacob Z. Davis appeared

in said probate proceeding admitting said will to probate, and applied for relief against said probate decree, and by motion therein to a judge of said Superior Court sought to obtain and make a bill of exceptions to be used as a record on appeal, and that all the heirs of said Jacob Z. Davis attempted to take an appeal from said probate decree to the Supreme Court of this state; unless, however, we construe the quotation as referring only to proceedings prior to said probate decree and as in no wise disputing the fact that all of said heirs appeared in said probate proceeding after the will had been admitted to probate and even prior to the expiration of one year after such probate (Trans. pp. 235, 263, 357, 358).

8. *Probate Jurisdiction. Transfer and Continuances.*—It is also stated in the bill that various continuances of the probate proceedings were had, two of them *sine die*, and that said proceedings were transferred from Department 10 to Department 9 of said Superior Court without there ever having been published or served a notice of such continuances and transfers in accordance with Section 1303 of the Code of Civil Procedure. Appellants seek to have the probate decree treated as a nullity on this ground, although it is shown that appellants appeared at the hearing of the petition for probate and continued to appear after such continuances *sine die* without objection and participated in the proceedings until judgment, and how

long and to what extent thereafter appellants have not seen fit to say (Trans. p. 235).

9. *Probate Jurisdiction. Formal Invalidity of Will.*—The fact that the will shows on its face that the date thereon does not include a place, is made the basis of an argument to the effect that such an omission is sufficient to render the will void on its face; and that, therefore, the probate decree is a nullity notwithstanding the fact that the Superior Court acting as a probate court of general and exclusive jurisdiction, admitted it to probate, thereby adjudging said will to have been executed by decedent according to the forms of law (Trans. p. 347).

10. *Probate Jurisdiction. Disqualification of Jurors.*—And as a final objection against the validity of the probate decree it is alleged that four of the jurors were disqualified because of interest, being the secret agents of appellees Mrs. Muir and Mrs. Curtis and others, and that the judgment based thereon is totally void even though the judge who rendered the decree was qualified to act (Trans. pp. 237, 242).

11. *Probate Jurisdiction. Appellants' Theory.*—In view of these arguments, appellants contend that they are before the court in the same situation as if there had never been any probate proceedings whatsoever, and that the bill should be treated as praying only for the cancellation of the deeds and not as asking for any relief whatsoever against a

probate decree. But they do not, however, rest their case upon this position alone. They go further and, assuming the decree to be valid because rendered with jurisdiction of the subject matter, the *res*, and the parties, they ask for relief against the probate decree on a showing which they denominate as extrinsic fraud, consisting of the next following averments.

12. *Allegations of conspiracy.*—That prior to the death of Jacob Z. Davis, appellees Mrs. Muir, Mrs. Curtis and others, entered into a secret conspiracy with the purpose of seizing upon and appropriating to themselves all the property then owned by Jacob Z. Davis to the exclusion of his next of kin and heirs, and formed the design to accomplish said conspiracy by any and every means within their power (Trans. p. 216).

13. *Charge of Forgery.*—That after the death of Jacob Z. Davis appellees Mrs. Muir and Mrs. Curtis and others, by counterfeiting the hand writing of said deceased, forged the will in suit (Trans. pp. 222, 223).

14. *Averment of Spoliation of Evidence.*—That said appellees took possession of all the property and effects of deceased immediately upon his death and made a search by breaking open safes and lockers and going through the private papers and effects of deceased, and discovered and destroyed certain documents which if produced would have

proved the forgery of the will. It is also alleged that appellants broke open the urn containing the ashes of the wife of deceased (Trans. pp. 224, 225).

15. *False Testimony*.—That on May 24, 1897, appellee, John M. Curtis, falsely testified that said will was found by him on the 4th day of November, 1896, in the urn containing the ashes of the wife of decedent (Trans. p. 244).

That Alexander Boyd falsely testified that he had a conversation with decedent on October 2, 1896, in which decedent told him that he had made his will providing for the girls, meaning appellees, Mrs. Muir and Mrs. Curtis (Trans. p. 245).

That John C. Senderling, on June 14, 1897, falsely testified that the hand writing of the will in suit was that of decedent (Trans. p. 250).

16. *Suppression of Testimony*.—That said appellees so importuned William H. Senderling that he refused to disclose a conversation which he had with decedent just prior to his death, to the effect that decedent had not yet made a will. That when questioned by appellants' attorneys, said William H. Senderling refused to disclose said conversation (Trans. pp. 220, 246, 249).

17. *Disqualified Jurors*.—That said appellees procured four men as their agents to attend the trial of the will contest, who secretly caused themselves to be accepted as jurors upon said trial and

that through said jurors said appellees made and rendered said verdict (Trans. pp. 237, 242).

18. *Summary of Misconduct.*—That Mrs. Muir and Mrs. Curtis and their confederates, in furtherance of said design, and by causing four of their confederates to be members of said jury, and by preventing evidence from being introduced before said jury or in said court, and by suborning false witnesses and producing false evidence before said jury, caused the verdict of said jury to be rendered in court, and by means of said verdict caused the judgment and order of court admitting said will to probate to be made and filed.

19. *Execution and Delivery of Deeds.*—That appellees Mrs. Muir and Mrs. Curtis, in May, 1898, offered to the firm of attorneys who represented appellants \$100,000 if they would have appellants and Elizabeth Wilson and her four children execute deeds conveying all their interest in the Davis estate to said appellees, and would represent to appellants and said Elizabeth Wilson and her four children that said deeds when executed and delivered would extinguish all the interest of said claimants in and to said estate, and that said appellants accompanied said offer with the representation and threat that they would continue to hold all the property of said estate and would by means of said probate decree prevent said claimants from obtaining any of said estate unless said

offer was accepted. That said attorneys communicated said offer and representation to said claimants, who believed said representation, accepted said offer, executed said deeds and delivered them to appellees Mrs. Muir and Mrs. Curtis. It is further alleged that the money paid for said deeds was a part of said estate and that said appellees obtained said deeds by means of said probate decree while the claimants were ignorant of the technical objections now urged against it, although they had already contested the will and asserted that they knew it to be a forgery (Trans. pp. 273, 285).

20. *Averments of Fraud Concluded.*—This is a complete statement of averments upon which appellants rely to establish their claim of extrinsic fraud in the probate proceeding. But these things all took place more than ten years before this suit was instituted. Wherefore the delay?

21. *Laches.*—It appears from the bill that all the wrongs complained of except the adverse possession of the property involved, were completed in June, 1898, more than ten years before the institution of this suit. Immediately after the death of decedent, appellants sent their agent to California, who employed attorneys and contested the validity of the will, and in so doing appellants asserted knowledge on their part that said will was a forgery and that decedent died intestate, and

also spent forty-six days in court trying to convince a jury of the truth of these averments. They then and there asserted that they knew a fraud was being perpetrated upon them by means of said alleged forgery, and the alleged perjured testimony of various witnesses to the effect that said will was genuine. They had knowledge of these alleged facts when they executed and delivered the deeds releasing their claims, and made such releases with the belief and understanding that they were surrendering all their rights in said estate. With knowledge of said alleged wrongs they surrendered their alleged rights, and acquiesced for more than ten years. It further appears that meanwhile appellees have occupied and held the exclusive possession of the property involved (Trans. pp. 267, 273).

22. *Alleged Excuses for Laches.*—Appellants seek to avoid the lawful consequences of this long lapse of time by alleging that they resided outside the State of California, were poor and unable to come here and ascertain the facts in the case, but it is further shown by the bill that they were represented by agents and attorneys here until the execution and delivery of said deeds, and they appear to have been well represented in view of the allegation that \$12,500 was expended in the preparation and assertion of their claims (Trans. pp. 197-200, 233, 234).

23. *Ignorance of California Law and Defects in Judgment.*—Notwithstanding the fact that appellants were represented here by their agents and attorneys, it is also averred that appellants were ignorant of the organization and character and practice of the Superior Court and of its various departments, and of the orders of court transferring said probate proceeding from Department 10 to Department 9 thereof, and of the various orders continuing the hearing of said probate proceeding *sine die*, although those things were matters of law and of public record. It is also alleged that appellants and their attorneys in the will contest were ignorant of the law of California relative to the dating of olographic wills, and that appellants were likewise ignorant of every invalidity and defect in the judgment and order purporting to admit said pretended will to probate and consisting either of the said court's want of jurisdiction of the subject matter of said probate proceeding or of any omission or insufficiency of notice or of any irregularity in the empanelment of the jury, until the 25th day of June, 1906, although it is further shown that these things, including the jury panel, were matters of law and of public record in the very proceeding in which appellants were represented by said attorneys (Trans. pp. 258-260).

24. *Ignorance of Alleged Destroyed Writings.*—It is further alleged that appellants never learned

of the alleged writings of Jacob Z. Davis, which it is stated were deposited by him in his safes and were destroyed by appellees Mrs. Curtis, Mrs. Muir and others, until the month of July, 1908, and it is further alleged that appellants were prevented from discovering these facts by the concealment thereof by said appellees, but it is nowhere alleged of what the said acts of concealment consisted, or how or by what means appellees discovered the alleged existence of the said writings or the alleged fact of their destruction, in July, 1908, and appellants have also failed to allege any facts or circumstances whatsoever which would have prevented them in the exercise of due diligence from having discovered said alleged facts before or during the trial of said will contest (Trans. p. 243).

25. *Ignorance of Senderling's Testimony.*—The bill also avers that the appellants did not discover the alleged fact that William H. Senderling had a conversation with decedent immediately prior to his death, in which he stated that he had made no provision by way of will for appellees Mrs. Muir and Mrs. Curtis, until in July, 1908, when it is alleged said Senderling disclosed said alleged conversation to appellants. It is further alleged in the bill that appellants made inquiry of said Senderling whether he had any knowledge relating to the issues in said will contest, but that said Senderling refused to disclose the alleged fact of said conversation with decedent (Trans. pp. 265-266).

26. *Discovery of Facts.*—The bill does state, however, that appellants obtained the information of the various matters and things of which they allege they were ignorant, through a certain attorney of San Francisco, on June 25, 1906, who gave them such information voluntarily, without employment by them. It appears from the bill that said attorney had never been employed by appellants in said probate proceeding. The bill is silent as to how or under what circumstances said attorney obtained knowledge of the alleged facts upon which appellants now seek relief, and it does not appear when said attorney obtained such information, or that he possessed any special or peculiar advantage which enabled him to ascertain said alleged facts, or that appellants' attorneys in said probate proceeding, by the exercise of ordinary diligence, could not have ascertained all the facts of which appellants claim they were ignorant and presented the same to the Superior Court in said probate proceeding. The jury panels and lists referred to in the bill were matters of public record, and it is not stated that the officer's return of the venire was not subject to inspection by appellants' attorneys at all times, nor is any fact stated to show that appellants' attorneys in said contest proceeding could not have ascertained all the facts of which appellants allege ignorance, before or at the time said probate decree was rendered except, perhaps, the testimony of Senderling (Trans. p. 262).

27. *Delay After Discovery.*—A reading of the bill reveals the fact that notwithstanding the discovery of said alleged facts on June 25, 1906, no proceeding was instituted or relief asked for in equity until the filing of this bill more than two years afterwards. Appellants allege, however, in their bill, that certain proceedings were instituted in the state courts, but by amendment expressly aver that the relief now sought was not applied for (Trans. pp. 263, 357, 358).

28. *Proceedings in California Courts.*—It is also alleged in the bill that appellants and all the other heirs of decedent appeared in the Superior Court of the City and County of San Francisco in said probate proceeding shortly after June 25, 1906, and began and thereafter with all possible diligence prosecuted, certain proceedings applying for relief to said Superior Court and to the Supreme Court of the State of California in that proceeding. That said proceedings were only an attempted appeal by appellants and said other heirs to said Supreme Court from said probate decree, and a motion by appellants and said other heirs in said Superior Court to obtain and make a bill of exceptions to be used as a record on said appeal, and an action in said Supreme Court against the judge of said Superior Court for a writ of mandamus to compel him to settle and allow said bill of exceptions. That said proceedings by appellants terminated on the 30th day of April, 1908, with the refusal of said

courts to allow any remedy (Trans. pp. 263, 357, 358).

29. *Symptoms of Decedent's Last Illness.*—The bill contains certain allegations describing decedent's last illness but does not undertake in anywise to state the cause producing such symptoms and finally death. Neither does the bill state that such symptoms were the effect of any specific or particular cause. Furthermore, the particular cause of such symptoms as are described in the bill is not a fact of common knowledge which could be assumed without a statement of such cause in the bill. No fact whatsoever is stated in the entire bill which could in any way connect appellees Mrs. Muir and Mrs. Curtis with the cause of decedent's death. The only facts stated which, according to appellants' contention, have even the remotest connection with the subject, are that said appellees desired to own the estate of decedent, that they were present with him at the time of his death and that they caused his remains to be cremated after death. But there is nothing unusual in the fact of cremation, and it was rather the natural thing to be expected in view of the further fact stated in the bill that decedent himself had only a few weeks prior to that time cremated the last remains of his own wife.

30. *Conclusion.*—It is upon this state of facts that appellants are now seeking relief and ask to

have relitigated their alleged claims which have already been presented many times to all the courts of this state and have been passed upon by the court below and are now before this court for consideration the third time. Let us proceed to a consideration of the legal effect of these allegations.

BRIEF AND ARGUMENT.

I.

Jurisdiction of Superior Court in Probate Proceeding.

31. *Introductory.*—In order to a recovery of any relief in this suit, it is necessary for appellants to establish the ultimate fact that Jacob Z. Davis died intestate. To this end the court is asked to decide that the probate proceedings set forth in the bill are absolutely void for want of jurisdiction. Various objections to support this position are urged and will now be considered.

32. *Want of Notice.*—The first objection urged in this connection is to the effect that no notice was ever given in said probate proceeding in accordance with Section 1303 of the Code of Civil Procedure. As already pointed out in the statement, such an allegation appears in the bill, but the probate decree which is also set forth decides the fact that due proof of the notice required by said section of

the statute was made at the hearing. And it further appears from the bill that appellants were present at said hearing and participated therein; they were in fact as well as in law the moving parties in said contest proceeding, and they, instead of appellees, were at that time invoking the jurisdiction of the Superior Court in this proceeding (Section 1312, C. C. P.).

34. *A final judgment finding jurisdictional facts which were in issue in an adversary proceeding made after the appearance of both parties is res judicata, and such issue cannot be again litigated.*

1 *Black on Judgments*, Section 274, and cases there cited;

Sipe v. Copwell, 8 C. C. A. 419; 59 Fed. 970.

Thus it is said in 1 *Black on Judgments*, Section 274:

“The fact of its own jurisdiction may become a matter in issue before the court, or a question which it must determine before proceeding with the case, and then its decision that it has jurisdiction is generally considered final and conclusive in all collateral inquiries. When the jurisdiction of a court depends upon a fact which it is required to ascertain in its decision, such decision is binding until reversed in a direct proceeding. Where a statute confers general jurisdiction over a class upon a particular tribunal, its decision upon the facts

essential to the existence of jurisdiction in a particular case belonging to the class will be conclusive as against collateral attack. So when a notice which is defective, or the service of which is informal, has been adjudged sufficient, the judgment rendered thereunder will not be held void in a collateral proceeding. And in case of an insufficient service of notice, if the court decides the question of jurisdiction erroneously, the judgment will be voidable but binding until reversed on appeal. The determination of the question of the sufficiency of the affidavits presented to the court as proof of the service of a summons and the failure of the defendant to answer, is a judicial determination of the question of jurisdiction, and therefore binding until set aside or reversed.”

The cases supporting this conclusion are quite distinguishable from the cases cited by appellants to the effect that the jurisdictional recitals in a judgment may be contradicted. The jurisdictional fact in those cases was not an issuable fact in controversy, but appeared in the judgment merely by way of recital and generally in the absence of the objecting party.

It therefore follows that in this case, where the issue of notice *vel non* was before the Superior Court for adjudication and the appellants were there participating in the decision on this issue, the

judgment of the court thereon has all the dignity and conclusiveness of a judgment upon any other issue in the case, is just as binding and conclusive, and appellants' allegation to the contrary must therefore be disregarded.

35. *Want of Notice Waived by General Appearance.*—Whatever may be the conclusion reached as to whether or not the bill does or can show want of the statutory notice, any such want of notice is wholly cured by the appearance of all the parties in interest in this proceeding. Appellants appeared in the probate proceeding prior to entry of the probate decree and contested the will. The remaining heirs appeared in the probate proceeding after the probate of the will and took various steps consisting of a motion to obtain a bill of exceptions and an attempted appeal to the Supreme Court. The bill does not undertake to state the nature of the appearance in said probate proceeding or to state what grounds of exception such remaining heirs sought to raise against that proceeding. In the absence of an express allegation to the contrary, the appearance will be taken to have been general, and as an inference of fact it is but reasonable to assume that said heirs other than appellants appeared for the purpose of excepting to said probate proceeding upon all the grounds of which they had knowledge and believed to be valid. If that be true, such grounds of exception include an objection against the alleged false testimony as well as an

objection to the disqualification of the jurors in that proceeding. Such an appearance therefore must have been general, and is in all respects the legal equivalent of a voluntary appearance before probate.

36. *Any appearance after final judgment, except a special appearance for the purpose of objecting to the jurisdiction alone, is a general appearance, waiving lack of notice.*

O'Dell v. Rogers, 44 Wis. 136, 174, 175, 176;

Douglass v. Pacific Mail S. S. Co., 4 Cal. 304;

Mayer v. Mayer, 39 Pac. (Ore.) 1002;

Anderson v. McClellan, 102 Pac. (Ore.) 1015;

Welch v. Ladd, 116 Pac. (Okla.) 574, 575;

Lookabaugh v. Epperson, 114 Pac. (Okla.) 738;

Burdette v. Corgan, 26 Kans. 102;

Barnett v. Holyoke, 97 Pac. (Kans.) 962;

4 *Am. & Eng. Ency. Law and Practice*, 1005.

O'Dell v. Rogers, 44 Wis. 174, deals with this point upon a state of facts identical with those in suit. A statement of the conclusion there reached is set forth in the following language:

“Has she done anything since becoming of age tantamount to an appearance at the time and place of the probate, or in assent thereto, or in recognition thereof? This court held, in *Blackburn v. Sweet, imp.*, 38 Wis. 578, and

many other cases, *in effect*, that when the moving party asks some relief which can only be granted upon the hypothesis that the court has jurisdiction of the cause and the person, this is a submission to the jurisdiction, and waives all defects in the service of process; and that where a party seeks to take advantage of a want of jurisdiction, he must object *on that ground alone*, and keep out of court for every other purpose. This is the only safe and consistent rule in all cases of a want of jurisdiction of the person, by defective service or notice, which may be waived by an appearance. In August, 1876, Emma A. Hewitt, then being of full age, joined in a petition to the county court of Milwaukee county, setting forth the want of sufficient publication of notice of the time and place of the proving of the will, and that no notice was personally served on the persons interested therein, as the only ground for showing that the county court in probate had no jurisdiction to make the order or decree admitting said will to probate. * * *

She charges that Celestia A. O'Dell and George W. O'Dell, pretending to act as executrix and executor, and Rogers, Burnham and Becher, took possession of the estate and converted it to their own use, and have never accounted; that said estate has been wrested from the petitioners and other heirs by a cunningly de-

vised system of fraud, etc.; * * * And that the decree is void for want of authority in the court to make it, and by reason of the fraud practiced upon the court and the heirs of said estate. The prayer asks, first 'that the probate of the will and all orders and proceedings in this matter be set aside'; secondly, 'and for such other and further relief as may be just and proper'. * * * The petition and complaint most fully and clearly place the said Emma A. Hewitt in the attitude which this court has so frequently held is equivalent to an appearance to the proceeding sought to be declared void for want of notice; and operate as an assent and submission to the proceedings of the court in the probate of the will and the appointment of executors. For the purposes of this case, therefore, we must hold said proceedings valid as to all the parties."

Under the facts alleged in the bill, the appearance of the remaining heirs must be taken to be general and not necessarily for the purpose of objecting only to the jurisdiction of the court, and consequently must be treated as falling within the operation of the principle just elucidated in the *Wisconsin* case.

37. *General Appearance a Valid Substitute for Notice.*—But appellants argue that notice in accordance with Section 1303 of the Code of Civil

Procedure is a prerequisite to jurisdiction of the subject matter and cannot be waived. Such a contention is undoubtedly erroneous.

38. *A general appearance in a proceeding to probate a will is the full equivalent of the notice required by Section 1303 of the Code of Civil Procedure.*

Section 1306, C. C. P.;

Abila v. Padilla, 14 Cal. 103;

Curtis v. Underwood, 101 Cal. 669;

Estate of Ricks, 160 Cal. 472;

Estate of Kearney, 13 Cal. App. 95.

Appellants make the statement in their complaint notwithstanding the decree that due proof of service was made, that the notice required by Section 1303 of the Code of Civil Procedure was never given, and it is argued that for this reason the Superior Court never acquired jurisdiction of the subject-matter of the proceeding and was therefore without power to render a valid decree; and that this is true even though all the appellants, either in person or through their privies, appeared generally and contested the probate of the will in suit. In support of this position it is contended that in matters of this kind, when the legislature provides a course of procedure, every other mode of procedure is excluded; that the notice provided for in Section 1303 is a condition precedent to the right of the Superior Court to hear a petition for the probate of a will; that such notice is the *sine qua non*

without which the court has no jurisdiction of the subject-matter, and that an appearance of the parties cannot serve as a substitute because jurisdiction of the subject-matter cannot be waived by consent or general appearance. This contention of appellants is, however, contrary to the statute and law of this state, as construed by our Supreme Court. Section 1303 as originally enacted was interpreted in keeping with the general law in regard to the service of process, in the case of:

Abila v. Padilla, 14 Cal. 103.

The appellant in that case appeared in a probate proceeding to contest a will before probate, and filed an answer to the petition. After having been defeated, he raised the point on appeal that there had been a failure of notice as required by the statute, and that the court was consequently without jurisdiction. It was decided that the point was not well taken because, said the court,

“The answer gave the court jurisdiction of the party and it is perfectly immaterial whether a citation ever issued”.

This construction of Section 1303 of the Code of Civil Procedure has since been strengthened by positive legislative enactment in Section 1306, C. C. P. That section, as originally adopted into the Code, provided simply that proof of notice must be made at the hearing. In 1873, the latter section was amended so as to require proof of notice “*unless the parties appear*”; thereby dispensing with

proof, and consequently with notice itself, in such cases. The Supreme Court had occasion to consider this section in the case of

Curtis v. Underwood, 101 Cal. 669,

and repudiated appellants' contention in the following language:—

“The clause quoted provides for cases in which a postponement has been had, *and that proof of service is not necessary as to parties who appear*, and in this latter respect is in line with the doctrine enunciated in *Abila v. Padilla*, 14 Cal. 103, where it was held *that as to parties who appeared notice was waived*.”

These decisions were lately approved in

Estate of Ricks, 160 Cal. 471,

in the following terms:—

“But appellant is not in a position to raise any question of defective issuance or service of the citation upon him on the grounds suggested, because he waived the right to object to the manner of issuance and service of the citation by voluntarily appearing in the proceeding.”

From the foregoing it must clearly appear that a general appearance of the parties in interest is a complete equivalent of the notice required by Section 1303, C. C. P.; that such an appearance effectually dispenses with such notice and clothes the

court with jurisdiction as fully as could the notice provided for in that section.

39. *Probate Decree Without Notice Not Void for Want of Interested Parties.*—The bill expressly shows an appearance of all the heirs in this proceeding at one time or another. Appellants have nevertheless disregarded that showing and argued that they alone appeared and that owing to lack of notice and the failure of some of the heirs to appear the probate decree is without jurisdiction. The authorities are to the contrary, however.

40. *The failure to give notice did not invalidate the probate decree as to appellants who appeared and contested, even though some of the heirs never appeared.*

Flood v. Kerwin, 113 Wis. 673; 89 N. W.

845; 7 Pro Rep. Ann. 672;

O'Dell v. Rogers, 44 Wis. 136;

Board of Supervisors v. Mineral Point R. R. Co., 24 Wis. 93;

Rice v. Hosking, 105 Mich. 303; 63 N. W. 311;

Jones v. Roads, 74 Ind. 510;

Lewis v. Luckett, 32 App. D. C. 188;

Reese v. Nolan, 99 Ala. 203; 13 So. 677;

Walker v. Jones, 23 Ala. 448;

In re Fay's Will, 1 Tuck. (N. Y.) 405;

Hines v. Hines, 137 S. W. (Mo.) 774;

Section 1306, *Code of Civil Procedure*;

Sampson v. Sampson, 64 Cal. 326;
In re Garcelon, 104 Cal. 570;
Ricketson v. Richardson, 26 Cal. 149;
McKinley v. Tuttle, 34 Cal. 235.

In deciding this point upon statutes and a state of facts in all respects the equivalent of those here claimed, the Supreme Court of Wisconsin has, in its decisions above cited, unequivocally negatived the position taken by appellants and has always consistently held that a decree probating a will is valid and binding as to those who appear and contest notwithstanding any failure of notice or service thereof, and lack of appearance of other parties in interest.

Flood v. Kerwin, 89 N. W. 845, dealt with a probate decree wherein the appellant who had appeared and contested the will set up the invalidity of the probate on the ground that there had been no sufficient notice of the hearing for the probate of the will there involved, and that certain heirs of the decedent had failed to appear and join in the contest. The court held that there had been no sufficient showing of the service of notice as to parties in interest not appearing, but decided that this was no cause for reversal upon appeal by those who appeared and contested, and in so deciding used the following language:

“The case is quite similar, in the particular mentioned, to *O'Dell v. Rogers*, 44 Wis. 136. In that case it was held that ‘where the proper

county court, after a hearing at the time and place duly appointed therefor, has admitted a will to probate, issued letters testamentary to the persons named in it as executors, etc., the proceedings, while invalid as to persons not duly notified who did not appear or assent to them, and have done no acts of ratification, are valid as to all who were duly notified, or who appeared or assented to them.' (Cases cited.) We must hold that the court had jurisdiction as to such parties as appeared in the case, including the appellant."

Rice v. Hosking, 63 N. W. (Mich.) 311, considers the point in issue under a statute similar to ours, and reaches the following conclusion:

"The failure of the probate judge to comply with the statute did not deprive him of jurisdiction which he acquired upon the filing of the petition. Parties interested in the estate were residents of Houghton county. The object of the statutory notice, while the proceeding itself is in nature in rem, is to give the heirs and legatees, and others interested in the distribution of the property of the estate, an opportunity to be heard. * * * Although the notice may be insufficient, and the proceedings declared void upon seasonable objection by a party in interest who has not waived it, yet an appearance will waive the defect, and bind all those who so appear."

In *Reese v. Nolan*, 99 Ala. 203, 13 So. 677, it was held under a statute similar to ours that the contestant in a proceeding for the probate of a will cannot object to the validity of such probate on the ground that one of the next of kin was not cited.

In *Walker v. Jones*, 23 Ala. 448, it was likewise decided that when one of the heirs at law appears and contests the validity of a will, he will not be allowed to assign for error that there were other resident heirs who were not duly notified, and who did not appear.

Appellants have cited a number of cases for the purpose of sustaining their contention that the appearance of a part only of the heirs of decedent was wholly insufficient to give the court jurisdiction to pronounce any judgment whatsoever binding upon appellants or any one else. The case primarily relied upon is the *Estate of Cobb*, 49 Cal. 599. There is nothing in that case from which any one can draw the conclusion it is cited to support. The court there held under Section 1306 of the Code of Civil Procedure prior to its amendment in 1873, that the action of the court in entering judgment in that case was *erroneous* because the court had proceeded to hear the petition for the probate of the will without proof of service of notice upon the heirs in accordance with the requirements of Section 1306 of the Code of Civil Procedure—several of the heirs not appearing to the

proceeding, and says that this was an *error*. The court there did nothing more than any court of equity would do upon the failure to join necessary parties. It has always been the practice of courts of equity when the record shows the absence of a necessary party, to require the joinder of such party upon penalty of dismissal, and such action will be taken by the court *sua sponte*. Furthermore, if such defect of parties is first noticed by an appellate court it will reverse and remand the cause for the purpose of permitting such parties to be joined.

Thus it is said in *Minnesota v. Northern Securities Company*, 184 U. S. 199, 235:

“The established practice of courts of equity to dismiss the plaintiff’s bill if it appears that to grant the relief prayed for would injuriously affect persons materially interested in the subject-matter who are not made parties to the suit, is founded upon clear reasons, and may be enforced by the court, *sua sponte*, though not raised by the pleadings or suggested by the counsel.”

The estate here involved was one over which the Superior Court could take jurisdiction and the will had been presented to it for probate. It therefore had jurisdiction of everything necessary to a decision when the cause was set for hearing, except jurisdiction of the parties, and under the authorities already cited it obtained jurisdiction of all

parties who appeared. Appellants' contention therefore amounts to no more than an objection to the lack of proper, or at most, necessary parties. That such a nonjoinder cannot be taken advantage of in this proceeding is well settled. Thus it is said in *Hines v. Hines*, 147 S. W. (Mo.) 776, dealing with a decree annulling a will where a like objection was made to the nonjoinder of parties:

“We hold that the judgment of the circuit court of Caldwell county annulling the will of Matilda A. Higgins is final, and the validity of such will cannot be relitigated in this action. It would produce an intolerable condition of affairs if parties were permitted to litigate and relitigate the same facts in different actions. To suffer such a thing to be done would be to make of the courts instruments of oppression; and ‘the law’s delay’, considered both in ancient and modern times as one of the most aggravating evils which mankind is forced to endure, would then become utterly unbearable.

“If there was a defect of parties in the will contest, that issue could have been raised in that action; but it was not. The true rule is that all matters which could have been properly adjudicated in that action are *res adjudicata* when the same matter is sought to be relitigated in another action.”

Appellants undertake to strengthen their argument in support of this proposition by citing a list

of cases to the effect that a joint judgment void as to one party for lack of jurisdiction over the person must be treated as an entirety and consequently void as to all parties. Whatever may be the law in other jurisdictions, such a proposition cannot find support under the laws of California. The case of *Junkans v. Bergin*, 64 Cal. 203, is not at all in point. The judgment there was entered by the clerk without any action of the court, and was of course entered by the clerk under the express provision of the statute which authorized him to enter judgment only in case "all the defendants have been served and have failed to answer".

The true rule as to joint judgments is set forth in *Ricketson v. Richardson*, 26 Cal. 149, and *McKinley v. Tuttle*, 34 Cal. 235, where it is held that even in a direct proceeding in the same action, the reversal of a joint judgment as to one of the parties does not vacate such judgment as against a party who fails to join in the appeal; from which it must follow that even joint judgments are not treated as such an entirety in this jurisdiction as to render a judgment void against one party invalid as to all. Furthermore, the interests of heirs and claimants under a will are not as a matter of substantive law joint, but are rather several in their nature as to each other, and there is nothing in the probate statutes of this state which requires them to be treated as other than several in a probate proceeding.

Section 1333 of the Code of Civil Procedure expressly permits a severance of proceedings for the probate of wills as to minor heirs, and it is also likewise held by the Supreme Court of this state that the interest of minor heirs is so severable that a successful contest of the probate of will by a minor heir who has not lost his right by limitation, operates to vacate the probate decree and set aside the will only as to such minor alone and does not vacate the decree as to persons *sui juris* and other minor heirs who have lost their right by limitation. Such is the decision of the Supreme Court in *Sampson v. Sampson*, 64 Cal. 327.

Appellants seek to avoid the principle announced in that case by a quotation from the *Estate of Carpenter*, 127 Cal. 582, to the effect that parties to a will contest cannot arbitrate the controversy. A reading of the extract on page 585 of the report will reveal the fact that it is merely dictum, premised by the remark that the facts which would call for such a decision did not exist. The quotation is also in direct conflict with the underlying principles announced *In re Garcelon*, 104 Cal. 570, where it is decided in effect that the interest of an heir is sufficiently severable to enable him to waive any right which he may have to contest the probate of a will disposing of his ancestor's property. In that case the agreement was made with the testator himself but it was held that the executor stood in such relation to the testator as to enable him to

claim the benefit of the waiver, and appellant's contest was dismissed.

Appellants have also cited *Estate of Smith*, 122 Cal. 462, in support of their position. But that case is obviously not controlling here because it deals with the powers of administrators to waive the rights of those whom they represent, which are limited in this respect to a few special cases. The rights involved in that case were not as in the matter under consideration, severable in any sense of the word. And the rights of the parties who there sought to obtain an adjudication by consent could not be determined independently of the rights of those over whom the court had no jurisdiction.

We therefore conclude from the foregoing principles, that the Superior Court obtained jurisdiction of the subject-matter in the proceeding to probate the will in suit and likewise acquired jurisdiction over the appellants here so that the decree of probate, as to them at least, was valid jurisdictionally, whatever may be its effect upon any person who may not have appeared.

41. *Continuances and Transfer of Probate Proceeding.*—We do not think the averments of the bill setting up a transfer from one department of the Superior Court to another and alleging continuances *sine die* can be taken very seriously as jurisdictional objections.

42. *The continuance of the hearing in the probate proceeding and transfer to another department of the same court constitute no objection to the jurisdiction of the court in that proceeding.*

In re Warfield's Will, 22 Cal. 51; 83 A. D. 49;

Estate of Davis, 151 Cal. 318, 324;

Field v. Apple River etc. Co., 31 N. W. (Wis.) 17;

Roberts v. Flannagin, 32 N. W. (Nebr.) 563.

Undoubtedly such an objection does not reach the jurisdiction of the court, even if there had been no attendance by appellants. This conclusion was reached by our Supreme Court *In re Warfield's Will*, 22 Cal. 51, 58, and was stated in the following language:

“It does not appear that the will was probated on the day specified in the notice, nor that the probating was adjourned from that day to the day when it was in fact done. But this was, at most, an irregularity, occurring after jurisdiction had been acquired, and could only be objected to on a direct proceeding to set aside the probate.”

That decision was followed in the *Estate of Davis*, 151 Cal. 318, 324, where it was approved in the following language:

“This court has held in *Estate of Warfield*, 22 Cal. 51 (83 Am. Dec. 49), that where a no-

tice of time and place of probating a will was given, the failure to adjourn the hearing from the time fixed in the notice to a later day when the matter was in fact taken up, was, 'at most, an irregularity, occurring after jurisdiction had been acquired'. We see no reason for departing from the rule so declared."

The two cases cited above from Wisconsin and Nebraska disclose the fact that the same view of the law is taken in those jurisdictions, and so far as we can find, there are no adjudications to the contrary. We therefore conclude that this objection to the jurisdiction of the Superior Court to admit the will to probate is not well taken.

43. *Formal Sufficiency of Will Res Judicata.*—It is also argued that the will is void on its face because not lawfully dated, and, consequently, the probate decree based thereon is also void. This feature of the case cannot now be litigated, even if this court had jurisdiction to decide the question, because the Superior Court has put that matter at rest by its final judgment.

44. *The validity of the will cannot be questioned in this suit, however lacking in formalities, because the decree of the probate court is res judicata as to its due execution.*

Fouvergne v. City of New Orleans, 18 How.
470;

Parker v. Brown, 6 Gratt. 554;

Robinson v. Allen, 11 Gratt. 785;
Horton v. Barto, 107 Pac. (Wash.) 191;
Wall v. Wall, 28 Miss. 409;
Bryan v. Nash, 66 S. E. (Va.) 69;
Vanderpoel v. Van Valkenburgh, 6 N. Y.
 190;
Wells v. Stearns, 35 Hun. 323;
Dublin v. Chadbourn, 16 Mass. 433.

It can make no difference in this suit whether the will as executed was in due form and complied with the law in all respects as to olographic wills. The decree of the Superior Court admitting the will to probate is conclusive as to the due execution of such will, and it cannot now be urged that the will was not properly executed. It was within the province and jurisdiction of the probate court, a court of general and exclusive jurisdiction, to determine whether or not the script presented to it as a will had been executed in such form as to entitle it to probate, and the affirmative decision of the court on this point cannot be questioned. It cannot be the law of the State of California that when a script is presented to the Superior Court and admitted by it to probate, thereby establishing the due execution and formal validity of the instrument probated, it can afterwards be decided, by other courts administering either common law or equity, that the decision of the probate court upon issues peculiarly and exclusively within its province is a nullity to be disregarded, notwithstanding the stat-

utes of this state have asserted that such an adjudication shall be conclusive. If appellants' contention in this regard be true, it becomes the duty of every court passing upon titles based upon decrees of probate to determine whether or not the will was lawfully and properly executed. But the law imposes no such duty upon courts of equity and common law after the will has been probated. They are required by law to accept the decision of the probate court upon this issue as *res judicata* and conclusive. This is especially true of the federal courts.

Thus it was decided in *Fouvergne v. City of New Orleans*, 18 How. 470, 473, that the federal courts will not consider objections to the legal sufficiency of an instrument as a will where the same has been admitted to probate. In that case appellant made various objections to an instrument which had been probated as a will and urged that "the legal formalities were wanting which were necessary to its validity" as a will. But the Supreme Court of the United States refused to consider such objections, and in doing so used the following language:

"That question, in our opinion, is closed by the decree of the alcalde. That decree declares the will to be valid and subsisting, and directs its execution. We are obliged to treat the decree as the judicial act of a court of competent jurisdiction. In fact, it was the only judicial

authority in the province of Louisiana, except that exercised by the governor.

“This decree remains in full force, never having been impeached, except in this collateral way. The courts of the United States have no probate jurisdiction, and must receive the sentences of the courts to which the jurisdiction over testamentary matters is committed, as conclusive of the validity and contents of a will.”

So in the case of *Robinson v. Allen*, 11 Gratt. 785, the court had before it a will appearing upon its face to have been made by a married woman but which had regularly been admitted to probate in the proper court. But the court refused to consider whether or not the will upon its face was valid because this point had already been concluded by the decree of the probate court, which was held to be binding. In discussing the point the court there used the following language:

“It is well settled by the decisions of this court, that the sentence of a court of probate, of competent jurisdiction, admitting a will or writing in nature of a will, to probate, is conclusive evidence of the due making thereof, and that it cannot be denied in any collateral proceeding touching the will; that its validity can be tested only by resorting to the means provided by law for that specific purpose.”

The same conclusion was reached in *Parker v. Brown*, 6 Gratt. 554, where a will came before the court collaterally which had been admitted to probate notwithstanding the fact that it was attested by only one witness, and it was argued there as here, that the probate was void because of the informality of the execution of the will. The Supreme Court of Appeals of Virginia held, however, that the probate decree was decisive of the validity of the will and that the issue cannot be again adjudicated.

In *Horton v. Barto*, 107 Pac. 191, 194, the same point was made and disposed of as follows:

“It is contended that the will of Annie Collins is void because of a failure to comply in its execution with section 4596, Ballinger’s Ann. Codes & St., which provides: ‘Every person who shall sign the testator’s or testatrix’s name to any will by his or her direction shall subscribe his own name as a witness to such will, and state he subscribed the testator’s name at his request.’ It is argued that the will upon its face bears evidence of having the name of the testator subscribed thereto by some person other than herself and hence there should have been indorsed thereon a statement by the person so subscribing the testator’s name as provided by this section. We regard this contention as presenting only a question which was before the court upon the probating of the will

and which might have been again presented to the court within the year allowed for contesting the will. Section 6110, Ballinger's Ann. Codes & St. The probating of a will is a judicial act, and as such it cannot be avoided or set aside save in the manner provided by law."

In *Wall v. Wall*, 28 Miss. 409, 413, an instrument on its face purporting to be a deed had been admitted to probate notwithstanding the fact that it had not been executed with all the formalities required of a will, and it was sought in that suit to question the validity of such instrument as a will notwithstanding it had been probated. But the Supreme Court of Mississippi held that this could not be done, and in so deciding used the following language:

"It cannot be denied that it was entirely within the jurisdiction of the probate court to pronounce whether the paper was a will or not; and no principle of law is more firmly settled than that, however erroneous as a legal judgment that decision may be, it cannot, while it stands in full force and unreversed, be called in question in a collateral proceeding, because that court had the power to settle the question. And this rule has been often declared by courts of the highest authority, and frequently in reference to judgments the most palpably erroneous, but within the jurisdiction of the courts which rendered them."

Wells v. Stearns, 35 Hun. 323, 324, states the principle involved succinctly in the following language:

“The will proven included this writing as part of it, and if the adjudication was erroneous it became without an appeal the law of the case even if it be not the law of the land.”

In view of the fact that the jurisdiction of the superior courts of this state sitting in probate is in rem, general and final and immune from collateral attack, it seems clear from the foregoing authorities that the decree probating the paper propounded as the last will and testament of Jacob Z. Davis, deceased, cannot now be declared or treated as void for lack of proper execution whatever might have been the conclusion reached upon appeal from the probate decree. The question involved in deciding the validity of an instrument offered as a will is not one of jurisdiction. The Superior Court had jurisdiction to decide whether or not the instrument constituted a will, and even if the instrument propounded had shown on its face that it was not sufficient as a will, the Superior Court nevertheless retained its jurisdiction to decide that proposition, and its decision however erroneous, is therefore not subject to collateral attack for want of jurisdiction.

Appellants undertake to maintain the negative of this proposition by the citation of cases from Georgia and Pennsylvania. Whatever may be the

basis of those decisions, whether it be because probate decrees are there rendered by courts of inferior and limited jurisdiction, or because it is not within the province of such probate courts to decide upon the validity of the will, such decisions cannot in any event be accepted as the law of this jurisdiction because the Superior Court of California sitting as a court of equity or common law, certainly cannot claim any superiority over itself sitting as a court of probate, to determine whether or not a will has been duly executed. And under Sections 1333 and 1908 of the Code of Civil Procedure making probate decrees conclusive as to all issues determined by such decree, the decree becomes the law of the particular case and conclusive as to the validity of the will whatever informalities may have existed.

Upon familiar principles of *res judicata* we therefore conclude that the question whether or not the will was properly executed is no longer an open one and cannot now be considered by this court.

45. *The Will is However Properly Dated and Valid on its Face.*

Estate of Chevallier, 159 Cal. 161;

Estate of Plumel, 151 Cal. 79;

Estate of Clisby, 145 Cal. 408;

Estate of Fay, 145 Cal. 82;

Estate of Lakemeyer, 135 Cal. 28;

Ladd's Estate, 94 Cal. 670;

Estate of Soher, 78 Cal. 478;

Estate of Skerrett, 67 Cal. 586;

Estate of Billings, 64 Cal. 427;

Estate of Barton, 58 Cal. 538;

Succession of Robertson, 49 La. Ann. 868;

21 So. 586; 62 Am. St. Rep. 672.

If the court should see fit to examine the point raised by appellants' questioning the validity of the will on the ground that it was not properly executed because not sufficiently dated, an examination of the cases cited here will show conclusively the groundlessness of appellants' objection and likewise prove the will to have been duly executed. The briefs heretofore filed by appellees have already discussed the law on this point fully and made use of the cases here cited. We shall therefore submit this point without further discussion since appellants are without any authority whatsoever militating against the cases cited.

46. *Disqualification of Jury*.—It is alleged that four of the jurors in the will contest were disqualified because of active interest in appellees' success. Upon this averment appellants ask the court to decide that such a state of facts would render the probate decree void for want of jurisdiction.

47. *A Disqualification of any or all of the Jury Who Tried the Will Contest Does Not Affect the Validity of the Probate Decree*.

Dimes v. Grand Junction Canal, 3 H. L. Cas. 759, 785;

Phillips v. Eyre, L. R. 6, Q. B. 1, 22;

Heydenfelt v. Townes, 27 Ala. 423;
McMillan v. Nichols, 62 Ga. 36;
Moses v. Julian, 45 N. H. 52; 84 A. D. 114
 and note;
 2 *Pollock & Maitland's Hist. Eng. Law*,
 pp. 541, 623, 665;
Foreman v. Hunter, 59 Ia. 550; 13 N. W.
 659;
Clark v. Drain Commissioners, 16 N. W.
 (Mich.) 167;
Johr v. People, 26 Mich. 427;
Mize v. Americus Co., 34 S. E. (Ga.) 583.

A great many cases are cited to the effect that a decree or judgment rendered by a judge disqualified by reason of an interest in the subject matter of the suit or decree to be rendered therein, is void. The result in all these cases is based upon statutory enactment and is contrary to the common law rule. At common law, however deeply interested a judge may have been in any proceeding pending before him, his decision or judgment was not for that reason void, but was at most voidable. Thus it is said in *Dimes v. Grand Junction Canal*, 3 H. L. Cases 759, 785:

"I have to state the unanimous opinion of the judges, that in the case suggested the order or decree of the Lord Chancellor was not absolutely void on account of his interest, but voidable only."

The same conclusion was reached in *Phillips v. Eyre*, L. R. 6 Q. B. 22, where it is said:

“In the latter, as a rule, the judgment of an interested judge is voidable and liable to be set aside by prohibition, error, or appeal, as the case may be; but it is not absolutely void, and persons acting under the authority of such a judgment before it is set aside by competent authority would not be liable to be treated as trespassers.”

So it was said in *Moses v. Julian*, 45 N. H. 52, which was a case where the judge who admitted a will to probate was a party in interest:

“At common law the recusation of a judge does not affect the jurisdiction, but is merely ground to set aside the judgment on error or appeal (cases cited); except in cases of inferior tribunals, where no writ of error or appeal lies. The language of statutes may be such as to render the proceedings void (cases cited); otherwise, in courts of common law jurisdiction, they are generally voidable only (cases cited).”

Assuming then that the jurors stood upon the same basis as a judge in relation to the proceedings before them (which of course is not true) the judgment in this case would not be void because there is no statutory enactment imposing such a conse-

quence against judgments rendered upon verdicts returned by disqualified jurors.

The jury occupies a relation to the judgment altogether different from that of a judge. Although the verdict constitutes the basis for the judgment, it is, however, no part of the judgment and must be approved and adopted by the court before any judgment can be entered thereon; and this is peculiarly true of special verdicts, such as are rendered in will contests. Any irregularity in the jury rendering the verdict cannot therefore be treated as sufficient to render the judgment void. Thus it is said in *Foreman v. Hunter*, 59 Ia. 550, 13 N. W. 659:

“A judgment rendered by a disqualified jury is erroneous, but not void. It might be reversed upon appeal, but it cannot be disregarded as nullity. In Cooley’s Constitutional Limitations (2nd Ed.) 410, it is said: ‘Even the denial of jury trial in cases where that privilege is reserved by the constitution does not render the proceedings void, but only makes them liable to be reversed for the error.’ ”

To the same effect is the case of *Clark v. Drain Com’rs*, 16 N. W. (Mich.) 167, where the case last cited is approved and the following language used:

“Complainant was present when the jurors were chosen. He took no exception, but on the

contrary aided in striking the panel, and declared himself satisfied with it."

The rule under consideration is also well stated by Judge Cooley in *Johr v. The People*, 26 Mich. 426, 429, in the following language:

"Neither our constitution nor our statutes regard it as essential to the protection of the rights of parties in civil cases, that they should have their controversies determined by jury, or, that if they do, the jury should be the common-law tribunal of twelve. The party may not only assent to a trial by less than twelve, but he may wholly waive the jury, and the statutes go even further, and hold him to have waived the right whenever he has not expressly demanded it: Com. L. 1871, Sec. 4961. This being the case, it is not improper to hold the party insisting upon his right to a common-law jury of due competency, to strict vigilance in guarding the right, while the jury is being impanelled. Neither the officers of the court nor the court itself, is under the same obligation of caution and vigilance in the protection of his interests that the law expects in cases of alleged felony, and he is justly expected to ascertain by his own inquiries whether the jurors are such as he is satisfied with or not. If he sees fit to rely upon the evidence of competency afforded by the fact of their being summoned, he may, with the utmost propriety, be held to

this election. It is not a mistrial in his case, as it would be in case of felony; but it is at most only an irregularity which he might have discovered and obviated by the proper vigilance. The time for him to make the necessary inquiries into the qualifications of jurors, is before the trial, and not afterwards."

To the effect that the verdict itself as distinguished from the judgment is not rendered void by reason of the disqualification of jurors returning it, see the case of *Mize v. Americus, etc. Co.*, 34 S. E. (Ga.) 583, 584, where it is said:

"The fact that a juror who tried a case was disqualified on the ground of relationship does not render a verdict void, but only voidable, and can be set aside only in the method prescribed by law."

48. *Summary of Jurisdictional Objections.*—This completes a review of appellants' objections to the validity of the probate decree on jurisdictional grounds. The Supreme Court of this state has unanimously decided that the probate decree is valid on its face (*Estate of Davis*, 151 Cal. 318, 363), and as appears from this review of appellants' objections they have alleged nothing whatsoever off the record affecting the jurisdictional validity of the decree. We shall therefore proceed to consider other features of the case.

II.

Probate Decree Made Without Extrinsic Fraud.

49. *Introductory.*—Having shown that the probate decree possesses all the necessary jurisdictional requisites, we come now to a consideration of the alleged acts of fraud and the sufficiency of such averments to entitle the appellants to any relief in this suit. Waiving for the nonce all questions of equity jurisdiction in this action, and treating the probate decree from the standpoint of an ordinary judgment, we will undertake to show that all the averments in the bill, taken both separately and as a whole, do not come within the principle contended for and were therefore finally and conclusively determined against appellants by the probate court.

50. *Alleged Fraud Wholly Intrinsic.*—We have already set forth the substance of appellants' averments on this point, and it is now sufficient to say that when taken with every intendment in their favor, they consist of the alleged forging of the will, the alleged perjured testimony in support of its probate, the alleged destruction of certain documentary evidence and the alleged suppression of oral testimony refuting the validity of the will and alleged misconduct preventing a fair jury trial; and that all these things were done secretly and pursuant to a conspiracy.

51. *Forgery of Will, Perjury, Destruction and Suppression of Evidence Constitute Intrinsic Fraud, and a Judgment Procured by Such Means is Conclusive and Binding, Even in Equity.*

State of California v. McGlynn, 20 Cal. 233;
81 A. D. 118;

Langdon v. Blackburn, 109 Cal. 19; 41 Pac.
814;

Tracy v. Muir, 151 Cal. 363, 370;

Del Campo v. Camarillo, 154 Cal. 647, 662;

Broderick's Will Case, 21 Wall. 503;

United States v. Throckmorton, 98 U. S. 61;

Baker v. Wadsworth, 67 L. J. Q. B. N. S.
301;

Flower v. Loyd, L. R. 10 Ch. Div. 327;

Pico v. Cohn, 91 Cal. 121.

52. *Alleged Forgery Not Extrinsic Fraud.*—This court is already too familiar with the decisions cited to require quotation therefrom in support of this point, and no authority has been cited by appellants to the contrary. *Broderick's Will Case*, 21 Wall. 503, and *State of California v. McGlynn*, 20 Cal. 233, are the leading cases in this country to the point that the forgery of a will does not constitute extrinsic fraud for which the decree probating such forged will can be questioned. These cases have been accepted as the settled law in every case where the point has arisen. Nothing therefore remains for inquiry on this point except to determine whether or not the additional charges of per-

jury, destruction and suppression of evidence when joined with the charge of forgery can operate to take the case out of the rule there announced.

53. *Alleged Perjury Not Extrinsic Fraud.*—Obviously the probate of a forged will could hardly be obtained in the absence of perjury because the witnesses to the due execution of a will are required to identify the instrument and swear that they as well as the testator executed the writing. It must also be true that in every such proceeding the truth is concealed and suppressed, and it would be hard to imagine a case where the facts were not embodied in some form of evidence which must also have been likewise concealed and suppressed. It certainly can make no difference whether the concealment was accomplished by hiding, disguising or the absolute destruction of the instruments of evidence or the actual evidence itself. It must follow, therefore, that these cases which deal with the question of forgery alone are also good authority in this suit in which the alleged concomitant facts are also urged. We have, however, taken the trouble to collect cases dealing specifically with the incidental wrongs which exist in every case involving forgery and perjury, such as conspiracy, concealment, suppression and destruction of evidence. To these cases we now invite the court's attention.

54. *Alleged Conspiracy Not Extrinsic Fraud.*—In dealing with allegations of conspiracy in a complaint identical with the bill here, it was decided by

our Supreme Court in the case of *Tracy v. Muir*, 151 Cal. 363, 373, that such allegations could not be relied on or used to constitute extrinsic fraud, and in coming to such conclusion used the following language:

“The allegations as to conspiracy add nothing to the legal effect of plaintiff’s complaint. The sum and substance of that complaint is that she has been deprived of property to which she would have succeeded as heir, by means of a false and forged will, established in the court having the jurisdiction to determine as to its validity by prejured testimony. Whether or not the forgery and perjury were the result of a conspiracy appears to be entirely immaterial in determining her rights to pursue the property in the hands of the beneficiaries. We are unable to see, as suggested by counsel for plaintiff, that such a conspiracy could operate to change what would otherwise be intrinsic fraud into extrinsic fraud.”

55. *Allegations of Concealment and Destruction of Evidence Insufficient.*—The allegations in the bill relative to the suppression or concealment of the testimony state merely a negative and less vicious form of perjury, and since perjury can not be used as the basis of relief against the judgment, the suppression of testimony is therefore likewise unavailable. Such was the adjudication in *Del Campo v. Camarillo*, 154 Cal. 647, 662, where it is said:

“The fraud here complained of consisted of producing this will to the court, introducing evidence establishing its due execution and in avoiding a disclosure of the alleged attempted revocation and fraudulent preservation thereof. All these were facts relating to the validity of the will, which was the very fact to be then determined by the court. This character of fraud comes within the same class as perjured testimony or the fraudulent production and proof of a false will previously forged. The only remedy for a fraud so committed is the remedy afforded by the probate statute, that is to say, a proceeding to contest the will and to revoke the probate thereof, which under section 1327 of the Code of Civil Procedure may be begun within a year after such probate. This short limitation is made in order to prevent the unsettling of titles and the re-opening of contests over estates of deceased persons.”

The same conclusion is stated in *Volume 6 Pomeroy's Equity Jurisprudence*, Section 656, where it is said that “to the average mind it will seem that an act of falsehood is stronger ground for relief than passive concealment”. Furthermore, in this case appellants and appellees occupied the position of adversaries in the probate proceeding and appellees were therefore under no duty whatsoever to disclose to appellants any evidence in their favor.

Thus it is said in *6 Pomeroy's Equity Jurisprudence*, Section 654:

“Fraudulent concealment is some times relied upon as a ground for equitable relief against judgments. In order that concealment shall be ground for any equitable relief, there must be a duty to disclose. Ordinarily when there are two parties on an equal footing before the court there is no such duty.”

Parties to litigation cannot be adversaries and at the same time under a duty to disclose to each other, because the moment that duty arises the law forbids the adversary litigation and estops the parties from claiming against each other.

56. *No Fiduciary Relation Between Parties to Will Contest.*—Appellants try to avoid the operation of the principle just stated by arguing that Mrs. Curtis by virtue of her appointment as special administratrix of decedent's estate became a trustee for the heirs, and that consequently the alleged frauds under consideration and which, under all the authorities, must unquestionably be treated as intrinsic, thereby became extrinsic and, therefore, constitute the basis for equitable relief.

In this connection it is contended that until the probate decree was rendered the decedent must be considered as having died intestate and that prior to the entry of said decree the estate must be considered as property belonging to decedent's heirs,

and that since Mrs. Curtis was special administratrix during that time, she therefore became an express trustee for the heirs of decedent. This conclusion is obviously erroneous for two reasons. In the first place it is well settled law that when a will is admitted to probate the decree operates by relation and takes effect as of the date of the death of decedent and enables the will to vest title in the devisees and legatees from and after decedent's death, as effectually as if they had taken as heirs.

In the second place a special administratrix is not a trustee for only those claiming as heirs, but is a special trustee for the persons who may eventually be entitled to the estate upon distribution, whether such persons be heirs, devisees or creditors; and no authority is needed to refute the contention that a special administratrix appointed before a will is admitted to probate is under any duty to take sides in a will contest or aid any one to establish his rights in the estate whether he claims such rights as heir or as devisee.

Furthermore, a special administratrix is at most a special trustee and is under no duty whatsoever towards even the persons whom it may ultimately be decided are entitled to the property except to care for the property and preserve it intact. Such a duty can in no wise estop a special administratrix from asserting any beneficial interest which she may have in the estate against any adverse claim-

ant of such estate whether such claimant bases his title upon a will or under the law of succession.

The cases cited by appellants in support of their contention on this point are wholly inapplicable. There is, of course, no disputing the proposition that a trustee after his appointment cannot acquire an interest in the subject of his trust adverse to his beneficiary, but such a rule of law certainly does not prevent a special administratrix or any other person holding property for unknown or unascertained beneficiaries from asserting and establishing according to forms of law the fact she is herself the beneficiary for whom she holds; and this is especially so where she does not receive her appointment from any one claiming as beneficiary and never in any wise acknowledges any one other than herself to be a beneficiary, having received her appointment and authority thereunder at the hands of a court of justice on the theory no doubt that she was herself the real beneficiary and was taking the estate to preserve it for her own ultimate benefit. If the position contended for by appellants were true, a special administrator, an executor or a receiver of an estate, would be estopped from asserting and establishing against the estate which he represents any and all rights and claims whatsoever which he might have had in or against it prior to assuming his trust.

The case of *Sohler v. Sohler*, 135 Cal. 323, is cited by appellants. But this case does not rest the duty

to disclose facts upon the delinquent party there because she occupied the position of executrix, but because she was the mother and guardian of minor children who were defrauded. Hence it is said in the opinion on page 327:

“As executrix merely, it might be argued that she was a disinterested party, having no concern whatsoever in the question of heirship or right of distribution, standing indifferent between the parties, and interested only in carrying into effect the determination of the court upon these questions. But, as the mother and natural guardian of these plaintiffs, her position was a very different one.”

It was because of this duty imposed upon her both by nature and by municipal law giving her the guardianship of her minor children that her acts of concealment which prevented the minor heirs from appearing in the proceedings for distribution of the estate, were declared to be extrinsic fraud. The fraudulent acts there set up were moreover of a type altogether different from those in this suit. The fraud there was such as to prevent the parties in interest from appearing in court and claiming their rights; whereas, the alleged fraud averred here consists in a failure to disclose testimony pertinent to the issues.

In *Wingerter v. Wingerter*, 71 Cal. 105, cited by appellants, no claim to the estate was made by the administrator adversely to the heir and he had al-

ways acknowledged that he was trustee. There is nothing in that case which undertakes to say that the administrator was under any duty whatsoever to disclose to the heir any defects or objections in any claim which he held against the estate or to the effect that in so far as any such claim was concerned, he was not entitled to all the rights and remedies in its prosecution which he would have had if he had not held the position of administrator; or that his position as such administrator imposed any duty whatsoever upon him to disclose evidence to his adversaries.

It is also argued by appellants that appellees, Mrs. Muir and Mrs. Curtis, by reason of having taken possession of the property of decedent, became trustees *ex maleficio* or *de son tort*, and were by reason of this relation under a duty to appellants to make a full disclosure of all the facts in the suit. As appears from the bill, Mrs. Curtis, during the will contest, held possession of the estate as special administratrix. Appellants have, notwithstanding, argued in their brief that both Mrs. Curtis and Mrs. Muir occupied the relation of executrices *de son tort* in relation to said estate prior to the probate of the will. Even if such a legal conclusion could be drawn from the averments of the bill, their duties to appellants flowing therefrom were no greater than or different from those imposed by the special letters of administration. The latter argument of appellants asserting a duty on the part of appellees

to disclose said alleged acts of fraud and misconduct, must fail for the same reasons which we have already stated against the preceding argument based upon the duties of Mrs. Curtis as special administratrix.

Mrs. Muir and Mrs. Curtis at the time of taking such property, and ever since that time, have claimed the same as beneficial owners and, by virtue of the will in suit, have always denied any right whatsoever in appellants. They cannot therefore be regarded as ever having been under any fiduciary duty whatsoever to disclose any facts which they might have ascertained relative to the estate of decedent and the devolution thereof.

57. *Intrinsic Fraud no Basis for Relief.*—Appellants go further, however, and conceding for the sake of argument that the alleged fraud under consideration is intrinsic, they insist vehemently that decrees probating wills are distinguishable in this respect from other judgments; and that the law applicable to them constitutes an exception to the general principle of law in relation to other judgments which prevents the re-examination of any issue once litigated and decided. This contention is based upon the provisions of Section 4 of an act passed by the Legislature of California on March 3, 1862 (Stats. of California 1862, p. 27), which provides that the District Court shall have power

“to set aside a decree of any probate court admitting to probate any supposed will, when

such decree has been obtained by fraud, concealment or perjury”.

It is argued that this statute is still in full force and effect and that its provisions enable a court of equity to consider the evidence relating to the issues tried in will contests, and to determine whether or not the decision of the probate court upon such issues was obtained by forgery and perjury or destruction and concealment of evidence. In other words, it is contended that probate decrees are subject to review and trial *de novo* in courts of equity in this jurisdiction; and this, too, notwithstanding the fact that our statutes provide a perfect and ample procedure for the contest of wills before probate, and further provide for and authorize a likewise ample and complete remedy for the contest of wills one year after probate, and have also clothed the Superior Courts in such proceedings with all the powers and process known to either law or equity for the purpose of affording a full and adequate hearing of every issue relating to the validity of wills. It is appellants' contention, briefly stated, that a will contest, like the proverbial cat, is endowed with many lives and cannot be put to final rest until after many adjudications upon the same issue. Such a proposition is not the law.

Whatever may have been the proper construction of the section under consideration, it is no longer operative so far as this point is concerned, because

it is in this respect contrary to the express provisions of Section 1908 of the Code of Civil Procedure, and, if not before, was undoubtedly repealed by the enactment of the latter section in 1872. This section deals with the legal effect of judgments, including the probate of a will, as follows:

“The effect of a judgment or final order in an action or special proceeding before a court or judge of this state, or of the United States, having jurisdiction to pronounce the judgment or order, is as follows:

“1. In case of a judgment or order against a specific thing, or in respect to the probate of a will, or the administration of the estate of a decedent, or in respect to the personal, political, or legal condition or relation of a particular person, the judgment or order is conclusive upon the title to the thing, the will, or administration, or the condition or relation of the person.

“2. In other cases, the judgment or order is, in respect to the matter directly adjudged, conclusive between the parties and their successors in interest by title subsequent to the commencement of the action or special proceeding, litigating for the same thing under the same title and in the same capacity, provided they have notice, actual or constructive, of the pendency of the action or proceeding.”

This section gives to probate decrees not only all of the conclusiveness extended to judgments in general, but a great deal more. How then can it be argued that they are subject to re-examination because of intrinsic fraud contrary to the universal rule which prevents a re-examination of issues once litigated and determined. In order to make this contention, appellants not only disregard the general principle of law announced in the statute above quoted, but argue contrary to the fundamental maxim of probate law announced on every hand that estates should be settled without delay, the rights of parties therein speedily determined and all questions in connection therewith speedily put to rest. Appellants' position cannot therefore be considered as well taken.

58. *Breaking of Cinerary Urn.*—The allegations of the bill relative to the breaking of the cinerary urn containing the ashes of decedent's wife, cannot be regarded as fraud either intrinsic or extrinsic which in any way affects the probate decree, for the simple reason that that fact was not relevant or material to the issues there presented. If as alleged in the bill, the will is not in fact genuine and was not found in the urn, then of course it is wholly immaterial whether the same was broken or preserved intact. If, on the other hand, it is a fact that the urn contained the script which appellants have so often and so far so vainly assaulted, then how can appellants urge that appel-

lees Mrs. Muir and Mrs. Curtis committed a wrong by discovering the evidence which enabled them to come into acknowledged ownership of that which was rightfully theirs?

59. *Character of Alleged Evidence Suppressed Immaterial.*—Throughout the discussion of this feature of the case we have, for the sake of argument, accepted appellants' statement and contention to the effect that any evidence alleged to have been destroyed or suppressed was of the tenor and effect attributed to it by the bill. We have for that reason not seen fit to answer the many pages of argument of appellants' brief addressed to that point, because as appears from the cases cited, it is not the amount but the quality of the alleged fraud that determines this question. No amount of intrinsic fraud, under the law of this jurisdiction, can constitute a basis for relief in equity, even though such intrinsic fraud consists in suppressing or destroying evidence which was, in fact or under the adverse presumption arising from spoliation, of the most conclusive character.

60. *Alleged Fraudulent Jury.*—Having discussed those averments of alleged fraud which have been the subject of frequent judicial decision, we shall now take up those allegations of misconduct in relation to the jury, and will at the outset endeavor to establish the proposition that the alleged misconduct complained of does not constitute such fraud as entitles appellants to relief here.

In the first place, the alleged misconduct of appellees Mrs. Muir and Mrs. Curtis in this regard, is stated to have been accomplished before the jury was accepted and sworn to try the cause. There is no presumption of law or fact that because the name of a juror is called by the clerk he is qualified. The law and practice of this state gives to every litigant the right to examine a juror and either to decide for himself or to have the court decide for him concerning his qualifications and competency. Appellants have averred merely that said jurors *falsely represented themselves* to be disinterested and qualified jurors without alleging that they were even examined on their *voir dire* or that a single thing was done by appellants to try the issue of competency as to any of such jurors. If they were willing to accept said jurors on the mere fact that these jurors were called and took their seats, they cannot now complain, even if such appearances were false, because they had no right to rely upon them. Furthermore, since the objections assigned were a ground of principal challenge, and were in issue before the court in the presence of both parties, which issue was determined in the affirmative, even though by perjured testimony, appellants have, nevertheless, had their day in court upon such issue; and there is nothing whatsoever to distinguish the false swearing by the juror, if false swearing there was, from the alleged false testimony of any other witness in the cause. If, therefore, perjury on the other issues in the case

is no ground for relief in equity, how can it be contended that perjury supporting this issue constitutes the basis for equitable relief after the decision on this point became final; especially in view of the fact that it is only fraud apart from or collateral to any issue in the case which will support equitable relief?

The averments of this bill must not be confused with those cases where jurors have been corrupted after and not before they had been accepted and sworn to try the cause. In those cases there is, of course, ordinarily no opportunity to raise an issue to determine the legal consequences of such misconduct and the principle of *res judicata* and rule as to intrinsic fraud can have no application. If, however, misconduct of parties in relation to the jury is presented to the trial court and an issue made and trial had thereon by way of motion for new trial or otherwise, and an adverse result thereon is obtained by false affidavits, then we would have a case parallel to the one in suit. In such cases, however, it is clear that equity will grant no relief because the fraud is not extrinsic as defined by such courts.

Matson v. Field, 10 Mo. 100;

Collins v. Butler, 14 Cal. 223.

The allegation that the clerk called the names of the jurors as though they were on the jury list, when if as alleged they were not, is of no aid to appellants in this connection. The trial jury list and

the officer's return thereon were matters of record in the probate proceeding and the jury list selected by the judges of the Superior Court was also a matter of public record. Knowledge, or negligence equivalent to knowledge, of the alleged fact that four of the jurors who tried the will contest were not on the jury list, must therefore be attributed to appellants (*Quinn v. Wetherbee*, 41 Cal. 247) and they cannot be heard at this time to allege their ignorance of such alleged fact. The bill expressly alleges the existence of the trial jury list for this particular cause, and negatives any conclusion that the jurors in said probate proceeding could have been summoned upon an open venire. The lack of diligence in this respect will be taken up later under the head of laches. The showing on this point would be insufficient, we think, to justify the granting of a new trial even in the probate proceeding itself, and certainly is wholly insufficient as a fraud upon which this court could declare a trust, because such fraud or irregularity as would entitle a litigant to a new trial is not of itself sufficient to preclude the guilty party from asserting his rights whatever they may be, since the punishment imposed for such delinquency does not consist in depriving a litigant of his legal rights.

This concludes our discussion of the various allegations of fraud and misconduct charged by the bill against appellees, and brings us to a consideration of the power of the court below to take jurisdiction of and decide these issues.

III.

Probate Decree Conclusive in Equity.

61. *Introductory.*—Assuming, however, that all the alleged frauds and alleged misconduct averred in the bill, do constitute such extrinsic fraud as would in the case of ordinary judgments entitle appellants to relief in equity, we have yet to inquire whether or not this court can afford any relief in a suit of this kind, and to that end, it becomes necessary, at the outset, to determine the scope and extent of the jurisdiction of the federal court in this case over the probate of wills, and those issues of fact which must be decided to determine whether decedent died testate or intestate. In doing so, we shall undertake to determine: whether the federal courts of equity, unaided by any statutory provision, have the power to grant the relief sought, and if not, whether the original equity jurisdiction of the court has been enlarged by statutory enactments.

62. *Equity has no jurisdiction to grant relief against the probate of a will on the ground of fraud, in the absence of statute, because the granting of such relief would compel courts of equity to decide issues within the exclusive jurisdiction of probate courts.*

State of California v. McGlynn, 20 Cal. 233;
81 A. D. 118;

Broderick's Will, 21 Wall. 503;

Farrell v. O'Brien, 199 U. S. 89;

Carrau v. O'Calligan, 125 Fed. 657; 60 C. C. A. 347;

Langdon v. Blackburn, 109 Cal. 19;

McDaniel v. Pattison, 98 Cal. 86;

Estate of Walker, 160 Cal. 547.

All these cases declare that such decrees stand upon a different basis than other judgments, and it is asserted generally that the probate of a will cannot be set aside upon the ground of fraud.

It becomes material, then, to determine the extent and scope of the exception so frequently recognized, and to ascertain the nature of this distinction so far as equity jurisdiction is concerned.

63. *Is Lack of Jurisdiction Due to Lack of Remedy?*—Is it a lack of method merely, or is it a want of jurisdiction of the subject matter that differentiates a will probate from other judgments? The distinction certainly can have nothing whatsoever to do with the method of procedure, since courts of equity cannot *set aside* even judgments at law, because they have no jurisdiction over those courts or their records and could not actually *set aside* their judgments any more effectively than they could a decree probating a will.

Thus it is said in *II Freeman on Judgments*, 4th Ed., Section 485, p. 848:

“When relief is granted in chancery from a judgment at law, the interference is in all cases indirect. The judgment is not canceled nor

vacated, nor is the court of law nor its judge enjoined from proceeding, nor is a new trial granted in express terms.”

To the same effect is *I Black on Judgments*, Section 357.

A court of equity is likewise without jurisdiction to *set aside* a probate decree of distribution just as it is without power to vacate judgments at law or those of any other separate, distinct and co-ordinate tribunal. In such cases it is the practice to let the judgment stand and enjoin its execution, or if it passes title, to declare the guilty party a trustee and compel him to convey the legal title. This method of procedure is based upon the fact that courts of equity have no supervision or control over other courts of co-ordinate jurisdiction, and therefore cannot act directly upon their judgments and decrees, but must always act *in personam* upon the parties to the judgment alone.

This indirect method is therefore the usual everyday course of procedure. The much talked of exception accorded to a will probate as distinguished from other probate decrees and ordinary judgments, must undoubtedly rest upon something more than the mere method adopted in granting relief, and it must be clear when it is said in all the cases that the probate of a will cannot like ordinary judgments, be set aside, such language is used in a general untechnical sense and unquestionably means that such a decree cannot be set aside by the usual

method of declaring the guilty party a constructive trustee.

To pursue the subject further, it cannot be said that a method of granting relief constitutes an exception or distinction when such method is used in all cases. It would be simply trifling with words if a court of equity should state that it could not set aside the probate of a will, but that it could declare the guilty party a trustee and should then declare that it could set aside ordinary judgments, when such a procedure is the only method it could possibly adopt in granting relief in those cases. Evidently the immunity of decrees probating wills cannot be destroyed by any such quibble of words.

64. *No Form of Fraud Can Vitate a Will Probate in Equity.*—Since the difference in the power of equity over will probates as distinguished from other judgments in relation to fraud cannot be found in dissimilar methods of procedure, let us see if the distinction lies in the nature or amount of fraud required to bring into operation equity jurisdiction.

In the case of ordinary judgments, equity will, if the fraud be *extrinsic*, grant relief by appropriate remedy; otherwise not. Does the same rule hold true of the probate of a will? If so, and such a probate can be set aside for fraud in its procurement, then the courts have after all been merely applying the general rule and were altogether mistaken when they stated that they were dealing with

an exception. This cannot be true, because common sense teaches us that if the probate of a will can be set aside for extrinsic fraud practiced in its procurement, just as in the case of ordinary judgments according to every day methods, all the learned chancellors and jurists would not be repeating in unqualified terms for two centuries, that equity is without jurisdiction to afford relief against the probate of a will procured by fraud.

Briefly stated, we interpret such language to mean simply this, that the probate of a will cannot be set aside directly or indirectly by equity for fraud even in its procurement, because in order to set aside any kind of a judgment for fraud or to raise a trust, the court of equity must first determine whether or not the fraud works injury, that is, must decide that the guilty party has no cause and should have failed, and that the complaining party has a good cause and should have succeeded, and to do this in the case of a probate decree a court of equity would be required to decide all the issues touching the due execution and validity of the will involved.

At the time equity jurisdiction grew up and until it had reached its final maturity, it was not called upon to decide such an issue, for the reason that the entire law of wills was within the exclusive province of ecclesiastical jurisdiction until the Statute of Henry VIII provided for the devise of real property, and even then equity refused to take ju-

risdiction of issues connected with the execution of such wills. It therefore came about that equity jurisdiction was so definitely defined and limited that its lack of power to determine one way or the other the issue of testacy or intestacy, has never been doubted.

Thus it is said in *I Story's Equity Jurisprudence*, 13th Ed., p. 195, note:

“It is now well settled that a Court of Equity will not entertain jurisdiction to set aside a will obtained by fraud, or establish a will suppressed by fraud, whatever relief it may otherwise grant under special circumstances.”

And likewise in *Allen v. McPherson*, 1 H. L. Cas. 191:

“The law says that the Court of Chancery has not jurisdiction over a will of personal property; it cannot set aside a probate of personal property. Well, then, if you are not allowed to file a bill to set aside the probate, shall you be allowed, in every instance, to file a bill to declare the party in whose favour the probate is granted to be a trustee for the next of kin, or for some other party? Wherever you wish to find fault with the probate which the Ecclesiastical Court has granted, you have only to file a bill and to pray that the party in whose favour the probate has been granted may be declared a trustee. Nay, my Lords, by this process you might review the sentence of the

Ecclesiastical Court in *refusing* probate; because, let me suppose that the Court refuses probate, and grants administration to the next of kin, then, the Court having refused probate and granted administration to the next of kin, the party who claims under the will would file his bill, and would pray that the next of kin may be declared to be trustees for the legatee, and in that manner you might in every instance have an appeal from the Court of Probate to the Court of Chancery.”

To the effect that this is still the law in California, see,

McDaniel v. Pattison, 98 Cal. 86;

Estate of Walker, 160 Cal. 547.

It cannot be disputed that the trial court would have to consider and settle the issue of forged or valid will in this case before it could raise an involuntary trust and compel a conveyance. If then, equity has no jurisdiction to determine an issue of testacy or intestacy at all in the first instance *before* probate while the question is still an open one, from what mystic source can it conjure up the power to reopen such an issue after it has become *res judicata* and decide it in flat contradiction of the decree of a court established and constituted by the sovereign with exclusive jurisdiction over such issues? That the trial court has no authority to do so is made plain by the often quoted statement from the

McGlynn case, repeated in *Langdon v. Blackburn*, 109 Cal. 19, 26, as follows:

“The court of chancery has no capacity, as the authorities have settled, to judge or decide whether a will is or is not a forgery; and hence there would be an incongruity in its assuming to set aside a probate decree establishing a will, on the ground that the decree was procured by fraud, when it can only arrive at the fact of such fraud by first deciding that the will was a forgery. There seems, therefore, to be a substantial reason, so long as a court of chancery is not allowed to judge of the validity of a will, except as shown by the probate, for the exception of probate decrees from the jurisdiction which courts of chancery exercise in setting aside other judgments obtained by fraud. But whether the exception be founded in good reason or otherwise, it has become too firmly established to be disregarded. At the present day it would not be a greater assumption to deny the general rule that courts of chancery may set aside judgments procured by fraud, than to deny the exception to that rule in the case of probate decrees. We must acquiesce in the principle established by the authorities, if we are unable to approve of the reason. Judge Story was a staunch advocate for the most enlarged jurisdiction of courts of chancery, and was reluctant to allow the exception in cases of

wills, but was compelled to yield to the weight of authority.”

The only case in the English reports in any wise approaching the result sought by appellants, is the case of *Barnsley v. Powell*, 1 Vesey, Sr. 284, and the only case in this jurisdiction either state or federal that even remotely suggests such a thing is *Patterson v. Dickinson*, 193 Fed. 328.

In the first case, a will disposing of both real and personal property came before the chancellor after a jury trial on the issue of *devisavit vel non*, finding the will to be a forgery, but it further appeared that the legatee had obtained its probate in the ecclesiastical court by fraudulent practices. The chancellor did not, however, decide that there was no will and declare a trust, but compelled the forger to consent to a readjudication of his rights in the ecclesiastical court. The situation there was one which could not arise in this jurisdiction. The will had been presented to both tribunals having jurisdiction and was held by one after contest to be a forgery, but had been probated by the other by consent obtained through fraud. Such a state of facts would naturally invite the chancellor to exercise his jurisdiction to the fullest to grant all possible relief, but even with the determination of a lawful tribunal to sustain him he declared that he was nevertheless without power to determine the validity of the will.

This is the case cited by Professor Pomeroy for the statement in Section 919 of his equity treatise, to the effect that equity has jurisdiction to set aside the probate of a will for fraud in its procurement. The remaining half dozen cases which he cites are not even remotely in point, as will appear from the opinions delivered by the House of Lords in *Allen v. McPherson*, 1 H. L. Cas. 191; 9 Reprint 727, and as there appears, those cases deal with questions which determine the scope, effect and legal operation of the will and in no wise involved issues relating to the making, execution or existence of the document involved as a valid will.

The case of *Patterson v. Dickinson*, 193 Fed. 328, decided by this court on February 5, 1912, does not aid appellants in any way. The court was dealing with the probate of a foreign will in that case and was not in any sense of the word called upon to determine whether or not a will existed, that issue having been previously settled for the court of equity by the probate court of the State of Missouri. The opinion calls attention to the distinction between that case and *Tracy v. Muir*, 151 Cal. 363.

It must appear, therefore, from all the authorities, that this trial court is without jurisdiction to adjudicate the rights of the parties in this case, unless it is possessed of something more than the ordinary equity jurisdiction.

65. *Statute of March 3, 1862*.—It is argued, however, quite vehemently and at great length by

appellants, that whatever may have been the scope and extent of equity jurisdiction as it originally existed to grant relief against probate decrees, that jurisdiction has been so effectually enlarged by an act of the legislature of this state of March 3, 1862, as to enable the trial court to grant the relief prayed for.

66. *Section 4 of an Act Passed by the Legislature of California, March 3, 1862, (Stats. Cal. 1862, p. 27) was Unconstitutional and has Been Repealed.*

*Constitution of California, 1849, Article VI,
Sections 6 and 8;*

*Constitution of California 1849, Article VI,
Section 8, as amended September 3, 1862;
Statutes 1849-50, p. 217;*

*Statutes 1850-53, pp. 377, 420, 421, 585, 586,
742;*

Statutes 1855, p. 132;

Statutes 1861, p. 630;

Statutes 1863, pp. 335, 338, 346;

Code of Civil Procedure, Part III, Title XI;

Constitution of 1879, Art. VI, Sec. 5;

Code of Civil Procedure, Sec. 18;

Code of Civil Procedure, Secs. 1333, 1908;

I Sutherland Stat. Const., Sec. 270;

Pulaski County v. Downer, 10 Ark. 590;

Page v. Ellis, 18 Mass. 43;

*People, ex rel. v. Peck, 157 N. Y. 51; 51
N. E. 412;*

Mack v. Jastro, 126 Cal. 130;

Hamberlin v. Terry, 8 Miss. (7 How.) 143.

67. *Synopsis of Probate Law Prior to the Codes.*

—A reference to the foregoing sections of the constitution and statutes of this state will disclose the fact that originally probate jurisdiction was vested in the inferior courts of this state. The Constitution of 1849 gave the county judge jurisdiction of surrogate or probate matters and made provision for the trial of issues of fact in will contests before the district court. The statutes not only followed the constitutional provisions but also provided that the district courts should have appellate jurisdiction in will contest cases and should try such contests *de novo*, but the Supreme Court held this provision of the statutes unconstitutional for the reason that the constitution gave the district courts no probate jurisdiction (*Deek v. Gherka*, 6 Cal. 669).

This was the condition of the law at the time the statute under consideration was enacted. A few months after the enactment of this statute, Article VI of the Constitution of 1849 dealing with the judicial department of the state government, was amended and the various courts of this state, both superior and inferior, were reconstructed with their jurisdiction defined anew. Pursuant to the new constitution the legislature enacted a new statute which undertook to define the scope and extent of the jurisdiction of each of the courts so established in detail (Stats. 1863, p. 33). This statute purports to be general and compre-

hensive in its terms, and it is provided in Section 89 thereof that all prior acts concerning the courts of justice of this state and judicial officers are thereby repealed. Under the constitutional provisions as amended, and the Act of 1863 in conformity therewith, a separate probate court was established and given exclusive jurisdiction of probate proceedings including the probate of wills. The district courts were nowhere given authority in any probate matters whatsoever, and their jurisdiction was confined to suits in equity and actions and special proceedings at law. The provisions of Section 6 of Article VI of the Constitution as originally enacted, and authorizing the district courts to try issues of fact joined in the probate court, was *ex industria* omitted, and as a consequence the Supreme Court held in the *Matter of Bowen*, 34 Cal. 682, that the district courts possessed no jurisdiction of probate matters after the amendment of the Constitution of 1862 and the enactment of the Act of 1863, and the same conclusion was reached in the *Matter of Tomlinson*, 35 Cal. 508.

68. *Constitutionality of Statute of 1862.*—The section under discussion deals with that branch of the law of wills which belongs exclusively to the probate jurisdiction. In the first clause it is provided that the district court shall have power to set aside a will obtained by fraud or undue influence, and to declare null and void any paper purporting to be a last will, and to establish a will lost or de-

stroyed. These provisions are clearly the subject of probate jurisdiction, and under the Constitution of 1849 as originally enacted, were clearly unconstitutional as constituting an attempt to confer probate jurisdiction upon the district court contrary to the express provisions of Article VI, Section 8 of the constitution which bestowed jurisdiction of such matters upon the county court.

As already pointed out, and as is recognized by the terms of this statute, a probate decree could not be set aside without passing on the validity of the will; and since the statute was undoubtedly unconstitutional and inoperative to bestow the power to try this probate issue on the district court, it must be held likewise inoperative to vest the power to grant relief based upon the trial and determination of such an issue.

This conclusion cannot be avoided by simply designating the subject matter of this statute as equity jurisdiction. Appellants seek to do so, however, by arguing that as equity has jurisdiction of fraud generally, the frauds mentioned in this statute are therefore in a jurisdictional sense, matters of equitable cognizance. But both equity jurisdiction and probate jurisdiction, so far as fraud is concerned, each had a well defined meaning in 1849 when our state constitution clothed the district court with equity jurisdiction and bestowed exclusive jurisdiction of probate matters upon the county courts. As already pointed out, equity juris-

diction did not include this species of fraud, because it had been often declared by the courts that it belonged exclusively to the probate jurisdiction.

We therefore conclude that the statute never had any validity even at the time of its enactment; but, be that as it may, it has undoubtedly been repealed.

69. *Statute of 1862 Repealed.*—If the provisions of the statute under consideration be considered as valid at the time of its enactment, it was certainly repealed by the statute of April 18, 1863 (Stats. 1863, p. 335, 338, 346), which as we have already pointed out was enacted pursuant to the constitutional amendment of 1862, and which in accordance with that amendment, divested the district courts of such probate jurisdiction as they possessed prior to that time and vested it exclusively in the probate courts. A glance at this statute makes it apparent that it was the purpose of the legislature to cover the subject dealt with completely, and establish a judicial system in accordance with the constitutional amendment which had vested all probate jurisdiction in a separate and distinct tribunal. It must follow, therefore, that whatever jurisdiction the section under consideration which may have given to the district courts in relation to the probate of wills, was effectually divested by the constitutional amendment referred to and the statutes enacted in accordance therewith.

If it should be thought, however, that the constitutional and statutory enactments just reviewed

did not constitute a repeal of the statute under discussion, it certainly did not survive the code legislation of 1872.

The Code of Civil Procedure adopted at that time undertook to cover the subject of the estates of deceased persons and provided a remedy and procedure for every possible right which could arise in connection with such estates, including the law of escheats. The law of escheats enacted in the statute under consideration was likewise embodied in the Code of Civil Procedure but the section in suit was omitted, showing the undoubted intention of the legislature to repeal the same so far as it had any relation to that subject.

The same code not only provided generally a complete procedure for the administration of estates, including the probate of wills, but contains a chapter dealing specifically with will contests *after probate*, and is therefore shown not only to have dealt with the subject in a general way, but descended into the very particulars which, it is claimed, are covered by the statute in controversy. It therefore appears that the legislature possessed the intention to provide for will contests, and, as appears from Sections 1327 to 1333, did so very elaborately.

That such legislation operated to repeal the section in suit cannot be doubted. A great many cases could be cited, but we think a few will suffice. Thus it is said in *I Sutherland Statutory Construction*, Section 270:

“Where one act is framed from another, some parts taken and others omitted * * * the later act operates without any repealing clause as a repeal of the first.”

The same principle is announced in *Pulaski County v. Downer*, 10 Ark. 590, where it is said:

“The authorities are abundant to support the proposition that where the legislature takes up a whole subject anew, and covers the entire ground of the subject-matter of a former statute, and evidently intend it as a substitute for it, the prior act will be repealed thereby, although there may be no express words to that effect, and there may be in the old act provisions not embraced in the new.”

It is also said in *Page v. Ellis*, 18 Mass. 43, 45:

“It is a well settled rule, that when any statute is revised, or one act framed from another, some parts being omitted, the parts omitted are not to be revived by construction, but are to be considered as annulled. To hold otherwise would be to impute to the legislature gross carelessness or ignorance; which is altogether inadmissible.”

To the same effect see *People ex rel. v. Peck*, 157 N. Y. 51.

The rule is also recognized and announced in *Mack v. Jastro*, 126 Cal. 130.

The Supreme Court of Mississippi had occasion to consider this very question in *Hamberlin v. Terry*, 8 Miss. (7 How.) 143, where the following language is used:

“Prior to the adoption of our present constitution, there was a statutory provision which authorized any party interested within a given time to file his bill in chancery to set aside a will, whereupon an issue was directed to be made up to try the validity of the will. But this was not a matter of equitable jurisdiction; on the contrary, it is testamentary in its character, and when the constitution gave to the probate courts full jurisdiction in all matters testamentary and of administration, this power was of course included in that general grant; and as the jurisdiction of the probate court is also exclusive, it follows as a matter of course that the law alluded to was virtually repealed by the constitution.”

Appellants seek to avoid this principle by asserting that the scope and effect of Section 1333 making probate decrees conclusive was limited by the section in dispute at the time of its adoption into the code, and must therefore be regarded as still subject to such limitation, although that section which appellants contend covers the same subject-matter was *ex industria* omitted. This position cannot be correct, because, as pointed out by the authorities just cited, the very effect of the omission was to relieve

Section 1333 of any limitation which may have been imposed upon it by the omitted section.

The effect of Section 1908 of the Code of Civil Procedure upon the statute in controversy has already been considered and will not be repeated here.

We conclude from the foregoing that the entire law of California governing the probate and contest of wills was embodied in the codes, and that the section relied on was not only unconstitutional when enacted but has since been repealed. Hence the jurisdiction of equity in this suit stands now just as it did when *State v. McGlynn* was decided.

IV.

Appellants' Suit Barred by Laches.

70. *Introductory.*—We are now brought to a discussion of those features of the record which, according to our view, disclose such laches as must prevent a recovery by appellants in the absence of the objections which we have already urged against their suit. In the treatment of this subject, we shall set forth briefly the pertinent allegations of the bill and discuss the equitable principles governing such a state of facts.

71. *No Facts Alleged Excusing Delay.*—A lapse of more than ten years after the transaction of the alleged wrongs transpired before the bringing of this suit. During all that time it appears consist-

ently throughout the bill that the principal fraud, the whole basis of the wrong complained of, the cause without which there could be no dispute or litigation whatsoever, to wit, the alleged forgery of the will in suit, the alleged perjured testimony and the alleged facts accompanying decedent's death, were all known to appellants. This statement must be true in view of the fact that appellants contested the validity of the will prior to probate on that issue, and if, as they there maintained, the will was a forgery, it is an irresistible conclusion that they must have known the alleged concomitant facts of perjury, fraudulent intent, conspiracy, concealment of the truth and consequently concealment of the evidence which would have established the truth according to their contention.

72. *Allegations of Ignorance and Discovery.*—Appellants seek, however, to avoid the consequences of such delay by averments of ignorance of the law of California relating to wills and their rights in the estate involved, and also of the law relating to the constitution and procedure of the Superior Courts as well as the various supposed legal objections to the record in the probate proceeding. So much for matters of law. Ignorance is also asserted of the alleged interest and disqualification of certain jurors, together with the want of knowledge of certain alleged evidence tending to establish the alleged forgery. It is further averred that this

ignorance as to the law and jury was not dissipated until June 25, 1906 (shortly after the Conflagration of April, 1906), when appellants began anew their litigation in the state courts. It is alleged, however, that knowledge of the alleged pertinent evidence was not discovered until 1908. Except as to the testimony of W. H. Senderling, it nowhere appears how that certain attorney who communicated these things to appellants ascertained such facts. Likewise it does not appear that knowledge of all those things could not have been obtained at the time the will contest was pending by the same means that they were later discovered. There is also no allegation that appellants ever took the depositions of appellees or sought by any other means to obtain a discovery of the facts in dispute.

73. *Legal Consequences of Delay.*—This showing is, we submit, wholly insufficient to take the case out of the operation of the equitable principle of laches in view of the fact that the period of limitation provided by law has long since expired and the burden was on appellants to bring forward in their bill facts excusing the delay.

It is not knowledge of the evidence and means by which the principal fraud complained of is accomplished that imposes upon a litigant the duty to prosecute his supposed rights, but knowledge or its equivalent of the principal fraud itself. It is a familiar maxim of equity jurisprudence dealing with knowledge and notice, that sufficient knowledge to put

a reasonably prudent person upon inquiry as to a principal fact is the full equivalent of knowledge itself. If that be true, then must it not necessarily be true, even to a greater degree, that when knowledge of the principal fraud exists no amount of ignorance of the evidence by which such fraud can be established will serve to excuse delay? This must be so for the simple reason that when the principal fraud is known, equity stands ever ready with its remedies for discovery to supply any such alleged want of proof. It was, therefore, the duty of appellants to come at once into court after knowledge of the principal fraud and obtained the alleged facts which were, as they aver, without their knowledge.

Even if the things of which appellants aver ignorance constituted the substance and basis of their complaint, the lack of knowledge of such things would not constitute a sufficient excuse in this case. With the exception of the suppression of the testimony of W. H. Senderling and the alleged destruction of certain documentary evidence, every want of knowledge set forth consists either in matter of law or of record in the will contest to which appellants were parties, even to the jury list which would have informed them of the alleged fact that four of the jurors were not summoned as such to try the case, but were, as alleged, imposing upon the court. Appellants will not be heard to say that they were ignorant of the alleged con-

cealed evidence, because the law imposes upon them the duty to ascertain that knowledge, and put in their hands the means of doing so; and their failure constitutes such negligence as amounts to actual knowledge. Their averments of ignorance as to the law cannot on well settled principles, be considered, and in this respect it is immaterial that they resided outside the state, because they were present in the state and participated in the probate proceeding by means of their attorneys and agents. It therefore appears, that the lapse of time began to operate against appellants' alleged rights at the time the alleged wrongs were consummated.

The question of laches must be determined upon the peculiar facts of each case as it arises. The statute of limitations provided for in the ordinary case of fraudulent practices is three years after the discovery. But different limitations are provided for various special kinds of fraudulent practices. In case of fraudulent practices in connection with jury trials the right to relief by direct application to the court in the same proceeding is limited to a very brief period, not exceeding a few days. So if relief from a judgment is sought upon the ground of prejudice in the jury or irregular or fraudulent misconduct of one of the parties in connection with the jury, the application for relief against such wrongs must be made within ten days. And if application be not made within such time, in the absence of excusable ignorance, no relief can

be had either at law or in equity. Thus we have in such a case a period of limitation different from the usual three year period, and altogether distinguishable, based upon obvious grounds of public policy as well as justice to litigants.

If, however, through accident, mistake, ignorance or other reason, resort can be had to equity for the purpose of accomplishing what could have been done in the original proceeding, why should not courts of equity insist in some measure upon the same diligence after discovery as would have been required by positive rule of law in the original proceeding after notice of the facts?

Applying this principle then, to the averments with reference to the jury which in the probate proceeding itself would have come within the purview of the remedy given by way of new trial requiring the liveliest diligence, we think this court should declare a delay of more than two years after the discovery of the alleged fraudulent jury practices such laches as will prevent it from affording any relief on that ground (*Allen v. Currey*, 41 Cal. 318).

Taking up the averments of the bill with reference to the alleged fraud connected with the merits of the case in the probate proceeding, and applying the same principle, a period of two years delay is likewise sufficient to prevent appellants from obtaining any relief in this suit. The statutes of this state give parties in interest one year after the pro-

bate of a will to contest its validity. If, then, they are able to show some excuse why the time specified for such contest should be delayed, on what grounds can they insist after the discovery of those facts which are sufficient to start the time running, that they are entitled to more than the statutory period after such discovery?

The statute limiting the time to contest wills must be accepted as conclusive here, because, as pointed out in the case of *Bartlett v. Manor*, 45 N. E. (Ind. Sup.) 1060, the whole subject of the law of wills is the creature of statute depending upon legislative enactments for its existence, and subject to any and all limitations which the legislature may see fit to impose. And the same is likewise true with reference to the law of succession. There is, therefore, nothing in any constitution to prevent the state itself from claiming as heir in all cases. If, then, it sees fit to regulate the devolution of property through wills in a particular manner, who can be heard to complain? If the state wishes to limit the right to inherit property by imposing upon heirs the duty to contest successfully invalid wills within one year after the probate thereof or to be forever foreclosed, can equity interpose and set aside the plain intent of the law?

In the case last referred to the statute limiting the time for the contest of wills was compared to other statutes which limit the time for bringing an action to assert a right created by statute, and it

was there decided that a statute like the one in suit, limiting the time to contest wills, operated just as any other similar statute, such as those limiting the time within which to bring an action under the Federal Employers Liability Act and the usual statutes creating a liability for death, and thereby destroyed the cause absolutely, leaving no right to be litigated either in law or in equity after the expiration of the time provided. In other words, it was decided that when the state gave to any one a right or an interest in the estate of a decedent, such right was to be measured by the statute, including the statutory provision limiting the time within which to assert such right, and that an exception could not be created by courts of equity.

74. *Decedent's Last Illness.*—We have already set forth in paragraph 29 of this brief, a complete statement of the averments in the bill dealing with decedent's last illness. We do not believe that it requires argument to refute the sufficiency of these allegations to charge a capital crime.

Furthermore, so far as the bill shows, appellants have always had knowledge of these alleged facts; and if they ever constituted any cause for relief, such cause has long since become barred.

It must therefore follow, that the lapse of time has long since barred any cause appellants may have had long before the institution of this suit whichever statute of limitations may be accepted by the court as the correct rule by which to measure laches in this suit.

V.

Deeds Not Subject to Rescission.

75. *General Discussion.*—The bill contains no averment whatsoever of any fraudulent misrepresentation to appellants in connection with the execution and delivery of the deeds in suit. All the averments of misconduct relate wholly to the probating of the will. The only allegation offered to distinguish the position of appellants at the time the deeds were executed from the position they now occupy, is the general statement in the bill that they were ignorant of the alleged misconduct in connection with the probate of the will. But this averment does not and cannot, in view of the entire statement of the cause, permit the conclusion that appellants made the deeds without knowledge of the alleged forgery, perjury and other alleged misconduct which comprise the real *gravamen* of the alleged fraud. On the contrary, it appears expressly, and always inferentially throughout the bill, that they not only knew but asserted those essential alleged wrongs. It must therefore follow, under familiar principles of equity making partial knowledge of any alleged fraud the equivalent of complete knowledge that appellants are, in fact, in no other or different situation at the present time than they were when the deeds were executed and delivered.

Under such a state of facts it will require the citation of no authorities to support the position

that appellants are wholly without any equitable remedy to set aside the deeds in suit, because the surrender of quiet and peaceable, though wrongful, possession of property constitutes a valuable consideration for a deed; but if it did not, it would make no difference because a deed without consideration made with knowledge of the facts, or its equivalent, is sufficient to vest absolute title when the possession of the property conveyed has passed to the grantee. If with knowledge, or means of knowledge, appellants saw fit to deed away the property to which they claim title, it would constitute at least a gift which they could not afterwards rescind. Such a statement of course, puts the situation in the most favorable light for appellants, but if such were the real state of facts, their claim would, nevertheless, be without equity.

For the reasons set forth herein, the decree, we think, should be affirmed.

Respectfully submitted,

J. C. CAMPBELL,

WALTER SHELTON,

Solicitors for Appellees Isabella M. Curtis, John M. Curtis,
Elizabeth M. Muir Mugan, William G. Mugan, and the
Jacob Z. Davis Estate Company.

No. 1899

IN THE
**United States Circuit Court
of Appeals**
FOR THE NINTH CIRCUIT

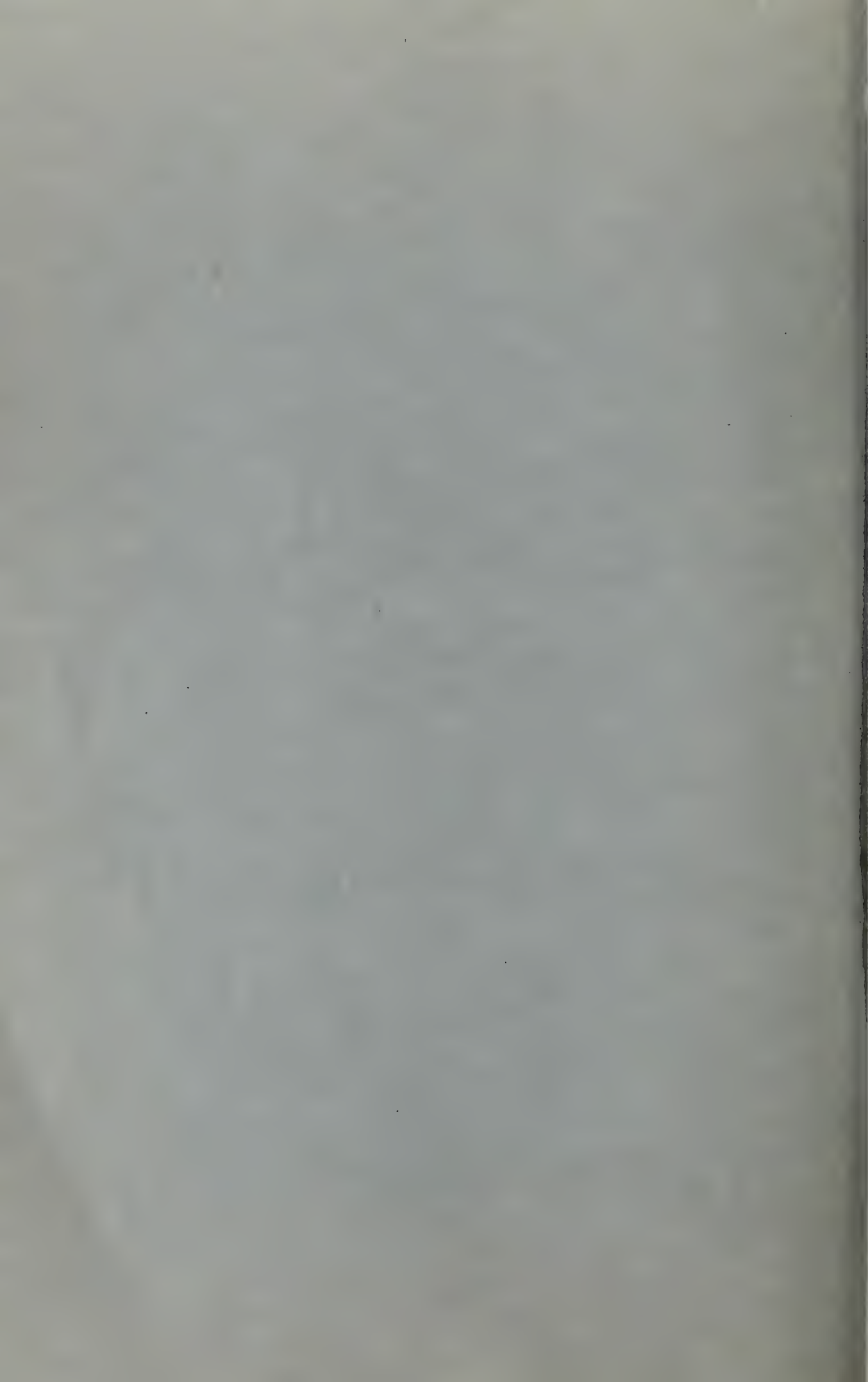
CATHERINE D. STEAD ET AL.,
Complainants and Appellants,

VS.

ISABELLA M. CURTIS ET AL.,
Defendants and Appellees.

**A FURTHER LIST OF
ADDITIONAL AUTHORITIES IN SUPPORT OF
APPELLANTS' BRIEF.**

HORACE W. PHILBROOK,
Solicitor for Appellants.



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ADDITIONAL AUTHORITIES IN SUPPORT OF
APPELLANTS' BRIEF.**

The following additional authorities (a second list) are applicable to some, respectively, of the positions stated in the Brief for the Appellants.

The section numbers herein employed correspond, of course, to those in that Brief.

§ 354. A probate of will without notice is void; and is equally void as regards that portion of the heirs who appear in the proceeding.

a. On this point, the decision in *Estate of Cobb*, 49 Cal. 599, being the decision of the State Supreme Court on a statute of the State, is to be taken as settling the question in the Federal courts.

Union and Planters' Bank v. Memphis, 189 U. S. 72.

b. It is an elementary rule of law that every Court of the United States is absolutely bound to accept and administer that meaning and effect of any statute of a State which the highest Court of that State has by its decision decided to be its meaning and effect.

In *Leffingwell v. Warren*, 2 Black (67 U. S.) 603, for example, the Court say:

“The construction given to a statute of a State by the highest judicial tribunal of such State, is regarded as part of the statute, and is as binding upon the courts of the United States as the text.” (Citing authorities.)

That rule of law has been settled for more than four score years, and the following, running back to the year 1826, are some of the rulings in which it has been expressly laid down:

Chicago &c. Ry. v. Minnesota, 134 U. S. 456;

Bucher v. Cheshire Ry. Co., 125 U. S. 555;

Burgess v. Seligman, 107 U. S. 33;

Scipio v. Wright, 101 U. S. 675;

United States v. Fox, 94 U. S. 321;

Railroad Co. v. Railroad Co., 20 Wall. (87 U. S.) 138, 150;

Leffingwell v. Warren, 2 Black (67 U. S.) 599, 603;

Van Rensselaer v. Kearney, 11 How. (52 U. S.) 318;

Williamson v. Berry, 8 How. (49 U. S.) 559;

Nesmith v. Sheldon, 7 How. (48 U. S.) 818;

Massingill v. Downs, 7 How. (48 U. S.) 767;

Green v. Neal, 6 Pet. (31 U. S.) 299;

United States v. Morrison, 4 Pet. (29 U. S.) 137;

DeWolf v. Rabaud, 1 Pet. (26 U. S.) 501;
Bell v. Morrison, 1 Pet. (26 U. S.) 351;
Shelby v. Guy, 11 Wheat. (24 U. S.) 361, 367.

c. The language, "This was error," used by the Court in *Estate of Cobb*, 49 Cal. 599, can not truthfully or honestly be taken as indicating that the probate was only *voidable*. To do so, would be to seize on the form of an expression to pervert its meaning. Courts commonly speak of a *void* judgment as *erroneous* and commonly speak of a want of jurisdiction as "error," and such was the usage especially at the time (1875) when that decision of *Estate of Cobb* was made.

The following are examples where the *nullity* of a *void* judgment is spoken of by the courts as *error*:

Mutual Life Ins. Co. v. Clover, 36 Mo. 392;
Wood v. Smith, 11 Tex. 367;
Winslow v. Lombard, 57 Me. 357;
Penobscot R. Co. v. Weeks, 52 Me. 457;
Buffum v. Ramsdell, 55 Me. 252;
Brockman v. McDonald, 16 Ill. 112.

d. In *Estate of Cobb*, 49 Cal. 599, the Court could not have considered the want of notice in the probate *except on the ground that the probate*, from having been made without notice, *was equally void as regards the one heir* (the appellant) *who had voluntarily appeared*. For the express provision of Code of Civil Procedure of California (Sec. 938) was then in force, that *the appellant* must be "aggrieved" by the ruling reviewed. That express provision of the Code was taken *verbatim* from the

former Practice Act of April 29, 1851, where it may be seen in Cal. Stats. of 1851, p. 104.

That provision that *the appellant* must be "aggrieved" was expressly applied to probate appeals by the Act of May 7, 1855, which was afterward made Sec. 1714 of the Code of Civil Procedure. Its original form in the Act of May 7, 1855, may be seen in Cal. Stats. of 1855, p. 302.

And, independently of such express provision, it has always been settled, that where the Court below had jurisdiction *as regards the appellant*, it can not, merely on his appeal, reverse the judgment on a ground relating to jurisdiction as regards others. The following decisions are examples:

Culver v. Cougle, 165 Ill. 417, 420;

Reed v. Boyd, 84 Ill. 67, 71;

Rowan v. Carroll, 81 Ill. 224, 228;

Smith v. Hickman, 68 Ill. 314, 317;

Rees v. Chicago, 38 Ill. 332;

Pattison v. Smith, 93 Ind. 447;

Cool v. Peters &c. Co., 87 Ind. 532, 539;

Lively v. Husebye, 60 Wash. 47, 53;

Fulton v. Trading Co., 45 Wash. 136;

Halloran v. Holmes, 13 N. Dak. 412;

Brown v. Wilson, 45 S. Car. 519, 528;

Ward v. Finnen, 10 Tex. 187;

Boggess v. Gamble, 3 Cold. (43 Tenn.) 148, 150;

Liggatt v. Morgan, 2 Leigh (Va.) 84, 108.

The same is true as regards all errors. In *Richards v. Greene*, 78 Ill. 527, for example, the Court say:

“It is a familiar principle, that the appellant can not allege errors which, if they exist at all, relate exclusively to a person who is not complaining, and is not before the Court.”

The same is expressly held in the following decisions :

- Dobbs v. Purington*, 136 Cal. 70;
Malone v. Bosch, 104 Cal. 680;
Golden Gate & Co. v. Machine Works, 82 Cal. 186;
McDonald v. Taylor, 89 Cal. 43;
People v. Reis, 76 Cal. 269, 275;
Tripp v. Duane, 74 Cal. 91;
Ball v. Nichols, 73 Cal. 193;
McCreery v. Everding, 44 Cal. 284;
People v. Worth (Cal.), 33 Pac. 913;
Press v. Woodley, 160 Ill. 437;
Tibbs v. Allen, 27 Ill. 125;
Thorn v. Ingram, 25 Ark. 53, 59;
Mining Co. v. Costello, 11 Ariz. 334, 343;
Powell v. Sturdevant, 85 Ala. 243;
Medlin v. Wilkerson, 81 Ala. 147;
Barker v. Callihan, 5 Ala. 708;
Oldham v. Rowan, 4 Bibb (7 Ky.) 544;
Williams v. Neil, 51 Tenn. 279, 281;
Teller v. Hartman, 16 Colo. 447, 449;
School Dist. v. Flannigan, 28 Colo. 431;
Lacy v. Heirs of Williams, 8 Tex. 182, 188;
Chappell v. Brooks, 33 Tex. 275, 277;
Herndon v. Bremond, 17 Tex. 432;
Oliver v. Shoemaker, 35 Mich. 464;
Griggs v. Railway Co., 10 Mich. 123;
Warner v. Whittaker, 6 Mich. 133;

Boyd v. Titzer, 6 Cold. (46 Tenn.) 568;
Brunner v. Warner, 52 S. W. 668 (Tenn.);
Papin v. Mussey, 27 Mo. 445;
Eyre v. Cook, 9 Ia. 185.

§ 355. Where a judgment is against more than one defendant, it is at common law a unit, and if void as to one defendant, is void *in toto*. This is the settled law, and, on collateral attack, is so laid down in the following authorities:

Jackson v. Hulse, 6 Mackey (D. C.) 548, 555;
Watson v. Steinan, 19 R. I. 218;
St. Louis v. Gleason, 15 Mo. App. 25, 31;
Holbrook v. Murray, 5 Wend. (N. Y.) 161;
Altman v. Hohfeller, 152 N. Y. 498;
Hanley v. Donoghue, 59 Md. 239, 243;
Wilbur v. Abbott, 60 N. H. 40;
Rangeley v. Webster, 11 N. H. 299, 307;
Hall v. Williams, 6 Pick. (23 Mass.) 485, 490;
Knapp v. Abell, 10 Allen (Mass.) 485, 490;
Wright v. Andrews, 130 Mass. 149, 151;
Martin v. Williams, 42 Miss. 210;
Comentz v. Bank, 85 Miss. 662;
Williams v. Chalfant, 82 Ill. 218;
Claflin v. Dunne, 129 Ill. 248;
Railroad Co. v. Annis, 62 Ill. App. 180;
Grace v. Bank, 62 Ill. App. 149;
Goldberg v. Harvey, 122 Ill. App. 106;
Blanchard v. Gregory, 14 Ohio 413;
Wood v. Watkinson, 17 Conn. 500.

So also, where a judgment, being a unit, is reversed on an appeal by one defendant, such reversal reverses the judgment *in toto*, as was done in *Estate of Cobb*, 49 Cal. 599. It is so expressly held in the following decisions:

- Alling v. Wenzel*, 133 Ill. 265, 277;
- Railway Co. v. Reno*, 123 Ill. 273, 278;
- Jansen v. Varnum*, 89 Ill. 100;
- Williams v. Chalfant*, 82 Ill. 218;
- Earp v. Lee*, 71 Ill. 194, 197;
- Thompkins v. Wiltberger*, 56 Ill. 386, 392;
- Rees v. Chicago*, 38 Ill. 322, 332;
- Enos v. Capps*, 12 Ill. 255, 257;
- Mohr v. McKenzie*, 60 Ill. App. 575, 577;
- Brockman v. McDonald*, 16 Ill. 112;
- Altman v. Hohfeller*, 152 N. Y. 498;
- Bower v. Hawes*, 115 N. Y. App. Div. 492;
- Boice v. Jones*, 106 N. Y. App. Div. 548;
- Purcell v. McCleary*, 10 Gratt. 246;
- Donnelly v. Graham*, 77 Pa. St. 274;
- Bradford v. Taylor*, 64 Tex. 169, 171;
- McRae v. McWilliams*, 58 Tex. 328, 334;
- Dickson v. Burke*, 28 Tex. 117, 118;
- Davenport v. Hervey*, 30 Tex. 308, 319, 330;
- Wood v. Smith*, 11 Tex. 367;
- Burleson v. Henderson*, 4 Tex. 49, 59;
- Mutual Life Ins. Co. v. Clover*, 36 Mo. 392;
- Rush v. Rush*, 19 Mo. 142;
- Weis v. Aaron*, 75 Miss. 138;
- Keifer v. Barney Bros.*, 31 Ala. 192;
- Buffum v. Ramsdell*, 55 Me. 252.

So likewise, where a judgment was *in part* obtained by fraud, it must be set aside *in toto*. This is so held in *Hutchins v. Lockett*, 39 Tex. 165.

This also comes out in the following rule: Where, on an appeal by one of a number of defendants, a judgment is found erroneous on the merits, *on a ground that would equally apply in favor of some who have not appealed*, the judgment must be reversed *in toto*, and equally for the benefit of those who have not appealed. It is so laid down and held in the following authorities:

3 Cyc., p. 411;

Alexander v. Alexander, 85 Va. 353, 362;

Walker's Exrs. v. Page's Exrs., 21 Gratt, 636, 650;

Lenow v. Lenow, 8 Gratt, 349, 352;

Nicholson v. Gloucester &c. School, 93 Va. 101, 103;

Roanoke v. Blair, 107 Va. 639, 647;

Railway Co. v. Reno, 123 Ill. 273, 275-279;

Alling v. Wenzell, 35 Ill. App. 246, 248;

Clason v. Morris, 10 Johns. 525;

Bauer v. Hawes, 115 N. Y. App. Div. 492;

Boice v. Jones, 106 N. Y. App. Div. 548.

§ 515. The adjournment of the hearing *sine die*, made all the subsequent portion of the hearing a hearing *without notice*.

This is an obvious and self-evident truth, which no decision of any State Court can overthrow or subvert.

In § 515 of our Brief, we give three of the later decisions of the Supreme Court of California that spon-

taneously recognize and act upon this self-evident truth. We will now add one more decision:

In *Thompson v. Williams*, 76 Cal. 153, an assessment on corporate stock levied at an adjourned meeting of the directors held Oct. 9, 1883, was held void on the ground that the meeting was held without notice and without the presence of all the directors. And the Court there say:

“As it does not appear that the hour of the day on the 9th of October on which the adjourned meeting was to be held on the last named day, was fixed at the meeting of the 8th, and no notice of such adjourned meeting was given the directors Allen and Thompson, who were not at the meeting of the 8th, we must hold that the assessment levied at the meeting of the 9th was levied substantially without notice and without authority. To hold that the adjourned meeting of the 9th, the hour of which was not fixed or declared by the meeting of the 8th of October, was a part of the meeting of the board of the 8th, and therefore (that) no further notice of it was required, would be to sanction an evasion of the law in regard to the notice to the directors of the meeting of the board. An inspection of the minutes of the meeting of the 8th would give no information to the directors not attending that meeting of the time to which that meeting had been adjourned. In fact, it does not appear that the board as a board ever did fix the hour on the 9th at which the adjourned meeting was to be held; and as it does not so appear, we must hold that the board on the 8th did not fix the hour at all. Under these circumstances, we can not hold that the meeting on the 9th, at which the assessment was levied, was anything more than a special meeting, of the calling of which the non-attending direct-

ors, Allen and Thompson, had no notice or knowledge of any kind. The assessment was therefore levied without authority, and was a nullity."

§ 556. The publication made by the Code Commissioners of California in 1872-1873, reporting certain statutes to have been superseded by the Codes, is without force or effect as operating any such supersession or repeal. This is so *held*, in

Needham v. Thrasher, 49 Cal. 392.

HORACE W. PHILBROOK.

Solicitor for Appellants.

San Francisco,

February, 1913.

No. 1899

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

CATHERINE D. STEAD et al.,
Appellants,

VS.

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Appellees.

ADDITIONAL AUTHORITIES In Support of Brief for Appellees (On Rehearing)

J. C. CAMPBELL,

WALTER SHELTON,

Solicitors for Appellees Isabella M. Curtis, John M. Curtis,
Elizabeth M. Muir Mugan, William G. Mugan, and the
Jacob Z. Davis Estate Company.

Filed this.....day of March, 1913.

FRANK D. MONCKTON, Clerk.

By.....Deputy Clerk.

FILED

No. 1899

IN THE

United States Circuit Court of Appeals

For the Ninth Circuit

CATHERINE D. STEAD et al.,	}
<i>Appellants,</i>	

VS.

ISABELLA M. CURTIS et al.,	}
<i>Appellees.</i>	

ADDITIONAL AUTHORITIES In Support of Brief for Appellees (On Rehearing)

The cases cited herein, together with extracts therefrom, are applicable to Chapter 4 (Sections 70 to 74, inclusive) of the brief for appellees on rehearing.

“The defense of want of knowledge on the part of one charged with laches is one easily made, easy to prove by his own oath, and hard to disprove; and hence the tendency of courts in recent years has been to hold the plaintiff to a rigid compliance with the law which demands,

not only that he should have been ignorant of the fraud, but that he should have used reasonable diligence to have informed himself of all the facts.”

Foster v. Mansfield &c. Ry., 146 U. S. 89, 99.

Knowledge of such facts as would put a person of ordinary prudence and diligence on inquiry is equivalent to knowledge of all facts which a diligent inquiry would disclose; so, ignorance of the means by which a fraud is accomplished, and of the evidence by which it might be established, constitute no excuse for delay when such fraud is known.

Johnson v. Standard Mining Co., 148 U. S. 360, 370;

Felix v. Patrick, 145 U. S. 317;

Swift v. Smith, 79 Fed. 709, 713;

McMonagle v. McGlinn, 85 Fed. 88, 92-94;

Rugan v. Sabin, 53 Fed. (C. C. A.) 415, 418-419;

Sheftel v. Hays, 58 Fed. (C. C. A.) 457, 461;

Lant v. Manley, 71 Fed. 7, 18-19;

Melms v. Pabst Brewing Co., 93 Wis. 153, 174; 66 N. W. 518; 57 Am. St. Rep. 899.

The allegations in the bill show that appellants knew of the alleged forgery and of the alleged fraudulent purpose to acquire title to the estate of decedent, which was certainly sufficient to put a prudent man on inquiry for facts to support such allegations. It also appears that an attorney who

had no interest in the case was able to discover alleged facts of which appellants say they were ignorant, but there is no showing that there was anything exceptional or special about his investigation and there is nothing to show that the same investigation could not have been made many years ago by appellants with the same result. It must therefore necessarily follow that the rule stated in the cases requiring appellants to use diligence, precludes a recovery at this time, and, to use the language of Chief Justice Fuller:

“Those who have slept upon their rights must be remitted to the repose from which they should not have been aroused.”

Respectfully submitted,

J. C. CAMPBELL,

WALTER SHELTON,

Solicitors for Appellees Isabella M. Curtis, John M. Curtis,
Elizabeth M. Muir Mugan, William G. Mugan, and the
Jacob Z. Davis Estate Company.

No. 1900

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

J. KITCHEN JR. COMPANY (a Corporation),

Appellant,

VS.

ALEXANDER LEVISON,

Appellee.

TRANSCRIPT OF RECORD.

**Upon Appeal from the United States Circuit Court
for the Northern District of California.**

United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

J. KITCHEN JR. COMPANY (a Corporation),
Appellant,
VS.

ALEXANDER LEVISON,
Appellee.

TRANSCRIPT OF RECORD.

**Upon Appeal from the United States Circuit Court
for the Northern District of California.**

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[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in *italic*; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in *italic* the two words between which the omission seems to occur. Title heads inserted by the Clerk are enclosed within brackets.]

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[Names and Addresses of] Attorneys for Respective Parties.

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1105 Merchants' Exchange Bldg., San Francisco, Cal.

MILLER & WHITE, Solicitors for Appellee,
Crocker Building, San Francisco, Cal.

*In the United States Circuit Court of Appeals for
the Ninth Circuit.*

IN EQUITY.

JOHN J. KITCHEN JR. COMPANY (a Corporation),

Appellant,

vs.

A. LEVISON,

Appellee.

Stipulation [Under Rule 23].

It is hereby stipulated and agreed that the printing or incorporating into the Transcript of Record on Appeal of the several exhibits in this case may be dispensed with, except as to the patents introduced in evidence and Complainant's Exhibit "C."

CHAS. E. TOWNSEND,
Attorney for Appellant.

MILLER & WHITE,
Attorneys for Appellee.

Service of copy of the within stipulation admitted this 3d day of October, A. D. 1910.

For Appellee.

[Endorsed]: No. 1900. In Equity. In the United States Circuit Court of Appeals, 9th Circuit. John J. Kitchen Jr. Co., a Corporation, Appellant, vs. A. Levison, Appellee. Stipulation. Filed Oct. 13, 1910. F. D. Monckton, Clerk.

In the United States Circuit Court for the Ninth Circuit, Northern District of California.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Defendant.

Bill of Complaint.

To the Honorable the Judges of the Circuit Court of the United States for the Ninth Circuit, Northern District of California, Sitting in Chancery: Alexander Levison, of the City and County of San Francisco, State of California, and a citizen of the State of California, complainant, brings this his bill of complaint against the J. Kitchen Jr. Co., a corporation organized and existing under and by virtue of the laws of the State of California, and having its principal place of business at the City and County of San Francisco, in said State, defendant, and thereupon your orator complains and says:

1. That at all the times hereinafter mentioned your orator was and still is a resident of the City and County of San Francisco, State of California, and a citizen of said State; that at all said times defendant J. Kitchen Jr. Co. was and still is a corporation organized and existing under and by virtue of the laws of the State of California, and having its principal place of business at said City and County of San Francisco in said State.

2. That heretofore, to wit, prior to the third day of December, A. D. 1901, your orator was the original and first inventor of a certain new and useful improvement in manifold books, a more particular description of which will be found in reissued letters patent which were issued for said invention as hereinafter alleged, and to which special reference is hereby made, and which by such reference is made a part hereof; that the said improvement was a new and useful invention not known to or used by others in this country and not patented or described in any printed publication in this or any foreign country before the invention and discovery thereof by your orator, or more than two years prior to your orator's application for a patent therefor, and not in public use or on sale for more than two years prior to his application for a patent therefor, and not abandoned.

3. And your orator further shows unto your Honors that he did on the third day of December, A. D. 1901, duly and regularly make and file in the Patent Office of the United States an application in writing praying for the issuance to him of letters

patent of the United States for said invention, and that such proceedings were duly and regularly had and taken in the matter of said application that thereafter, to wit, on February 25, A. D. 1902, letters patent of the United States for said invention, numbered 694,103, bearing date February 25, 1902, were duly and regularly granted, issued and delivered by the Government of the United States to your orator, whereby there was granted and secured to him, his heirs and assigns, for the full term of seventeen years from said last named day, the sole and exclusive right, liberty and privilege to make, use and vend the said invention throughout the United States of America and the Territories thereof.

4. That said United States letters patent were issued in due form of law under the seal of the Patent Office of the United States and signed by the Commissioner of Patents of the United States, as will more fully appear from the said letters patent themselves, and that prior to the issuance of said letters patent all proceedings were had and taken which were required by law to be had and taken prior to the issuance of letters patent for new and useful inventions.

5. And your orator further shows unto your Honors that the said letters patent were inoperative by reason of a defective and insufficient specification, and that the error through which said specification was defective and insufficient arose by inadvertence, accident and mistake, and without any fraudulent or deceptive intention on the part of your orator; that within a reasonable time after the discovery of

said error and defect, to wit, on March thirteenth, A. D. 1902, your orator, for a good and lawful cause, as aforesaid, duly surrendered the said letters patent to the Commissioner of Patents of the United States, and on said last named day filed his application in the Patent Office of the United States, praying that said letters patent might be reissued for the purpose of curing and remedying said error and mistake; that such proceedings were thereafter duly and regularly had and taken in the matter of said application for reissued letters, that on July 1, A. D. 1902, the said Commissioner of Patents did cause a new patent for the same invention and in accordance with the corrected specification, and numbered 12,005, to be granted, issued and delivered by the Government of the United States to your orator, whereby there was granted and secured to him, his heirs and assigns, for the full term of seventeen years from said 25th day of February, 1902, the sole and exclusive right, liberty and privilege to make, use and vend the said invention throughout the United States of America and the territories thereof.

6. That said reissued letters patent, No. 12,005, were granted and issued in due form of law under the seal of the Patent Office of the United States, and signed by the Commissioner of Patents of the United States, as will more fully appear from said reissued letters patent themselves, which are ready in court to be produced by your orator, or a duly authenticated copy thereof.

7. That prior to the issuance of said reissued

letters patent, No. 12,005, on July 1, 1902, all proceedings were had and taken which were required to be had and taken prior to reissuing any letters patent for new and useful inventions, and ever since the issuance of said reissued letters patent your orator has been and now is the sole owner and holder of the same, together with all claims, demands and causes of action for the infringement thereof wherever and by whomsoever committed.

8. That the said invention protected by said reissued letters patent is of great value, and has been extensively practiced by your orator and your orator's licensees, and upon each and every one of the manifold books manufactured, used and sold by your orator or your orator's licensees, made in accordance with said reissued letters patent and embodying the invention thereby patented, the word "patented," together with the date and number of said reissued letters patent has been marked and stamped, thereby notifying the public of the same, and your orator further shows that ever since the issuance of said reissued letters patent, the public has and now does acquiesce in the validity of the same.

9. And your orator further shows unto your Honors that notwithstanding the premises, but well knowing the same, and without the license or consent of your orator, but contrary thereto, within six years last past, within the Northern District of California, defendant herein has made, used and sold manifold books containing and embracing the inventions described in the specification of said re-

issued letters patent, No. 12,005, and claimed and patented in and by the claims of said reissued letters patent, and has infringed, and is now infringing, upon the exclusive rights secured to your orator by virtue of said reissued letters patent, and that the manifold books so made, used and sold by the defendant were and are an infringement upon said reissued letters patent, and upon each and all of the claims thereof.

10. And your orator further shows unto your Honors that he has requested the defendant to cease and desist from its infringement aforesaid, and had hoped that the defendant would have complied with such reasonable request, but the fact is nevertheless, that said defendant has failed, neglected and refused to comply with such request, and is now making and threatens and intends to continue to make, use and sell the said manifold books containing and embracing the inventions patented in and by the said reissued letters patent, and the claims thereof, and unless restrained by this court defendant will continue to make, use and sell said manifold books, whereby your orator will suffer great and irreparable injury and damage.

11. That by reason of the premises and the unlawful acts of the defendant as aforesaid, your orator has suffered great and irreparable injury and damage, the exact amount of which is unknown, and can be ascertained only by an accounting, and the defendant has realized, as your orator is informed and believes, large gains, profits and advantages from and by reason of said infringement, the

exact amount of which is likewise unknown to your orator and can be ascertained only by an accounting.

12. That for the wrongs and injuries herein complained of, your orator has no plain, speedy or adequate remedy at law, and forasmuch as your orator is without remedy save in a court of equity where matters of this kind are properly cognizable and relievable.

To the end, therefore, that the said defendant may, if it can, show why your orator should not have the relief herein prayed, and may, according to the best and utmost of the knowledge, recollection, information and belief of its officers, but not under oath (an answer under oath being hereby waived) full, true, direct and perfect answer make to all and singular the matters and things hereinabove charged, your orator prays that the said defendant be enjoined and restrained both provisionally and perpetually by an injunction of this court from further infringing upon said reissued letters patent and be decreed to account for and pay over to your orator the gains, profits and advantages realized by it, and in addition thereto the damages sustained by your orator from and by reason of the infringement aforesaid, together with costs of court.

May it please your Honors to grant unto your orator forthwith upon the filing of this bill a writ of injunction issued out of and under the seal of this court provisionally and until the final hearing, enjoining and restraining the said defendant, J.

Kitchen Jr. Co., its agents, servants, attorneys, workmen and employees, and each of them, from making, using or selling any manifold books containing and embracing the inventions claimed and patented in and by said reissued letters patent, No. 12,005, and that upon the final hearing of this cause said provisional injunction be made perpetual, and that your orator have such other and further relief as to your Honors may seem meet and in accordance with equity and good conscience.

May it please your Honors to grant unto your orator the writ of subpoena ad respondendum issued out of and under the seal of this court directed to the defendant, J. Kitchen Jr. Co., commanding it by a day certain and under a certain penalty fixed by law to be and appear before this Honorable Court, then and there to answer this bill of complaint, and to stand to and abide by such further orders and decrees as to your Honors may seem meet in the premises.

ALEXANDER LEVISON,
Complainant.

MILLER & WHITE,

Solicitors and of Counsel for Complainant.

[Endorsed]: Filed August 29, 1908. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Subpoena ad Respondendum.**UNITED STATES OF AMERICA.**

*Circuit Court of the United States, Ninth Judicial
Circuit, Northern District of California.*

IN EQUITY.

The President of the United States of America,
Greeting: To J. Kitchen Jr. Co., a Corporation.

You are hereby commanded, that you be and appear in said Circuit Court of the United States aforesaid, at the courtroom in San Francisco, on the 5th day of October, A. D. 1908, to answer a Bill of Complaint exhibited against you in said court by Alexander Levison, who is a citizen of the State of California, and to do and receive what the said Court shall have considered in that behalf. And this you are not to omit, under the penalty of FIVE THOUSAND DOLLARS.

Witness, the Honorable MELVILLE W. FULLER, Chief Justice of the United States, this 29th day of August, in the year of our Lord one thousand nine hundred and eight, and of our Independence the 133d.

[Seal]

SOUTHARD HOFFMAN,

Clerk.

By W. B. Maling,

Deputy Clerk.

Memorandum Pursuant to Rule 12, Rules of Practice for the Courts of Equity of the United States.

You are hereby required to enter your appearance in the above suit, on or before the first Monday

of October next, at the Clerk's office of said court, pursuant to said bill; otherwise the said bill will be taken pro confesso.

SOUTHARD HOFFMAN,

Clerk.

By W. B. Maling,

Deputy Clerk.

RETURN ON SERVICE OF WRIT.

United States of America,

Northern District of California,—ss.

I hereby certify and return that I served the annexed Subpoena in Equity on the therein named J. Kitchen Jr. Co., a corporation, by handing to and leaving an attested copy thereof with J. Kitchen, Jr., the general manager of J. Kitchen Jr. Co., a corporation, personally at San Francisco, in said District, on the 5th day of September, A. D. 1908.

C. T. ELLIOTT,

U. S. Marshal.

By Paul J. Arnerich,

Deputy.

[Endorsed]: Filed September 10, 1908. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

*In the United States Circuit Court for the Ninth
Circuit, Northern District of California.*

No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Respondent.

Demurrer to the Bill of Complaint.

This respondent, by protestation, not confessing or acknowledging all or any of the matters or things in said Bill of Complaint to be true, in such manner or form as the same are therein set forth and alleged, doth demur thereto, and for cause of demurrer sheweth:

I.

That said Bill of Complaint is inequitable and unjust, in that the particular claims of the patent which the complainant intends to prosecute in the case are not specified.

II.

That said Bill of Complaint is defective, in that it does not conform to the requirements of section 4883 of the Revised Statutes of the United States, for that it does not allege or show that said original patent was issued in the name of the United States of America.

III.

That said Bill of Complaint is defective, in that it does not conform to the requirements of section

4887 of the Revised Statutes of the United States, for that it does not allege that the patentee or his legal representatives or assigns had not made or filed any application for a patent in any foreign country for said alleged invention more than seven months prior to the date of either and each of said applications therefor in this country.

IV.

That the averments of said Bill are insufficient, because it is not shown that said patentee was the sole owner and holder of said original letters patent at the time the same was surrendered and application for said reissue patent was made.

V.

That the averments of said Bill are insufficient to support a cause of action, because it is not shown what constituted the inadvertence, accident or mistake whereon said application for reissue was based.

VI.

That the averments of said Bill are insufficient, because it does not appear that no new matter was introduced into said reissue application and patent.

Wherefore, and for divers other good causes of demurrer appearing on said Bill, this respondent demurs thereto; and prays the judgment of this Honorable Court, whether it shall be compelled to make further or any answer to the said Bill, and humbly prays to be hence dismissed with its reasonable costs in this behalf sustained.

CHAS. E. TOWNSEND,
Attorney for Respondent.

I, Charles E. Townsend, attorney for the respondent herein, do hereby certify that the foregoing demurrer is, in my opinion, well founded in point of law.

CHAS. E. TOWNSEND.

State of California,

City and County of San Francisco,—ss.

John Kitchen, Jr., being first duly sworn, deposes and says that he is the president of the respondent corporation mentioned in the foregoing demurrer, and that the foregoing demurrer is not interposed for delay.

JOHN KITCHEN, Jr.

Subscribed and sworn to before me, this 30th day of October, 1908.

[Seal]

HARRY J. LASK,

Notary Public in and for the City and County of San Francisco, State of California.

Service of the within demurrer by copy admitted this 30th day of October, 1908.

MILLER & WHITE,

Attorneys for Complainant.

[Endorsed]: Filed Oct. 30, 1908. Southard Hoffman, Clerk. By W. B. Maling, Dep. Clk.

At a stated term, to wit, the November term, A. D. 1908, of the Circuit Court of the United States of America, of the Ninth Judicial Circuit, in and for the Northern District of California, held at the courtroom in the City and County of San Francisco, on Monday, the 9th day of

November, in the year of our Lord one thousand nine hundred and eight. Present: The Honorable WILLIAM C. VAN FLEET, District Judge.

No. 14,772.

ALEXANDER LEVISON

vs.

J. KITCHEN JR. CO.

Order Overruling Demurrer.

Defendant's demurrer to the bill of complaint herein came on this day to be heard, and was argued by counsel and submitted, and the same being fully considered, it is ordered that said demurrer be, and the same is hereby, overruled with leave to the defendant to answer within 20 days.

In the United States Circuit Court for the Ninth Circuit, Northern District of California.

IN EQUITY—No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Respondent.

Answer to Bill of Complaint.

To the Honorable the Judges of the Circuit Court of the United States for the Ninth Circuit, Northern District of California, Sitting in Chancery:

This respondent, now and at all times hereafter

saving and reserving to itself all and all manner of benefit of exception or otherwise that can or may be had or taken to the many errors, uncertainties and imperfections in the said Bill of Complaint contained, for answer thereto, or to so much thereof as this respondent is advised it is material or necessary for it to make answer to, answering says:

I.

Respondent denies that on or before December 3, 1901, or at any time, Alexander Levison was either the original or first or any inventor of any new or useful invention in "manifold books," either as alleged in said Bill of Complaint or otherwise, or at all; denies that the said alleged improvement was a new and useful invention; denies that it was not known to or used by others in this country; denies that it was not patented or described in any printed publication in this or any foreign country before the alleged invention and discovery of Levison for more than two years prior to Levison's alleged application for a patent therefor; denies that the said alleged improvement was not in public use or on sale for more than two years prior to Levison's alleged application for a patent therefor, and denies that the same was not abandoned.

II.

Further answering the allegations in paragraph 3 of said Bill of Complaint, wherein it is alleged that such proceedings were duly and regularly had and taken in the matter of Levison's alleged application, that on the 25th day of February, 1902, letters patent of the United States, numbered 694,103,

were granted and issued and delivered to the said Levison, respondent says that it has no information or knowledge thereof sufficient to enable it to make answer thereto, and leaves the complainant to make such proof thereof as he may deem material and necessary.

III.

Answering the fourth paragraph of said Bill of Complaint, wherein it is alleged that prior to the issuance of said letters patent all proceedings were had and taken which were required by law to be had and taken prior to the issuance of letters patent for new and useful inventions, respondent says that it has no knowledge or information sufficient to enable it to answer the same, and leaves the complainant to make such proof thereof as he may deem material and necessary; and respondent denies that the said letters patent were issued in due form of law, and denies that they were issued under the seal of the Patent Office of the United States and signed by the Commissioner of Patents of the United States.

IV.

Answering the fifth allegation of said Bill of Complaint, the respondent denies that said letters patent were inoperative by reason of a defective and insufficient specification; and denies that any alleged error through which said specification was alleged to be defective and insufficient arose from inadvertence, accident or mistake, and without any fraudulent or deceptive intention on the part of said Levison. Further answering the allegations in said para-

graph, wherein it is alleged that within a reasonable time after the alleged discovery of said alleged error and defect, to wit, on March 13, 1902, or at any other time, said Levison, for good and lawful cause, duly surrendered said letters patent to the Commissioner of Patents and filed his application in the Patent Office praying that said letters patent might be reissued for the purpose of curing and remedying said alleged error and mistake, and that such proceedings were thereafter duly and regularly had and taken in the matter of said application for reissued letters patent, and that the said Commissioner of Patents did cause a new patent for the same invention and in accordance with the corrected specification, and numbered 12,005, to be granted, issued and delivered by the Government of the United States to said Levison, or that there was secured to him, his heirs and assigns, for the full term of seventeen years from the said 25th day of February, 1902, or any other time, the sole and exclusive right, liberty and privilege to make, use and vend the invention throughout the United States and territories, respondent says that it has no knowledge, information or belief sufficient to enable it to answer the same, and leaves the complainant to make such proof thereof as he may deem material and necessary.

V.

Answering the allegations in the seventh paragraph of said Bill of Complaint, wherein it is alleged that prior to the issuance of said reissued letters patent all proceedings were had and taken which were required to be had and taken prior to

reissuing any letters patent for new and useful inventions, and that ever since the issuance of said reissued letters patent the complainant has been and now is the sole owner and holder of the same, together with all claims, demands, and causes of action for the infringement thereof, respondent says that it has no knowledge, information or belief sufficient to enable it to answer the same, and leaves the complainant to make such proof thereof as he may deem material and necessary.

VI.

Denies that the said invention described in said reissued letters patent is of great or any value; denies that the public now acquiesces in or has ever acquiesced in the validity of the same. Respondent further answering the allegations in the eighth paragraph of said Bill of Complaint, to the effect that the complainant or his licensees have practiced said invention, and that upon each and every one of the books made, used and sold by complainant or his licensees he has marked or stamped the word "Patented," says it has no knowledge, information or belief sufficient to enable it to answer the same, and leaves the complainant to make such proof thereof as he may deem material and necessary.

VII.

Answering the allegations in the ninth paragraph of said Bill of Complaint, respondent denies that it has wrongfully or unlawfully or at all, either in the State of California or elsewhere, ever made, used or sold, or that it is now making, using or selling, or that it threatens to make, use or sell, manifold books

contained and embraced, and claimed or patented in said reissued letters patent No. 12,005 sued on and described in said Bill of Complaint, and denies that it has infringed and is now infringing upon the said reissued letters patent; and respondent denies that the manifolding books it is now making, using and selling are infringements upon said reissued letters patent, or any letters patent owned or controlled by the complainant, and denies that it ever made, used or sold any manifold books which infringed said reissued letters patent.

VIII.

And respondent further denies that it is now making and threatens or intends to make, use or sell any manifolding books containing and embracing the alleged inventions patented in and by the said reissued letters patent and the claims thereof; and denies that the complainant has suffered or will suffer any damage or injury by reason of the respondent continuing to make, use and sell its manifolding book.

IX.

Respondent denies that the complainant has suffered great or any injury and damage by reason of any act or acts of respondent; and respondent denies that it has made or realized large or any gains or profits or advantages from making, using or selling, or operating the alleged invention or improvement described in said letters patent.

For affirmative defense respondent alleges:

1. That the said Levison was not the original or first inventor of the alleged inventions sought to be

patented in said letters patent sued on and described in said Bill of Complaint, nor of any material or substantial part or parts thereof, but that substantially the same combination of devices was, long prior to the supposed invention thereof by the said Levison, described and patented in the following letters patent of the United States, and printed publications, to wit:

285,794, October 2, 1883, E. J. Burwell;
288,048, November 6, 1883, J. H. Frink;
297,556, April 29, 1884, H. G. and J. B. Barlow;
503,918, August 22, 1893, H. F. Vaughan;
11,547, June 9, 1896, E. J. Perry;
589,372, August 31, 1897, H. P. Brown;
612,197, October 11, 1898, G. E. Doughty;
634,438, October 10, 1899, A. Abraham.

2. That the said Levison was not an original or first inventor of the invention sought to be patented in and by said letters patent sued on, nor of any material or substantial part or parts of the thing patented, but that substantially the same combination of devices was, long prior to the supposed invention or discovery thereof by the said Levison, in public use, and on sale in this country for more than two years before the said Levison's application for a patent, and that such public use of said alleged inventions was well known to the trade generally, and particularly to the following witnesses, who will be called to testify at the trial on behalf of respondent, to wit: Harry J. Stratford, W. R. Delzelle, James McNutt, Robert J. Loughery, James E. Agar, and John Kitchen, Jr., all of the City and County of

San Francisco; and Horace P. Brown and Clarence L. Johnston, of Emeryville, Alameda County, California.

3. That the original patent, No. 694,103, was surrendered and reissued by said Levison in the absence of every statutory foundation thereof.

Without this, that any other matter, cause or thing in said Bill of Complaint contained, and not herein and hereby well and sufficiently answered unto, traversed and denied, confessed or avoided, is true; all of which matters and things this respondent is ready to aver, maintain and prove, as this Honorable Court shall direct, and begs to be hence dismissed with its reasonable costs and charges in this behalf most wrongfully sustained.

[Seal]

JOHN KITCHEN JR. CO.,

By JOHN KITCHEN, Jr.,

President.

CHAS. E. TOWNSEND,

Solicitor for Respondent.

CHAS. E. TOWNSEND,

Counsel for Respondent.

City and County of San Francisco,
State of California,—ss.

Subscribed and sworn to before me this 20th day
of November, 1908.

[Seal]

HARRY J. LASK,

Notary Public in and for the City and County of
San Francisco, State of California.

Commission expires May 28, 1909.

Service by copy of the within answer, admitted this 27th day of November, 1908.

MILLER & WHITE,
Attorneys for Complainant.

[Endorsed]: Filed November 27, 1908. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

*In the United States Circuit Court for the Ninth
Circuit, Northern District of California.*

IN EQUITY—No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Respondent.

Replication.

This replicant saving and reserving unto himself now and at all the times hereafter, all and all manner of benefit and advantage of exception, which may be had or taken to the manifold insufficiencies of the answer of defendant, for replication thereto saith:

That it will aver, maintain and prove its said bill to be true, certain and sufficient in the law to be answered unto, and that the said answer of the defendant is uncertain, untrue and insufficient to be replied unto by this replicant, without this, that any other matter or thing whatsoever in the said answer of defendant contained, material or effectual in the law to be replied unto, and not herein and hereby well and sufficiently replied unto, confessed and

avoided, traversed and denied, is true.

All of which matters and things this replicant is now and will be ready to aver, maintain and prove, as this Honorable Court shall direct, and humbly prays as in and by his said bill he hath already prayed.

MILLER & WHITE,
Solicitors for Complainant.

Service of the within Replication admitted this 7th day of December, A. D. 1908.

Sol. for Defendant.

[Endorsed]: Filed Dec. 7, 1908. Southard Hoffman, Clerk. By W. B. Maling, Dep. Clk.

[Proceedings Had Before Examiner in Chancery.]

*In the Circuit Court of the United States, Ninth
Judicial Circuit, Northern District of Cali-
fornia.*

IN EQUITY—No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. COMPANY,

Defendant.

Be it remembered, that on the 6th day of February, 1909, and on the several days thereafter to which the examination was regularly adjourned, as hereinafter set forth, at my office, Room 214, in the United States Postoffice and Court Building, corner

of Seventh and Mission Streets, in the City and County of San Francisco, State of California, before me, E. H. Heacock, Examiner in Chancery, in the Circuit Court of the United States for the Ninth Circuit and Northern District of California, personally appeared the several witnesses whose names are hereinafter set forth, and who were produced and examined on behalf of the respective parties to the above-entitled cause. W. K. White, Esq., of Miller & White appeared as solicitor on behalf of complainant, and C. E. Townsend, Esq., as solicitor on behalf of defendant.

The following is a record of the proceedings:

[Stipulation Re Copies of U. S. Letters Patent, etc.]

It is stipulated between the respective parties that uncertified, printed, Patent Office copies of United States letters patent, or reissues thereof, may be introduced in evidence with the same force and effect as though certified or originals.

It is stipulated that the defendant is a corporation as alleged in the Bill of Complaint.

It is stipulated that the testimony herein may be adduced orally before the Examiner pursuant to equity rules.

It is stipulated that the testimony and proceedings may be taken in shorthand by Brainard C. Brown and by him put into typewriting.

[Testimony of J. B. Lewis, for Complainant.]

Examination-in-chief of J. B. LEWIS, called for complainant, sworn.

(By Mr. WHITE.)

Q. 1. State your name and residence, Mr. Lewis.

A. J. B. Lewis, 538 Page Street, San Francisco.

Q. 2. What is your occupation?

A. I am employed as a Clerk in the Auditor's Office, the City and County Auditor.

Q. 3. In the Auditor's Office of the City and County of San Francisco? A. Yes, sir.

Q. 4. How long have you occupied that position?

A. Well, since, I think, 1904.

Q. 5. Do you know anything about the sale to the City and County of San Francisco by the defendant herein, the J. Kitchen Jr. Co. of manifold books during the year 1908?

A. Well, at that time I had charge of the fees that were collected by the different departments; that is, the books were first brought into our office and then they were given to the different departments, and we have charge of all the books—the auditor's department has charge of all the fee-books in the city and county.

Q. 6. Can you state whether or not the defendant, John Kitchen Jr. Co. did sell to the City and County of San Francisco, during the year 1908, and prior to the month of September of that year, manifold books, manifold fee-books, to be used in the Board of Public Works department?

(Testimony of J. B. Lewis.)

A. They did; yes, sir.

Q. 7. I hand you a book, Mr. Lewis, and ask you to state whether or not this was one of the books that was sold by the defendant to the city and county prior to the month of Sept., 1908?

A. Yes, sir; this is the book that they sold and delivered to the auditor.

Q. 8. Do you know when that batch of books of which this book you hold in your hand was one, was delivered to the city? Approximately what date?

A. Well, I would not be sure of the date. It was along some time in June.

Q. 9. Of what year? A. 1908.

Q. 10. You are certain it was prior, are you, to the month of September?

A. Oh, yes, sir. I am sure of that, because they had to be delivered before the commencement of the fiscal years, which ends on June 30th. It commences on July 1.

Mr. WHITE.—Complainant offers in evidence this book, the fee-book sold by defendant to the City and County of San Francisco. (Marked Complainant's Exhibit "A.")

Mr. TOWNSEND.—No cross-examination.

Mr. WHITE.—Complainant offers in evidence the United States reissued letters patent No. 12,005, reissued on July 1, 1902, to complainant herein, Alexander Levison, for a manifold book, and asks that it be marked Complainant's Exhibit "B," being the patent in the suit.

(Marked Complainant's Exhibit "B.")

[Testimony of John Kitchen, Jr., for Complainant.]

Examination-in-chief of JOHN KITCHEN, Jr.,
called for complainant, sworn.

(By Mr. WHITE.)

Q. 1. What is your residence, Mr. Kitchen?

A. Oakland.

Q. 2. Oakland, California?

A. Oakland, California.

Q. 3. Are you an officer of defendant corporation?
A. I am.

Q. 4. What office do you hold, and how long have you held this office?

A. I am the president and I was the organizer of the company.

Q. 5. How long has the company been organized, the corporation?

A. Eight years, or nine years.

Q. 6. During the year 1908, prior to the month of September, I believe your company manufactured and sold to the City and County of San Francisco a batch of fifty-odd fee-books of the same construction and style of Complainant's Exhibit "A," of which batch exhibit "A" is one. Is that a fact?

A. That is a fact; yes.

Q. 7. I understand that your company has submitted a bid to the city and county regarding the furnishing to the city in the future of other fee-books. Is that not correct?

A. We have.

Q. 8. That bid is now under consideration by the printing committee of the Supervisors of this city

(Testimony of John Kitchen, Jr.)

and county. A. It is.

Q. 9. If the contract is awarded to your company on such bid, is it your intention to furnish books to the city and county of the character and type of Complainant's Exhibit "A"?

A. We certainly would.

Q. 10. Unless you are restrained, or your company is restrained by an injunction issued by this Court, it is your intention, as I understand it, to manufacture and sell to the city, books identical in construction with Complainant's Exhibit "A," provided that the contract is awarded to you?

A. Yes.

Q. 11. What is the purpose, Mr. Kitchen, in the construction of your book, of attaching one edge of carbon to the piece of cardboard and cutting the cardboard out in the manner shown in your book?

A. That is my patent which was allowed by the Patent Office. That is my patent.

Q. 12. Yes. I asked you, what is the purpose of attaching the carbon to the cardboard and fluting the edge of the cardboard in the manner indicated in your book?

A. Well, that is a removable carbon—it is a loose carbon.

Q. 13. A loose carbon?

A. A loose carbon; yes.

Q. 14. It serves only the purpose, as I understand it, of any loose carbon. A. Of what?

Q. 15. Of any loose carbon inserted in the book?

A. No, it does not. It holds the carbon into

(Testimony of John Kitchen, Jr.)

place. It remains virtually there as a holder for the carbon. It is a carbon holder.

Q. 16. As I understand it, then, the carbon or one edge of the same, is attached to this piece of cardboard which is cut out in the manner indicated, for the purpose of permitting the cardboard to be slipped in between the covers of the book in order to hold the carbon in place. Is that correct?

A. That is right; yes.

Q. 17. In other words, it is a means of binding the carbon in place, in the book.

A. No, it is not bound in.

Q. 18. It is not bound in?

A. No, it is not bound in. That is removable.

Q. 19. It would fall out?

A. It might fall out, but it is made to hold the carbon into place, and the carbon will be held properly in place if it is properly made.

Q. 20. As I understand it then, when the carbon is held in place, in this manner, you don't consider it bound in the book? A. No, not bound in.

Q. 21. What do you understand by the expression "bound"?

A. "Bound" is fastened; fastened into a book, so that it cannot be removed without being torn out; bound in.

Q. 22. That is your definition?

A. That is my definition; bound in a book. Of course, it is not to be perforated or taken out in any manner without tearing it out.

Q. 23. In your books is the carbon sufficiently

(Testimony of John Kitchen, Jr.)

bound in with the other portion of the book to hold the same in place under ordinary conditions?

A. Well, that is up to the man that uses it, to say that. The carbon is easily removed. The carbon is not bound in.

Q. 24. Your idea, though, in making the construction in this manner was that the carbon would be held in place, bound in place, restrained from freely moving about, and being loose, was it not?

A. No, it is just to hold the carbon into place. It is placed in the book, and the carbon will stay there. That is the construction of the binder, yes.

Q. 25. What do you sew the leaves of the book together for?

A. The leaves of the book are not sewed together. The leaves are wired, stitched together.

Q. 26. How do you bind them together?

A. The leaves are wired, stitched.

Q. 27. What is the purpose of stitching them together?

A. That is the cheapest method, of doing it.

Q. 28. Well, I know, but why do you do it at all?

A. Oh, so they will hold together.

Q. 29. Oh, simply to hold them together.

A. To hold them together.

Q. 30. So that you can put a sheet of carbon in in this manner, so that it will be held in its place?

A. We stitch the leaves together of this book so that they will be held in place, and then we attach the cover of the book by glue, so that it will be held in place.

(Testimony of John Kitchen, Jr.)

Q. 31. So that you have three different means of holding these elements together in this one book.

A. Yes, in various ways. The book is held together by wire and the cover is fastened onto the back with glue.

Q. 32. In the manufacture of a book of this character, would it not be cheaper, Mr. Kitchen, to simply sew the edge of the carbon in with the sheets of the book? A. Undoubtedly it would.

Q. 33. Why did you adopt this construction?

A. Because it is an improvement.

Q. 34. You consider this an improvement?

A. I do, yes, sir.

Q. 35. You thought it was an improvement in the manufacture?

A. Yes; suppose you tear a carbon in a book that is wired in, what are you going to do? You have either got to use a loose carbon, or tear your sheets out.

Q. 36. Prior to the commencement of this suit, and prior to your selling of these books, to the city you were notified, were you not, by Mr. Alexander Levison, the complainant in this suit, or his attorneys and agents, that the construction of a book of that character would infringe the letters patent in the suit?

A. Yes, but I did not consider it the same book as Mr. Levison's. I had made this sample up, and applied for patents of my own.

Q. 37. But after receiving that notice of infringement, you went ahead and constructed these

(Testimony of John Kitchen, Jr.)

books and delivered them to the city, delivered to the city a batch of books of which Complainant's Exhibit "A" is one?

A. These books were made and delivered before there was any notice sent me, if I remember rightly. I am not positive as to that, but I am pretty sure in regard to it.

Q. 38. But you were notified in regard to Mr. Levison's patent?

A. I knew what Mr. Levison's patent was; yes.
Mr. WHITE.—That is all.

Cross-examination.

(By Mr. TOWNSEND.)

XQ. 1. The reason you went ahead and delivered those books and made others, Mr. Kitchen, was because you asked legal advice as to whether your device was an infringement, was it not?

A. It was.

XQ. 2. And you were told that the device that you were making was not an infringement, in the opinion of your patent attorneys? A. I was.

XQ. 3. And your statement that you were ready to furnish other books to the Board of Public Works in accordance with your bid, as answered in your direct examination a moment ago, is because you are advised that your device does not infringe upon the patent of Mr. Levison, the patent in suit?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial.

A. Exactly.

XQ. 4. (By Mr. TOWNSEND.) Is the cover of

(Testimony of John Kitchen, Jr.)

the Exhibit "A" in evidence removable in the sense that your carbon is removable?

Mr. WHITE.—We object to that as immaterial.

A. No.

XQ. 5. (By Mr. TOWNSEND.) Are the pages removable?

Mr. WHITE.—The same objection.

A. The pages are perforated so that they can be torn out, but not removable on the same lines as the carbon.

XQ. 6. (By Mr. TOWNSEND.) The cover and the pages are bound together, are they not?

A. The cover and the pages are bound together.

XQ. 7. And your carbon is a loose carbon which can be put in and taken out of the book?

A. It can be removed and put in place in any portion of the book.

XQ. 8. You can put in one carbon, or put in half a dozen, can you not? A. Exactly.

XQ. 9. Is Mr. Levison's carbon in his books, or such as is shown in his patent—are they removable?

Mr. WHITE.—We object to that as immaterial.

A. They are not.

XQ. 10. (By Mr. TOWNSEND.) An ordinary loose carbon without your strengthening strip at the end would work substantially the same as your carbon does, would it not?

A. Well, it would not work as satisfactorily. You could not get as good results. You might on one or two copies only.

XQ. 11. It would stay in the book as long as the

(Testimony of John Kitchen, Jr.)

book was handled carefully, would it not?

A. Yes.

XQ. 12. It would stay in the book?

A. Yes.

Mr. TOWNSEND.—That is all.

Redirect Examination.

(By Mr. WHITE.)

RDQ. 1. You say the loose carbon worked satisfactorily. Is this more expensive than the process you have embodied in that book? Can you explain why your company goes to this additional expense of constructing this book, when a loose carbon serves the same purpose?

Mr. TOWNSEND.—We object to that, because that does not express the statement of the witness correctly. He said the loose carbon was not as satisfactory as his improved construction.

RDQ. 2. (By Mr. WHITE.) You can answer the question.

A. Well, the more times you fold a carbon, it is hard to fold it in the same position; and by using this device, you can always fold it in the same position.

RDQ. 3. In the ordinary use of a book of this character, it is quite essential and important, is it not, that the carbon should be in place at all times?

A. Oh, well, it depends. It depends in what place. You can take one carbon out, and put another in. It is not necessary to have your carbon absolutely stationary. You might use one carbon with one sheet and take that carbon out and use an-

(Testimony of John Kitchen, Jr.)

other one next time.

RDQ. 4. Nothing would be gained by substituting one carbon in your book unless the carbon was worn out.

A. Unless the carbon was worn out or torn.

RDQ. 5. But if you take the old carbon out of the book and put a new carbon in the book, still it is important that the new carbon should be held in place, and it is for that reason that you hold it in place and do not use a loose carbon which is liable to fall out of the book.

A. Yes, it is to hold the carbon in that book, and to get better results.

RDQ. 6. This is the purpose of your construction, that is, to hold the carbon in the book?

A. Yes, sir, exactly.

RDQ. 7. And that construction accomplishes that purpose?

A. Yes, sir.

RDQ. 8. Well, you say it accomplishes it. Does it accomplish it successfully?

A. It does.

RDQ. 9. Quite successfully, does it not?

A. Yes, it does.

RDQ. 10. So successfully that nothing would be gained by sewing the carbon in the book to hold it in place?

A. Well, no; I consider this an improvement on the other one.

RDQ. 11. You consider that this holds the carbon in place better than by sewing it in the book?

A. Yes, I consider this better than the other.

Mr. WHITE.—That is all.

[Testimony of Alexander Levison, for Complainant.]

Examination-in-chief of ALEXANDER LEVISON, called for complainant, sworn.

(By Mr. WHITE.)

Q. 1. What is your residence?

A. San Francisco; 526 Baker Street.

Q. 2. Are you the same Alexander Levison to whom the letters patent in suit, or rather, the reissued letters patent in suit were issued on July 1, 1902?

A. I am.

Q. 3. At all times since the delivery of said reissued letters patent to you, the patent in suit, have you retained all the right, title and interest in and to the said patent?

A. I have, with the exception of the licensees.

Q. 4. What is your business?

A. Printing and bookbinding.

Q. 5. How long have you been engaged in that business?

A. Since 1892.

Q. 6. With what company are you associated in the printing business?

A. The Levison Printing Co.

Q. 7. For how long a time has the Levison Printing Co. been engaged in the manufacture and sale of manifold books of various character and description?

A. Well, the Levison Printing Co., as a corporation, has only existed since the fire of April, 1906, but the Levison Printing Co. are the successors of the former company, the successors to my business prior to that time. It was an individual business

(Testimony of Alexander Levison.)

simply, a private business; up to the time of the corporation, and this is practically the same business that we have in the manufacture of manifold books of various kinds since 1892.

Q. 8. Have you or the Levison Printing Co. ever manufactured books in connection with the specifications and drawings of the letters patent in suit, re-issued number 12,005?

A. Very many of them.

Q. 9. What have you to say regarding the marking of said books in order to give notice to the world that the same were covered by any patents?

A. Well, every sheet of every book that was made by us was marked "Patented Feby. 25, Sept. 30, Re-issued July 1, 1902, Levison Printing Co., San Francisco."

Q. 10. As I understand it, then, since the issuance of the patent in suit, the Levison Printing Co. has always marked the books sold by them in the manner indicated by you in your previous answer—is that correct?

A. Yes, sir.

Q. 11. Have you read, and are you familiar with the patent in suit?

A. I am.

Q. 12. Now, I ask you to take the patent in suit and Complainant's Exhibit "A," and compare such exhibit with Claim 2 of the patent in suit, and state whether or not you find any of the elements of Claim 2 embodied in that exhibit "A."

A. I find all the elements of Claim 2 embodied in the book before me.

Mr. TOWNSEND.—Just one question. I want to

(Testimony of Alexander Levison.)

ask if Mr. Levison is being examined now as an expert.

Mr. WHITE.—Yes, sir; he is an expert, being the inventor of this identical invention. Perhaps he knows more about the invention than anyone else, having brought it into the world.

Mr. TOWNSEND.—I move that the last answer be stricken out, as it is not shown that the witness is competent to testify, not having been qualified as an expert; and that if the attempt is to show infringement of a claim, the conclusion is a legal one.

Q. 13. (By Mr. WHITE.) Do you find, or do you not find, each and all the elements of Claim 2 of the patent in suit combined in substantially the same way and performing substantially the same result or function in Complainant's Exhibit "A"?

Mr. TOWNSEND.—We object to that as leading and totally lacking in foundation.

A. I certainly do. I find all the elements there which are described in my patent.

Q. 14. (By Mr. WHITE.) I will ask you to make the same comparison between Claim 3 of the patent in suit and Complainant's Exhibit "A."

Mr. TOWNSEND.—We make the same objection.

A. I do. I find that the book is made with all the elements described in Claim 3.

Q. 15. (By Mr. WHITE.) What have you to say as regards the combination of such elements and the function performed by such elements in the book, as compared with the functions and combination of such elements set forth in Claim 3?

(Testimony of Alexander Levison.)

Mr. TOWNSEND.—We object to that as leading, and calling for an answer for which the witness is not qualified.

A. Well, take the claim as it reads: “A manifold book comprising a double carbon sheet.” There is the double carbon sheet. “And a plurality of recording sheets.” There is the plurality of recording sheets. “The record sheets outside the stubs being divided into three substantially equal separable parts.” There are the one, two, three, substantially equal separable parts. “And the carbon sheet extending the width of two of said parts.” There is the carbon sheet extending the width of two of said parts.” “Said recording sheets having the stubs to which they are attached along lines of perforation.” There are the lines of perforation. “Said stubs and one side of the carbon sheet being all bound together to form a book substantially as described.” There are the stubs and one side of the carbon sheet being bound together. There is one side of the carbon sheet being bound together to form a book, and there is the back of that carbon paper bound in that book.

Q. 16. (By Mr. WHITE.) What were you doing with the carbon sheet when you made your last answer?

A. I was raising the body of the book by the carbon paper which was bound into that book. The carbon paper is bound there, is held there. It is restrained there; and that is the same as my patent covers; “bound, held or restrained” meaning the same thing.

(Testimony of Alexander Levison.)

Q. 17. As I understand it, when you made your last answer you illustrated the same by taking hold of the outer edge of one of the carbon sheets of Complainant's Exhibit "A" and elevating the book by lifting such edge of the sheet. Is that correct?

A. I lifted the book by lifting the edge of the sheet, and the carbon paper was bound into the book; and that is the reason I could lift the book, because the carbon was bound.

Q. 18. There was no attraction of magnetism?

A. I have no electricity or magnetism, no.

Q. 19. Now, comparing Claim 4 of the patent in suit, with the Complainant's Exhibit "A" in the same manner that you have heretofore compared Claims 2 and 3, what have you to say?

Mr. TOWNSEND.—We make the same objection as was made to the similar question in regard to Claim 3.

A. Well, Claim 4 and Claim 3 are, I think, the same, with the exception that Claim 4 would cover a book comprised of more than 3 sections, as quadruple copies, and so on; therefore the book, in my judgment, is an infringement on my patent for the same reason as the previous answer.

Mr. TOWNSEND.—I move that that answer be stricken out as being a legal conclusion.

Q. 20. (By Mr. WHITE.) I ask you if you did, or did not find, embodied in Complainant's Exhibit "A" each and all the elements set forth and enumerated in Claim 4 of the patent in suit, and combined in substantially the same way, to form the same result?

(Testimony of Alexander Levison.)

Mr. TOWNSEND.—We object to that on the same grounds as urged to a previous similar question.

A. I did.

Q. 21. (By Mr. WHITE.) And do you?

A. I do.

Q. 22. Now, make the same comparison between Claim 5 of the patent in suit and Complainant's Exhibit "A.?"

Mr. TOWNSEND.—We make the same objection as was entered to questions of this kind with respect to the other claims.

A. I find this just the same as Claims 2, 3, 4 and 5. This book is made substantially the same and embodies all the elements described in Claim 5 of my patent.

Q. 23. (By Mr. WHITE.) Since the issuance of your patent, the one in suit, and the manufacture of manifold books in connection with the same by your lessee, the Levison Printing Co., have the public and the trade generally acquiesced in your rights under the patent, and accepted the same, and acquiesced in the validity of the patent?

A. They have, to a very great extent, too.

Q. 24. About what proportion of the business done in this city and county, of manifold books of this character, does your licensee, the Levison Printing Co. do, if you know?

A. Well, of this character we do them all, because we have not any competition in that. But I could take and make a comparison between certain

(Testimony of Alexander Levison.)

other books that we sell, and show the comparative sale. These are fee-books sold to the City and County of San Francisco, this particular book. We have not handled this particular book. Whoever sells them sells them all.

Q. 25. Since the issuance of your patent, have you sold fee-books of this character to the City and County of San Francisco?

A. Since the time that I introduced this system and the book into the Auditor's Office, I have sold all of the fee-books with the exception of one lot which were made by another concern, an infringement, and which was afterwards settled. There was a suit entered and the case was settled to the satisfaction of all parties concerned. But in the shipping-book line, I could illustrate these sales.

Q. 26. In my question, I did not mean to limit the same to fee-books. I meant manifold books embodying your invention, embodying the elements of these various claims combined in the same way.

Mr. TOWNSEND.—We object to this line of questions as wholly irrelevant and immaterial to any issue of the alleged infringement.

A. Well, take, for instance, shipping receipt-books, where there are always triplicates. When I put my book on the market there were other books, three or four or five kinds; and they were none of them giving the satisfaction that they should. The fact of the carbon paper being loose, lying around the shipping office and not being ready when they wanted it, and so on, made all the other books ob-

(Testimony of Alexander Levison.)

jectionable; and when I started in to sell this book I worked it up to a point that I can safely say now that we were selling from 75 to 90 per cent of all the shipping receipts that are used in this city. We are now selling that proportion. That is, the proportion of that one line.

Q. 27. (By Mr. WHITE.) Immediately after the issuance of the patent in suit, did you and your licensees commence the manufacture of books covered by the patent in suit, and mark the same in the manner indicated by you in your former answer?

A. Yes, sir.

Q. 28. Have you ever since the first manufacture of books in connection with the patent in suit—have you or your licensee continued to so mark all books manufactured and sold by you?

A. We have.

Mr. WHITE.—Take the witness.

Cross-examination.

(By Mr. TOWNSEND.)

XQ. 1. How many licensees have you, Mr. Levison?

A. The Levison Printing Co. That is all.

XQ. 2. What is the nature of that license?

Mr. WHITE.—We object to that as immaterial.

A. Well, it is a license to manufacture and sell.

XQ. 3. (By Mr. TOWNSEND.) An exclusive license?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial.

(Testimony of Alexander Levison.)

A. Well, it is a limited license, with certain restrictions.

XQ. 4. (By Mr. TOWNSEND.) Can you produce a copy of that license?

Mr. WHITE.—We object to that as immaterial.

A. I haven't it with me; no.

XQ. 5. (By Mr. TOWNSEND.) State the substance of it.

A. The substance of it is, that I permit the Levison Printing Co. to manufacture under that patent in the State of California. I have given my company the right to manufacture and sell these books in the State of California, and I agree not to give that same right to anybody else in the State of California.

XQ. 6. That license, then, is simply a territorial one, limited to the State of California?

A. That is it; yes, sir.

XQ. 7. You spoke about binding the carbons into the book. Were you the first to bind a carbon into a manifold book?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial, it being indefinite and uncertain as to the character of book referred to by counsel.

XQ. 8. (By Mr. TOWNSEND.) Manifold books, I said. Were you the first to bind carbons, the first to use carbons for manufacturing purposes, binding those carbons into a manifolding book?

Mr. WHITE.—We make the same objection.

A. There are many manifolding books. There

(Testimony of Alexander Levison.)

are duplicate manifolding books. There are triplicate manifolding books. There are quadruplicate manifolding books. There are five copies. People have bound carbon paper into a duplicate book, but not into a triplicate or a quadruplicate book.

XQ. 9. (By Mr. TOWNSEND.) The binding of carbons, at least in a duplicate form of book, was known to you before you ever applied for this patent, and before you got up your invention?

Mr. WHITE.—We object to that as immaterial.

A. Well, I saw books, duplicating books with carbons attached, yes.

XQ. 10. (By Mr. TOWNSEND.) Long prior to your invention in suit?

Mr. WHITE.—We make the same objection.

XQ. 11. (By Mr. TOWNSEND.) And duplicating books, bound manifold books, and triplicate and quadruplicate books you have known of, have you not, before you ever got up this invention or conceived of it?

A. Quadruplicate books and triplicate books were probably made before any one of us was born; a long time ago.

XQ. 12. Then there was nothing new in the binding of carbons in the manifold books?

Mr. WHITE.—We object to the question as indefinite; not specifying the character of the manifolding book. This patent does not cover all manifolding books.

A. Why, certainly; that is just what I was going to say. I say, in regard to any manifolding book,

(Testimony of Alexander Levison.)

I claim no patent on duplicate books. I only claim to own a patent on a certain kind of manifolding book, on this particular kind of manifolding book, the binding in of the carbon paper in the way I bind it has practically driven all the other devices out of business.

XQ. 13. (By Mr. TOWNSEND.) Have you put out a duplicate manifold book with the carbon bound in it?

A. I claim no patent on those.

XQ. 14. Have you put all duplicate manifold books with the carbon bound in them out of business?

Mr. WHITE.—We object to that as incompetent and immaterial.

A. I don't compete with them.

XQ. 15. I am talking about manifolding books, duplicate books, whether there are two or three or four or five carbons bound into one book. Have you put all those books out of business?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial, this suit not being concerned with the manufacture of books in general, simply being concerned with the invention disclosed in this patent in suit.

A. I don't make any contentions on the duplicating book. I am claiming the triplicate, quadruplicate, etc.; more than two copies. I don't claim it on two copies. I don't try to put them out of business. I am not spending much time on the duplicate books. I can't manufacture them as cheaply as the others.

(Testimony of Alexander Levison.)

What I am working on principally is the triplicate books and more than triplicate books.

XQ. 16. (By Mr. TOWNSEND.) As far as the binding together of a plurality of sections, the binding together of leaves having a plurality of sections, and the binding into a book of these leaves with carbon, that is still going on just as extensively as ever, is it not?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial, the question being too comprehensive, and including all character and descriptions of manifolding books, the problems of which are not the same as in the construction of the book in suit. (Question read.)

A. Well, I don't know how extensively it is going on, and I don't care, because I am not much interested in it. But with regard to placing with the trade the books described by the patent in suit, I know what I am talking about. But outside of the books that I claim here in the patent, I don't care what they make—they can make what they want.

XQ. 17. (By Mr. TOWNSEND.) You are making simply your special kind of book, in which you stitch your carbon in, are you not?

Mr. WHITE.—We object to that as incompetent and immaterial.

A. I am making the books described in this patent.

XQ. 18. (By Mr. TOWNSEND.) Answer my question, please.

A. Well, I am making these books that I have de-

(Testimony of Alexander Levison.)

scribed in this patent.

XQ. 19. In your books the carbons are stitched in with leaves divided into the plurality of sections, are they not?

A. It says here, "A plurality of sections, not less than three." That is what I am doing.

XQ. 20. That plurality of sections is what you are using, and you are stitching your carbons into books of that sort, and always have?

A. I am stitching my carbons into books as described in this claim in this patent.

XQ. 21. You are attaching your carbons in a bound book with leaves having a plurality of sections, and these leaves or these sections and the carbons being united by stitching, are you not?

Mr. WHITE.—We object to that as immaterial, what the character of binding is, as the same is not specified in any of the claims.

A. We bind carbon paper in the books. We do not necessarily have to stitch it in, we bind it in. Any method of binding it in is binding. Now, we bind it in the books.

XQ. 22. (By Mr. TOWNSEND.) You have always stitched it in, have you not? You have bound it in as a stub, have you not?

Mr. WHITE.—We object to that as immaterial.

A. Binding in don't mean stitching in.

XQ. 23. (By Mr. TOWNSEND.) You have bound it into a stub when you made up your book, have you not? A. We bind it into a stub.

XQ. 24. You do that when you make up your book?

(Testimony of Alexander Levison.)

Mr. WHITE.—We object to that as immaterial.

A. Yes, we bind it into the stub when we made up the book.

XQ. 25. (By Mr. TOWNSEND.) Your carbon cannot be removed without tearing it out, either, can it?

Mr. WHITE.—We object to that as immaterial.

A. In the particular book that we are manufacturing, extensively, they cannot be taken out, and that is the selling of it. That is the reason that they sell, because the carbons cannot be taken out.

XQ. 26. (By Mr. TOWNSEND.) They have to be torn out, do they not?

A. They don't have to be torn out. If we don't want to put them in permanently enough to tear them out, we could put them in so that they could come out without tearing, and they would still be bound in the book.

XQ. 27. Well, I am asking you the question, Mr. Levison: Prior to your getting up this alleged invention, they were manufacturing books with a plurality of sections, and a carbon to interfold with those sections, all bound into a stub by stitching or other means? Is not that the fact?

Mr. WHITE.—We object to that as leading, indefinite and uncertain, as to the number of sections of the recording leaves; uncertain as to what counsel means by the expression, "plurality."

A. I have said before that I did not contend anything on less than three sections; that three sections or more is my original invention; that less than three

(Testimony of Alexander Levison.)

sections I did not claim on. I don't claim on duplicating books. There have been duplicating books with carbons attached for a long time. I answered that way before.

XQ. 28. (By Mr. TOWNSEND.) Then your invention, your alleged invention, consisted in adding one or more sections to the sheet?

A. No, not within a long ways. The merely adding of a section to a sheet would mean absolutely nothing. When you use a duplicate book you have got to use a semi-faced carbon paper, carbonized on one side. When you get to making three copies you have got to use a double-faced carbon paper.

XQ. 29. Were you the first to use double-faced carbon?

Mr. WHITE.—We object to that as immaterial.

A. No.

XQ. 30. (By Mr. TOWNSEND.) There was nothing new in even triplicate books, before your alleged invention, and double-faced carbon, was there?

Mr. WHITE.—We object to that as immaterial.

A. No, double-faced carbon with triplicate books were used before, but it was bound as loose carbon. And there was a party called on me and tried to sell me this patent for \$75, and I would not buy it.

XQ. 31. (By Mr. TOWNSEND.) Then your invention was simply taking that loose carbon and binding it into this book of yours, was it?

Mr. WHITE.—We object to that on the ground that no such statement has been made.

(Testimony of Alexander Levison.)

A. No; in the mere taking of a double-faced carbon and putting it in between three sheets without giving it any study, that was what they did, and as a consequence it would not sell. But we have a good many elements in here, all combined together, making a book that seems to be thoroughly satisfactory and sells quicker than the other books.

XQ. 32. (By Mr. TOWNSEND.) I understand that prior to your alleged invention there were triplicate books of this character with triplicate bound leaves and loose double carbons?

A. Yes, sir. They could not give them away, either, in this town.

XQ. 33. You stated that you considered Claims 3 and 4 of the patent sued on, substantially of the same scope. Do I understand you rightly in that?

A. Well, except without reading it carefully I could not tell. I think that Claim 3 is without a cardboard backing.

XQ. 34. Claim 4 is also without a cardboard backing?

A. All these claims are substantially the same. They are very similar, you know. You have just got to study it out, that is all.

XQ. 35. Do you consider Claims 3, 4 and 5 substantially the same in scope?

Mr. WHITE.—We object to that as incompetent and immaterial, calling for a legal conclusion.

XQ. 36. (By Mr. TOWNSEND.) I should say calling for the same elements.

A. Well, they call for a book with all the ele-

(Testimony of Alexander Levison.)

ments, a big portion of all the elements, a book with three equal parts and a book with parts that are not equal; simply describing the various manners in which the same book could be made. That is all.

XQ. 37. Do not both Claims 3 and 4 call for sheets having three substantially equal, separate parts?

A. Well, my patent attorney drew those claims, and I am not going to study them out to point out a legal answer.

XQ. 38. I am asking for what the elements read in there, that they call for. You said that these claims were all readable into the defendant's device.

A. Well, I will go through them again. (After reading.) Well, the patent is there. It speaks for itself. You can't change it any. I can't change it by answering that question, it is there.

XQ. 39. You cannot tell the difference between Claims 3 and 4?

A. I could if I studied them. "A manifold book comprising in order a double-carbon sheet and a plurality of recording sheets." There is the double-carbon sheet, and there is the plurality of recording sheets.

XQ. 40. I asked you to compare Claims 3 and 4.

A. "The record sheets outside the stubs being divided into three substantially equal, separable parts." Claim 3 is for a triplicate book, and Claim 4 is for a book with more than three copies.

XQ. 41. In your opinion, then, it required invention to make a book of four copies or more than

(Testimony of Alexander Levison.)

three copies, when you have been shown a way to make three copies, did it?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial, that matter not being in issue in this case.

A. When I got up the triplicate book, I got up the quadruplicate book, and I explained this as nearly as I could to my attorney, and he drew these claims and told me what I needed. He was the doctor. I was not. I did not tell him what to give me. I told him that I wanted to protect this book, and I described it, and this is what he gave me.

XQ. 42. (By Mr. TOWNSEND.) Claim 4 is for a quadruplicate book, while Claim 3 is for a triplicate book. A. Yes.

XQ. 43. And Claim 4 being for a quadruplicate book, then from Claim 3 it required invention to make it into Claim 4.

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial, and calling for a conclusion.

A. I don't say that, either.

Mr. WHITE.—It is not for the witness to testify to the scope of these claims. It is for the Court to determine what scope should be given to the claims.

The WITNESS.—The triplicate and quadruplicate books are identically the same. They require the same elements, the same kind of carbon paper, the same construction, the same method of folding, and everything is the same. But it is my conclusion that what you are coming at is the difference between

(Testimony of Alexander Levison.)

a duplicate and a triplicate, and if a triplicate requires invention over a duplicate, and if a quadruplicate requires invention over a triplicate, that the duplicate and triplicate would be the same. Else what difference in the world would it be? The duplicate book is used with single-faced carbon, made of one fold. In the triplicate book that brought in the double-faced carbon with two folds or three folds, and the quadruplicate used the natural folding of the triplicate; whereas the duplicate, which had been in business for years, never came out with the triplicate carbon attached; therefore it shows me that there is a big difference between those two.

(Further hearing continued subject to notice.)

Saturday, February 27, 1909, 2 P. M.

Counsel appearing:

W. K. WHITE, Esq., of MILLER & WHITE,
Solicitors for Complainant.

C. E. TOWNSEND, Esq., Solicitor for Defendant.

(It is hereby stipulated and agreed by and between the parties to the above-entitled suit, that the complainant may have to and including April 1, 1909, in which to take its rebuttal testimony herein.)

[Testimony of Edward F. Crandall, for Defendant.]

Testimony of EDWARD F. CRANDALL, called for defendant, sworn.

(By Mr. TOWNSEND.)

Q. 1. State your full name, age, residence and occupation.

(Testimony of Edward F. Crandall.)

A. Edward Ford Crandall; aged 35. I am in the employ of Cunningham, Curtiss & Welch. My residence is Oakland.

Q. 2. What is the nature of the business of Cunningham, Curtiss & Welch?

A. They are wholesale stationers and printers and blank-book manufacturers.

Q. 3. What is your position in that company?

A. I am assistant manager of the company.

Q. 4. How long have you been with them?

A. I have been with them about 20 years.

Q. 5. In what department have you worked there?

A. I have served in all departments of the house. For the past 10 years and up to the 1st of January I was head of what is known as the manufacturing department, the printing and bookbinding department.

Q. 6. Do you manufacture manifold books in your firm? Do you handle them?

A. By manifold books you mean carbon books?

Q. 7. Yes. A. Yes.

Q. 8. What is the extent, in a usual way, of the size of the business of your firm, compared with other firms?

Mr. WHITE.—We object to that as immaterial.

A. I should say we are the largest house on the Pacific Coast.

Q. 9. (By Mr. TOWNSEND.) Does your firm handle a triplicate book? A. Yes, sir.

Q. 10. Do you handle the Levison book?

(Testimony of Edward F. Crandall.)

A. No.

Q. 11. Do you handle a triplicate shipping receipt-book? A. We do.

Q. 12. Have you much trade in that line?

A. Yes; we have a large trade in it.

Q. 13. Where is that trade confined to particularly, if confined, and how extensive is it?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial, what the amount of business done by Cunningham, Curtiss & Welch is.

A. They are sold all over the coast; in the Islands, Nevada, wherever we do business we sell the shipping-books.

Q. 14. You sell those books in San Francisco, do you?

Mr. WHITE.—The question is objected to as indefinite and uncertain as to the form of the book and the construction of the same, referred to by counsel.

A. We do.

Q. 15. (By Mr. TOWNSEND.) Do you know the Levison book, the Levison patent, here in issue?

A. Well, I know what is known as the Levison book. Of course, I don't know what they hold their patents on.

Q. 16. Do you know what the Levison book is on the market?

Mr. WHITE.—We object to that as indefinite as to what the form of the book is, as referred to by counsel, it having already appeared in this case that the Levison Co., the Levison who is complainant in this case, has marketed a large number of different

(Testimony of Edward F. Crandall.)

character of books, all of which are called the Levison book.

Q. 17. (By Mr. TOWNSEND.) I show you copy of Complainant's Exhibit "B," and ask if that is the book which you are putting on the market, a triplicate book of that sort.

Mr. WHITE.—We object to that question, no proper foundation having been laid, it not having been shown that this witness is competent to read drawings or specifications of a patent, or to understand the same.

A. No, we did not sell that style of book.

Q. 18. (By Mr. TOWNSEND.) Do you recognize the drawing before you as corresponding to the Levison book?

Mr. WHITE.—We make the same objection.

A. Yes, I think I do.

Q. 19. (By Mr. TOWNSEND.) May I ask you whether it is a fact or not that Mr. Levison's company have practically monopolized the business of triplicate books or manifolding books, in this city?

Mr. WHITE.—That question is objected to, no proper foundation having been laid; and on the further ground that the same is indefinite and uncertain, as to the form and construction of the book referred to.

A. He has not, as far as I know.

Mr. WHITE.—I move to strike out the answer, on the ground stated in the objection, and I give notice to counsel that we will renew this motion, at the final hearing.

(Testimony of Edward F. Crandall.)

Q. 20. (By Mr. TOWNSEND.) What would be the reason for your last answer, that he has not monopolized the business?

Mr. WHITE.—We make the same objection.

A. Well, the reason would be that we sell a great many of the other style of shipping-book. We have no call to speak of, for this book. Once in a great while some one will come in and ask for a Levison book. But we have very little call for the Levison Shipping-book.

Mr. WHITE.—We make the same motion, and give the same notice.

Q. 21. (By Mr. TOWNSEND.) But you say that you do sell a great many shipping-books of triplicate form in this city? A. Yes.

Q. 22. And that you don't use the Levison book?

Mr. WHITE.—We object to that as leading; and upon the further ground of its being indefinite as to the specific book referred to.

Q. 23. (By Mr. TOWNSEND.) If Mr. Levison's book has met with popularity, what would you ascribe that popularity to?

Mr. WHITE.—We object to that as calling for a mere conclusion of the witness; no proper foundation laid.

A. The popularity would be due to his soliciting the trade.

Q. 24. What other reasons?

Mr. WHITE.—Same objection.

A. Well, I don't know. He has solicitors out all over the State showing the book; all over the city

(Testimony of Edward F. Crandall.)

and all over the State, so far as I know, showing the book and soliciting the trade for it. That is about the only reason that I see that it sells. I don't know whether it is any better book or any worse book than the one we sell.

Q. 25. (By Mr. TOWNSEND.) Do you know whether any other firms in this city sell the triplicate receipt-books other than Mr. Levison?

Mr. WHITE.—We object to that as indefinite and uncertain, as to the form of the book referred to.

A. There are other firms making a specialty of shipping-books, and they sell a great many of them.

Q. 26. (By Mr. TOWNSEND.) How long have your firm been selling triplicate receipt-books?

Mr. WHITE.—We object to that as immaterial, and on the further ground that the question is indefinite as to the form and construction of the books referred to; and if the purpose is to anticipate the patent in suit, the question is further objected to on the ground that the name of this witness as a user or one familiar with the invention is not set up in the answer as provided for by section 4920 of the Revised Statutes.

A. I could not answer that question, as they have sold the books as long as I have been with them, which is about 20 years.

Mr. WHITE.—I move to strike out the answer on the ground stated in the objection. Notice is given that this motion will be renewed at the final hearing.

Q. 27. (By Mr. TOWNSEND.) With your ex-

(Testimony of Edward F. Crandall.)

perience as a binder and in the printing business, Mr. Crandall, what is your understanding of the term "a bound book" or a book in which the carbon is bound in with the leaves?

Mr. WHITE.—The question is objected to on the ground that no proper foundation has been laid for the same, and on the further ground that it calls for a conclusion of the witness.

A. My idea of the question would be a book with the carbon stitched to it, the same as balance sheets are, either sewed with wire or staples of some sort, that we have.

Q. 28. (By Mr. TOWNSEND.) In a bound manifold book do you generally consider that the sheets are fixedly bound, that all the sheets are fixedly bound together, or that some of them may be removed?

Mr. WHITE.—That is objected to as leading, and on the further ground that no proper foundation has been laid.

A. A bound book, I should say, that the sheets in the book must be bound through.

Q. 29. (By Mr. TOWNSEND.) I will show you Complainant's Exhibit "A," which is a book such as is made by the respondent, Mr. Kitchen's Company, and ask you if you consider the carbons there shown as bound into that book, speaking from your experience in the book-binding art?

Mr. WHITE.—That question is objected to, on the same grounds and on the further ground that no proper foundation has been laid.

(Testimony of Edward F. Crandall.)

A. I would not call that carbon bound in a book. It looks to me as a loose leaf carbon, simply a separate piece of carbon.

Q. 30. (By Mr. TOWNSEND.) In a contract to supply manifolding books, if that contract called for a bound book, with the carbon bound in, what would you from your experience in your line of business, understand by that?

Mr. WHITE.—We object to that as leading; and on the further ground that no proper foundation has been laid.

A. I would consider the carbon to be sewed in with the other sheets, the same as the other sheets are.

Q. 31. (By Mr. TOWNSEND.) Would you consider, and would it be considered in the bookbinding art, that the exhibit "A," respondent's book, fulfilled the requirements of that contract?

Mr. WHITE.—That is objected to as leading.

A. No, I should not.

Mr. TOWNSEND.—That is all.

Cross-examination.

(By Mr. WHITE.)

XQ. 1. What is the purpose of binding the carbon sheet in a book of this character?

A. Well, I don't know how to answer that question. The purpose of binding it in there is to hold it, I suppose.

XQ. 2. And would you say that any means which would hold it there you would consider as a means of binding it there?

(Testimony of Edward F. Crandall.)

A. No, I should not say that.

XQ. 3. You say the purpose of binding the carbon in the book is for the purpose of holding it there; and if you provide means for holding it there, that does not necessarily mean that it is bound there?

A. No, sir.

XQ. 4. What is the difference between the meaning of the word "hold" and the meaning of the word "bind"?

A. Well, I don't know. There are several different schemes or ways of holding carbon in there. For instance, can I illustrate?

XQ. 5. You may.

A. We sell what is known as a pen letter-book, which uses a carbon that has the same sort of an arrangement as this. It has a piece of metal that fastens in here, and holds it evenly there, and the binding itself holds the carbon in place.

XQ. 6. In that form of book is the carbon held in place and used in place? A. No, sir.

XQ. 7. It is not bound in place?

A. No, sir.

XQ. 8. If you took a book of that kind and turned it upside down it would drop out, would it not? A. No, it would not.

XQ. 9. What would prevent it from dropping out?

A. The pressure of the leaves here would bind the book.

XQ. 10. It is held in place then? A. Yes.

XQ. 11. It is not bound in place?

(Testimony of Edward F. Crandall.)

A. Well, no; not bound in, not stitched in. It is simply held underneath there. The pressure of the book holds it in place.

XQ. 12. You sell different forms of binders to hold leaves in place? A. Yes, sir.

XQ. 13. What do they call them? Do they call them binders when they hold leaves together by friction pressure?

A. I could not answer that question, because I don't know. Some concerns call them folios, some call them binders. They catalogue them in different ways. They are manufactured by different concerns, and different concerns catalogue them in different ways.

XQ. 14. Is it not a fact that in your stock you have binders, what are called binders in catalogues, which bind the leaves together simply by friction or pressure? A. Yes.

XQ. 15. And those articles are known as binders because they bind the leaves together in that manner?

A. Well, they generally term them a loose leaf holder. They are not termed binders. Most of the manufacturers call them loose sheet holders.

XQ. 16. Isn't it a fact that a great many of them are called binders?

A. Oh, no; not that class of binders. They do where it is held by a ring; they are called binders.

XQ. 17. Are you familiar with the tortion binder? A. No, sir.

XQ. 18. You notice, Mr. Crandall, that I am re-

(Testimony of Edward F. Crandall.)

ferring to this book, Complainant's Exhibit "A," and I am lifting it by taking hold of the end of the carbon sheet alone, do you not? A. Yes.

XQ. 19. And how am I able to lift the book in this manner when the carbon sheet is not bound in with the leaves of the book and so held in place?

A. Well, I suppose the pressure of the binding of the book holds it in place. Probably if you would pull it in this way it would come out. You are lifting it against the binding.

XQ. 20. It requires force to pull it out?

A. Yes.

XQ. 21. Now, in the ordinary use of a book of this character, Complainant's Exhibit "A," would the carbon fall out unless it was pulled out?

A. I don't exactly understand the question.

XQ. 22. In the ordinary use of a book of the character of Complainant's Exhibit "A," would the carbon be held in place by the means embodied in this Complainant's Exhibit "A" for that purpose?

A. Not unless it had some mechanical device to hold it there.

XQ. 23. I am directing your attention to this book and the means embodied in the same for holding the carbon in place, and I ask you, in the ordinary use of such a book, would not the carbon be held in place?

A. I don't exactly understand the question. As I say, it would be held in place if they used some mechanical device to hold it there, such as is used there, I should consider such a device to be holding the carbon in place.

(Testimony of Edward F. Crandall.)

XQ. 24. It binds it in position, does it not?

A. It don't bind it, no, sir; not what I would term binding. It does not bind it there.

XQ. 25. What do you understand by the term binding? A. Sewed in there.

XQ. 26. Where did you ever get the idea that "bound" meant "sewed"?

A. Well, I don't know. As I say, I don't believe that a loose-leaf book is a bound book, or a sewed book. We would not speak of a loose-leaf book as a bound book.

XQ. 27. Do you know whether in the use of these triplicate books and duplicate books parties using the same object to the carbons being loose and not bound in the book?

A. Oh, some of them prefer it bound, and some loose. We make it both ways.

XQ. 28. Why do they prefer it bound in a book?

A. It is a little easier to handle.

XQ. 29. In what way are they easier to handle?

A. Well, they don't handle the carbon every time. They turn the leaf over, you know. Of course, in a book like that, where the carbon is bound in, to work on the next leaf you must tear out the first leaf, you understand. Now, in a great many books where the original sheet would stay in the book you can't bind the carbon in because it would interfere with the next carbon copy. It is only once in a great while that we have to bind the carbon in the book.

XQ. 30. What do you suppose the purpose of the manufacturer of this book, Complainant's Exhibit

(Testimony of Edward F. Crandall.)

“A,” was, in so constructing the book and attaching the carbon with this piece of pasteboard in this way?

Mr. TOWNSEND.—We object to that question as calling for an opinion of the witness as an expression on the state of mind of the respondent.

A. I suppose the idea was to make it possibly a little more simple to handle the carbon, that is, not to have to take it out every time and replace it, if a man wanted to make a carbon copy.

XQ. 31. (By Mr. WHITE.) In order to accomplish such results does it make any difference whether the carbon is sewed in there or held in there by friction or held in there by staples or held in there by glue or held in there by any other means by which it might be held in place?

A. Well, with that loose-leaf carbon it would enable a man, if his carbon worked out sooner or later, he could get down to the next carbon and put in a new place without any trouble.

XQ. 32. You notice that there are a number of these carbons in this book, indicating that it was not contemplated that the carbon should be taken out and replaced by another. Is not that true?

A. I could not answer that question; I do not know.

XQ. 33. If this carbon here, being the first carbon, was designed to be replaced by another, this other carbon would not be placed in the book interspersed between a certain definite number of leaves throughout the book, thereby dividing it up into sections?

(Testimony of Edward F. Crandall.)

A. Before I answer that question, may I ask you a question?

XQ. 34. What is it? In explanation of any question that I asked?

A. No, it is an explanation. I want to know if that book was simply made for a sample or if it was made for an order?

XQ. 35. This book was made for an order.

A. Well, then, possibly you saw his specifications, what they called for, that there should be a carbon every so often.

XQ. 36. In other words, the user of this book intended to use the first carbon in the book with the bound sheets interposed between the first carbon and the second carbon?

A. I should say that that was the man's idea when he made it.

XQ. 37. It was the idea that he had in drawing up such specifications, to throw away the first carbon, after it had been used, with the sheets interposed between it and the second carbon, and then go on and use the second section of the book with the second carbon?

Mr. TOWNSEND.—That is objected to as being a mere hypothesis, asking him what the intention of the maker of the book was, and what the intention was of the contract on which the furnishing of these supplies was based. That is not a thing that this witness is supposed to know, what was required by the manufacturer when he furnished those books in that particular way.

(Testimony of Edward F. Crandall.)

A. I cannot answer that question as to why it was done. It may have been that the man didn't care to handle the carbon. A great many people object to handling carbon paper, because it soils their hands, and they order it put in with so many sheets between, either 25 sheets or 50 sheets to the carbon, and we bind the books in that way.

XQ. 38. (By Mr. WHITE.) As I understand you then, by binding or holding the carbon in place in this manner, it would obviate the necessity of handling the carbon and using the book in that manner—is that correct? And is that one of the purposes in so attaching the carbon to the book or holding it in place by this means?

A. I should think so.

XQ. 39. It is immaterial, is it not, what the specific means are for holding the carbon in place so long as the object desired is accomplished?

A. I don't know. I should think so. I should think so. I don't know anything about that.

XQ. 40. Would this book have any more efficiency if the carbon was held in place by glue? And I am now referring to Complainant's Exhibit "A." A. No, no more efficiency.

XQ. 41. Would it have any more efficiency if the carbon was held in place by staples? A. No.

XQ. 42. Would there be any more efficiency if the carbon was held in place by loose leaves in with the book? A. No.

XQ. 43. In all these questions I am referring to Plaintiff's Exhibit "A" which is before you.

(Testimony of Edward F. Crandall.)

A. Yes, that book there.

XQ. 44. Would you consider it an advantage to have the carbon held in place in these triplicate books rather than to have them loose as they are in some forms of this book?

A. Well, as I said before, the only advantage would be to keep the man from holding the carbon, to have them exempt from soiling their hands with the carbon. There is no advantage in it. I don't see any advantage in it myself.

XQ. 45. But of course you realize that a great many people differ with you as to certain advantages?

A. Oh, yes, certainly. We make books in any way that a man wants without any question as to the whys or wherefores.

XQ. 46. Do you personally use these triplicate books?

A. I use triplicate shipping-books, yes, sir.

XQ. 47. I mean, do you personally use these books in your ordinary business?

A. No, we use a duplicate order-book and duplicate estimate-books. The firm that I am employed by use duplicate shipping-books like any firm.

XQ. 48. Personally, you don't use these triplicate books—your firm? A. No, sir.

XQ. 49. So your idea as to the advantages or disadvantages of having the carbon attached is not based upon the actual experience that you have had?

A. No, sir.

XQ. 50. I should judge, then, that the opinions

(Testimony of Edward F. Crandall.)

of those who had actually used the book would be worth more in regard to the value of having the carbon attached than your own opinion in regard to that matter; is that not correct?

MR. TOWNSEND.—We object to that as being the mere guess of counsel.

A. I suppose so. Of course, I can't speak for the other man.

XQ. 51. Did you say that your firm carried any stock of the devices called binders which operated to hold loose leaves together by means of a cover held down in place by a spring?

A. We have loose sheet holders held with springs or rings or wire. We have one that is held there in place by wire. We have possibly a dozen loose leaf devices, some with strings and some with springs.

XQ. 52. As I understand it, some manufacturers of such devices as I have referred to, that is, the device containing a cover held in place by a spring, held down against the leaves by a spring, call them holders, and some manufacturers of the same article call them binders—is that correct?

A. No, I don't think I made that statement. I could not answer that without looking at the catalogues. Most of them, to the best of my recollection, call them loose sheet holders.

XQ. 53. How many of these triplicate books containing double carbon, or loose double carbon, does your firm sell a year?

A. Well, I could not tell without looking up my records. Of course, since the new Interstate Com-

(Testimony of Edward F. Crandall.)

merce ruling, the most of the books sold now we are compelled to use two carbons with. Formerly we used a tissue, a transparent tissue and a double carbon that showed through, you understand; but now the Interstate Commerce ruling has to be complied with, as I understand it, and on all Interstate Commerce roads they are compelled to use the three sheets; but still, on roads that are not Interstate Commerce roads and on coasting schooners and on steamers running up the river they still use the double side carbon.

XQ. 54. As I understand it, these triplicate books which you put on the market since the Interstate Commerce Act went into effect, in them you use and are compelled to use a semi-carbon instead of one double carbon, on account of the fact that the loose carbon is used. Is that correct?

A. We have books that we sell that we use two carbons with.

XQ. 55. Why do you use two carbons instead of one double carbon?

A. Well, we sell them because we sometimes have call for the book.

XQ. 56. Is it not a fact that two carbons in such a book, that is, the two carbons being used, are more convenient to handle than the single double-carbon, and that it is for that reason that the trade, or your trade, calls for two carbons?

A. No, I can't say that. I think the reason we do it is probably to push the sale of that book. It is a book that does not conflict with any patents, or

(Testimony of Edward F. Crandall.)

anything we know of; and if a man wants a shipping-book, we sell him that book.

XQ. 57. As I understand it, in that book you can either use a loose double carbon, or two semi-carbon sheets. Is that correct?

A. No, you cannot use a double carbon in that book. You can't use a double carbon.

XQ. 58. Why can't you use a double carbon in such a form of book?

A. Because the middle sheet is not transparent. As I said, the new Interstate Commerce ruling compelled us to use two or three sheets of semi or opaque sheets.

XQ. 59. Does not the Levison triplicate book use the double-faced carbon, and does not that book, when used, enable one to comply with such Interstate Commerce Act?

A. I guess so. I don't know. I suppose so. Mr. Levison sells his books right along, and he only uses a double carbon.

XQ. 60. So by the peculiar construction of his book, he is able to use one double carbon, whereas by reason of the construction of your book you are compelled to use two semi-carbon sheets. Is that correct?

A. I think so. That is, that applies only to the roads, where the Interstate Commerce law affects them. It does not apply to shipping up and down the Coast.

XQ. 61. When did you first commence selling these books containing the two semi-carbonized

(Testimony of Edward F. Crandall.)

sheets just referred to?

A. Well, we have sold them for years.

XQ. 62. You have sold them prior to the Interstate Commerce Act?

A. Yes, we used to manufacture ten or fifteen years ago, before this transparent paper came on the market, we used to make our books the same as we make them now, using two carbons; but I should say about 10 or 12 years ago, this transparent paper came on the market which enabled us to put this transparent paper in there, and use one carbon.

XQ. 63. How many books of that character does your firm sell a year?

A. I could not answer, without looking up my record.

XQ. 64. How many books of that character are sold in San Francisco during a year?

A. I could not tell.

XQ. 65. How many books of the character described in the Levison patent in suit are sold by the Levison Co. each year?

A. I don't know.

XQ. 66. Do you know what proportion of the business of such character of books is done by Levison & Co.?

A. No, sir.

XQ. 67. Do you know what proportion of the business is done here by Levison & Co., since the introduction of their books?

A. No, sir.

XQ. 68. Do you know to what extent other books of this character have been driven out of the market by the introduction of the Levison covered by the patent in suit?

A. No, sir.

(Testimony of Edward F. Crandall.)

XQ. 69. Do you know whether or not a large proportion of other character of triplicate books have been driven out of the market by reason of the sale of the Levison book covered by the patent in suit?

A. I don't know. We sell as many books, I guess, as anybody.

XQ. 70. You say you don't handle the Levison book? A. No.

XQ. 71. I presume that is one reason why people don't apply to you for the Levison book?

A. We have bought the Levison book, but we don't keep it in stock for a stock-book.

XQ. 72. I understand that the Levison book sells for more money than do the other books which you handle. Is that not the fact?

A. I don't know what it sells for. Our book sells for a dollar. I don't know what that sells for.

XQ. 73. Did you purchase these triplicate books referred to by you—do you purchase them or do you manufacture them?

A. We purchase them, I guess you would call it. We have them manufactured for us.

XQ. 74. Isn't it a fact that you are able to purchase such a character of book cheaper than you are able to purchase the Levison book?

A. I don't know. I never inquired from Mr. Levison about the price of the book. He makes a regular discount, a certain discount on regular stock-books, regular stock orders that we get. We turn them over to him whenever we get an order for books

(Testimony of Edward F. Crandall.)

of his class, we turn them over to him and he fills it, and allows us a certain discount.

Mr. WHITE.—Take the witness.

Redirect Examination.

(By Mr. TOWNSEND.)

RDQ. 1. You just stated, Mr. Crandall, that you didn't know whether Levison's book had driven all the other triplicating books out of the field. Do you believe that all the other triplicating books have been driven out of the field by Levison's?

Mr. WHITE.—We object to that question as immaterial and leading.

A. I don't think I said that. I know his book has not driven all the other books out of the field.

RDQ. 2. State if you know how long to your knowledge triplicating books have been in use?

Mr. WHITE.—The question is objected to on the ground that it is asked for the purpose of anticipating the patent in suit and is incompetent on the ground that the name of this witness as one being familiar with the invention covered by the patent in suit is not set up in the answer as provided by section 4920 of the Revised Statutes; and on the further ground that no proper foundation has been laid; and on the further ground that the question is indefinite as to the specific construction of the book referred to.

A. As far as I remember, it is twenty years.

Mr. WHITE.—I move to strike out the answer of the witness on the grounds stated in the objection, to wit, that the name of the witness is not set up in

(Testimony of Edward F. Crandall.)

the answer as the user of the invention covered by the patent in suit, or as a person having knowledge of such invention; and I give notice to counsel that we will renew this motion at the final hearing.

RDQ. 3. (By Mr. TOWNSEND.) You have stated that manifolding books with bound and loose carbons have been in use for a long time?

Mr. WHITE.—We object to that question as indefinite and uncertain as to the character of the book referred to, and on the grounds stated in the objection to the previous question.

A. As far as I can remember.

RDQ. 4. (By Mr. TOWNSEND.) Is that distinction, bound and loose carbons, recognized in the trade?

Mr. WHITE.—We object to that as not being proper redirect examination; also as leading.

A. It is.

RDQ. 5. (By Mr. TOWNSEND.) When you testified as to the advantages and disadvantages of loose leaves and bound leaves, what was the basis of that answer?

Mr. WHITE.—We object to that as not proper redirect examination.

A. I don't understand the question.

RDQ. 6. (By Mr. TOWNSEND.) You stated that you did not use the triplicating book personally, but I understand in your previous examination that you stated that you had been in the manufacturing department where these books were made. Is that true? A. Yes, sir.

(Testimony of Edward F. Crandall.)

RDQ. 7. And is your knowledge and experience of these things such that it is possible to gain from the orders that have come through from your customers, a knowledge of this class of books?

Mr. WHITE.—We object to that as grossly leading, and suggesting to the witness the answer that he is to make.

A. As I say, we bind all books just as our customers want. If a man orders the carbons bound in, we bind them in. If he orders the carbons loose, we give him loose carbons.

RDQ. 8. (By Mr. TOWNSEND.) Will you state what proportion of your customers ask for fixed carbons with triplicate sheets, and what proportion ask for loose carbons in triplicate sheets?

Mr. WHITE.—We object to that as immaterial; and further, that no proper foundation has been laid.

A. Probably 1 per cent want the carbons bound in the book.

RDQ. 9. (By Mr. TOWNSEND.) In your testimony on cross-examination, referring to Exhibit "A" of respondent's device, counsel suggested that the use of a series of carbons necessarily presupposed the using up of the record sheets for that carbon. I will ask you, is it likely that in a book such as is shown by exhibit "A," that the carbon may become torn out?

Mr. WHITE.—We object to that on the ground that no proper foundation has been laid; this witness having testified that he has not used these books

(Testimony of Edward F. Crandall.)

and that he has had no experience with them, therefore he is not competent to answer the question.

A. One reason is, that the carbon becomes torn, and worn out; torn or worn out. There are different grades of carbon. Of course, one will last longer than the other.

RDQ. 10. (By Mr. TOWNSEND.) What occurs when the carbon is worn out or torn?

A. You can't get your copy.

RDQ. 11. What is desirable in a case of that sort?

Mr. WHITE.—We object to that as immaterial.

A. What is desirable?

RDQ. 12. (By Mr. TOWNSEND.) Yes, what is desirable in a case of that sort?

Mr. WHITE.—We object on the further ground that it is not redirect examination.

RDQ. 13. (By Mr. TOWNSEND.) Is it desirable to replace that carbon?

Mr. WHITE.—We make the same objection; also that it is leading.

A. Yes, you would have to put a new carbon in it.

RDQ. 14. (By Mr. TOWNSEND.) Does respondent's book, exhibit "A" there, permit that?

Mr. WHITE.—The question is objected to as incompetent, irrelevant and immaterial, and on the further ground that it is not redirect examination.

A. It does.

Mr. TOWNSEND.—That is all.

(Testimony of Edward F. Crandall.)

Recross-examination.

(By Mr. WHITE.)

RXQ. 1. You say about one per cent of your customers called for these triplicate books with the carbon bound in?

A. I should say about that. Of course, I can't remember off hand. It is very seldom that we have a call for carbon bound in the book. Very, very seldom.

RXQ. 2. What do you do with such orders?

A. Fill them.

RXQ. 3. When did you last make a triplicate manifolding book with the carbon bound in?

A. I could not answer. That I don't know.

RXQ. 4. With the triplicate carbon bound in that book, so that you had a double carbon?

A. I could not answer that. I don't remember.

RXQ. 5. To whom did you sell such a form of book?

A. I could not answer that question. I can't remember. We sell to everybody in San Francisco; not everybody, but to a great many firms in San Francisco.

RXQ. 6. Is it not a matter of fact that your firm never did make a triplicate manifold book with double carbons bound in?

A. No, sir, it is not. We do make them. That is, we have taken orders for them. We don't manufacture the books, you know.

RXQ. 7. But you turn those orders over? To whom do you turn them over?

(Testimony of Edward F. Crandall.)

A. To different binders.

RXQ. 8. Can you name a single firm in town to whom you ever turned over an order for a triplicate manifolding book having the double carbons bound in, which order was filled?

A. Yes, we have turned those over to Mr. Levison.

RXQ. 9. Isn't it a fact that you never turned those orders over to any other firm but Mr. Levison?

A. No, we have turned those orders over to other binders.

RXQ. 10. Name some of those other binders.

A. Possibly Mr. Kitchen, or Mr. Malloye, or Mr. McIntyre. They all do work for us.

RXQ. 11. You say you have turned over those orders to one of those parties for triplicate manifolding book with the double carbon bound in?

A. To the best of my recollection I have. I could not specify the time, though, that was done. As I say, we have had very little call for that class of books.

RXQ. 12. Do you have any personal recollection that any of these firms mentioned by you ever filled such an order and delivered to you triplicate manifolding books with double carbons bound in?

A. No. Probably I would have to go over my records to see. I don't know whether we have taken any such orders since the fire or not. Of course, previous to the fire we did so.

RXQ. 13. Do you have any present recollection of ever having such an order as that prior to the fire?

(Testimony of Edward F. Crandall.)

A. Not lately.

RXQ. 14. I don't want you to rely upon your imagination. I want to know whether you have any present recollection or memory of such an occurrence.

A. No, I could not tell you of any particular one. I know we have made books with carbons sewed in, or bound in the books, but when it occurred, I cannot tell you.

RXQ. 15. In these sheets used in these loose leaf binders or holders, is there not a statement on one end of the sheet, or is there not a statement, that that sheet, that end, is to be bound in?

A. No, I don't think so.

RXQ. 16. In regard to such loose sheets which are not to be held together by these various binding devices, is it not customary in the trade to refer to one edge of the sheet as the binding edge?

A. It is. They generally leave a margin there for that purpose.

Mr. WHITE.—That is all.

Redirect Examination.

(By Mr. TOWNSEND.)

RDQ. 1. How many books have you ever ordered from Mr. Levison?

A. At one time or altogether?

RDQ. 2. Yes.

A. Oh, possibly a gross of books.

RDQ. 3. What were the circumstances leading to that order?

A. The main reason was, if I can remember right,

(Testimony of Edward F. Crandall.)

shortly after the fire we had a demand for shipping-books. We had placed our order in the Eastern market for shipping receipt-books and they had not arrived, and as Mr. Levison had some, we bought them from him.

RXQ. 1. (By Mr. WHITE.) Your firm does not make a specialty of manifolding books, does it? It simply carries a line of stock of that kind in connection with a large line of other articles?

A. Yes, sir. We try to carry anything that is called for that we can make any money in.

[Testimony of Frederick E. Maynard, for Defendant.]

Examination-in-chief of FREDERICK E. MAYNARD, called for defendant, sworn.

(By Mr. TOWNSEND.)

Q. 1. Please state you full name, age, residence and occupation.

A. Frederick E. Maynard; my residence is Berkeley. I may say that I devote my time as an occupation exclusively to the preparation and prosecution of applications for patents, before the Patent Office.

Q. 2. How long have you been engaged in Patent Office practice, and what has been the nature of that business?

A. Ten years; and the nature of the business has been such as that of all other attorneys; the preparation of drawings and specifications from models, sketches, and frequently verbal descriptions of inventions as presented to the office by inventors.

(Testimony of Frederick E. Maynard.)

Q. 3. Are you familiar with drawings and the reading of drawings?

A. My time is mostly occupied in the making and reading of drawings.

Q. 4. And have you had experience in the preparation of specifications? A. I have.

Q. 5. And in drafting the claims?

A. I have.

Q. 6. Are you familiar with the drawings relating to the manufacture of manifolding books?

A. I am.

Q. 7. And to patents relating to the same?

A. I am.

Q. 8. Have you made any examination along that art? A. Frequently.

Q. 9. I show you a patent to Heman G. Barlow and John B. Barlow, device for manifolding and copying, No. 297,556, April 29, 1884, and ask you if you understand the drawings, description and construction therein shown and described?

A. I do.

Q. 10. I meant first to ask you if you have read and examined that particular patent?

A. I have.

Mr. TOWNSEND.—We ask to have that introduced in evidence, and marked as an exhibit. (Marked Defendant's Exhibit No. 1.)

Q. 11. I show you a patent to G. E. Doughty, No. 612,197, dated October 11, 1898, for manifold book, and ask you if you have read and understand that patent?

(Testimony of Frederick E. Maynard.)

A. I have read it, and I understand it.

Mr. TOWNSEND.—I introduce that in evidence as Defendant's Exhibit No. 2. (So marked.)

Q. 12. I show you a patent to A. Abraham, No. 634,438, dated October 10, 1899, for manifold sales-book, and ask you if you have read that patent and understand the description and drawings therein?

A. I have read it, and do understand it.

Mr. TOWNSEND.—I offer that in evidence, and ask to have it marked Defendant's Exhibit No. 3. (So marked.)

Q. 13. I show you a patent to H. P. Brown, duplicating pad or sheet, No. 589,372, dated August 31, 1897, and ask you if you have read that patent and understand the description and drawings therein?

A. I have read the patent, and do understand it.

Mr. TOWNSEND.—I offer that in evidence, and ask to have it marked Defendant's Exhibit No. 4. (So marked.)

Q. 14. I show you a patent to Alexander Levison, No. 694,103, dated February 25, 1902, for manifold book, and ask you if you have read that patent, and understand the description and construction therein shown and described?

A. The patent to Levison? I have read it, and do understand it.

Mr. TOWNSEND.—We offer that in evidence, and ask to have it marked Defendant's Exhibit No. 5.

Mr. WHITE.—We object to it as incompetent, ir-

(Testimony of Frederick E. Maynard.)

relevant and immaterial. (Marked Defendant's Exhibit No. 5.)

Q. 15. (By Mr. TOWNSEND.) Mr. Maynard, have you read and do you understand the patent to E. J. Perry, reissue No. 11,547, dated June 9, 1896, for carbon copying manifold sheet or book, a copy of which I now show you?

A. Yes, I have read the drawings and understand the specification.

Mr. TOWNSEND.—I offer this in evidence and ask to have it marked Defendant's Exhibit No. 6. (So marked.) I introduce in evidence as Exhibit No. 7, patent to Rengough, No. 553,503, dated January 28, 1896. I have not the patent with me, but will produce it later, and ask when it is supplied, to have it marked Defendant's Exhibit No. 7.

Q. 16. I show you a paper and ask you if you have ever read it and if you understand what it is—if you understand its contents?

A. This appears to be a copy of the file wrapper of the reissue letters patent of Alexander Levison, No. 12,005 granted July 1, 1902, for improvement in manifold books, which I have read and understand.

Mr. TOWNSEND.—I wish to introduce in evidence the certified copy of file wrapper just referred to, and ask that it be marked Defendant's Exhibit No. 8. (So marked.)

Q. 17. I show you a specimen triplicate receipt-book in blank, and ask you if you know what that is, what it appears to be.

A. I should state that this appears to be a model

(Testimony of Frederick E. Maynard.)
representing the Barlow patent.

Q. 18. The Barlow? Do you refer to Exhibit 1?

A. Exhibit No. 1.

Q. 19. Taking the Barlow Exhibit No. 1 and comparing it with the model before you, will you state whether or not that is the correct representation, and, if not, wherein it differs in any respects?

A. This is a model representing the Barlow patent in all respects, except that it is not printed; in having a plurality of duplicate recording sheets and a double carbon loose in the book, not bound.

Q. 20. I asked you wherein it differed, if at all, from the device of the patent?

A. There is no difference.

Q. 21. Now, the difference further than that first particular that you have spoken about, that this was a blank book and the other was a printed book—

A. Yes, I answered that.

Mr. TOWNSEND.—I offer in evidence this model just referred to, and ask that it be marked Defendant's Exhibit No. 9. (So marked.)

Q. 22. I show you another model, Mr. Maynard, and ask you if you recognize what that is?

A. That is a manifold sales-book, comprising a cover and a plurality of triplicate recording leaves.

Q. 23. By referring to any of the patent exhibits on file, does that correspond to any of them?

A. It does, precisely, in principle, but the detail of construction is somewhat different, this being a crude model of the patent.

Q. 24. Which patent do you refer to—just take

(Testimony of Frederick E. Maynard.)

a look at the patents?

A. The Doughty patent.

Q. 25. Exhibit 2? A. Exhibit 2.

Q. 26. State wherein this model referred to differs, if any, from the Doughty patent, exhibit 2.

A. There is a difference in the detail construction of the parts, in that the frame which connects the movable carbon to the cover in the patent is represented as being of wire or suitable metallic structure, whereas in the model the frame is merely stiff cardboard used in lieu of the wire frame of the patent.

Q. 27. Is there any difference in operation between the exhibit model and the design of the drawing of Doughty?

A. The operation is the same. I might even go back to the previous question and state that further; I notice that the clamps are not precisely the same.

Q. 28. You are referring, then, to the clamp holding the pad in.

A. The clamp holding the pad to the cover, there being some difference in detail of construction in that member.

Q. 29. State whether or not the carbon is held in substantially the same manner as in the Doughty patent, exhibit 2.

A. It is held in substantially the same manner. It is held by clamps which vary in detail only from the Doughty patent.

Q. 30. What corresponds to the clamps of the

(Testimony of Frederick E. Maynard.)

Doughty patent holding the carbon in the model?

A. The carbon in the Doughty patent is held by a small clip, which is carried at the end of the frame "D" of the patent, whereas in the model exhibited the carbon is held to the frame by simple paper fasteners.

Q. 31. How is the frame "d" in the Doughty patent connected to the back of the cover "A" in the patent?

A. I should say that it was flexibly connected.

Q. 32. How is it in the model?

A. Also flexibly connected.

Q. 33. Would you say "flexibly" or hingedly?

A. Well, hingedly, also.

Mr. TOWNSEND.—I offer the model just referred to in evidence, and ask that it be marked Defendant's Exhibit No. 10. (So marked.)

Q. 34. I show you another model, Mr. Maynard, and ask you if you understand that, and if you can tell by reference to any of the patents already introduced in evidence, what that purports to be a model of?

A. This is a model representing the patent to Abraham, for a manifold sales-book, having a plurality of recording sheets.

Q. 35. To Abraham, Exhibit 3?

A. Abraham, Exhibit 3.

Q. 36. State wherein that differs, if any, from the design in the patent Exhibit 3, to Abraham.

A. There is no difference in any practical extent; merely that the Exhibit 3 shows ruled record sheet

(Testimony of Frederick E. Maynard.)
in some views.

Q. 37. Otherwise, is the model a correct representation?

A. The model is a correct representation of the patent exhibited in exhibit No. 3.

Mr. TOWNSEND.—I offer in evidence this model and ask that it be marked Defendant's Exhibit No. 11. (So marked.)

Q. 38. I show you Defendant's Exhibit "A," which is a book alleged to infringe the patent sued on, a book built by the respondent, and ask if you understand its construction and mode of operation?

A. I do.

Q. 39. Have you read, and do you understand the claims and the construction embodied in those claims of the reissue patent to Levison sued upon?

A. I have.

Mr. TOWNSEND.—I ask counsel, for the sake of a clear understanding of the issue, if he maintains an infringement on any more than the claims referred to in his examination-in-chief, being Claims 2, 3, 4 and 5? In other words, do you claim any infringement in the present case on Claim 1?

Mr. WHITE.—No, we do not claim an infringement on Claim 1.

Q. 40. (By Mr. TOWNSEND.) Take Claim 2 of the patent sued on, the Complainant's Exhibit "B," and compare it with the structure of exhibit "A" which you have just inspected; I will ask you if the structure of exhibit "A" combines a combination of the elements of that claim? A. No.

(Testimony of Frederick E. Maynard.)

Q. 41. In what respect does it not do so?

A. The respondent's book comprises a removable carbon sheet, and the flexible flap or stub-card flexibly or hingedly secured to the cover of the book. The carbon in exhibit "A" being removably inserted into the book in such a manner that it may be at any time removed from one position and placed into another, without destroying the utility of the carbon, and by using the removable stop-card the removable carbons may be inserted at such points throughout the book, irrespective of the number of leaves above the carbon, and the stop-card inserted at any point in the body of the book, to prevent transfer of the impression from the sheet above.

Q. 42. Is the carbon in the exhibit "A" bound into the book? A. It is not.

Q. 43. Is the stop-card that you referred to bound into the book? A. It is not.

Q. 44. This claim calls in the last three lines: "Said stubs and one side of each carbon sheet and backing being all bound together, to form a book, substantially as described." Do you find that structure present in respondent's device?

A. I do not.

Q. 45. Now, reading Claim 3, I will ask you if you find the defendant's book to contain the combination of elements of that claim? A. No.

Q. 46. In what respect do you find that it has not the combination of elements of Claim 3?

A. For the reason that the carbon is not permanently bound at any point in the book.

(Testimony of Frederick E. Maynard.)

Q. 47. Now, reading Claim 4, I will ask you if the defendant's device as shown in exhibit "A" embodies the combination of elements of that claim?

Mr. WHITE.—The question is objected to as grossly leading, in the same manner that all the previous questions propounded to this witness along this line of inquiry have been grossly leading.

A. Complainant's Exhibit "A," or respondent's book, does not embody the elements of Claim 4.

Q. 48. (By Mr. TOWNSEND.) In what respect do you find such to be the case?

A. The respondent's book does not have the carbon bound permanently into the book with the stubs of the record sheets.

Q. 49. What does the concluding phrase convey to your mind, "substantially as described" in Claim 4?

Mr. WHITE.—We object to that question as usurping the province of the Court in construing and determining patent specifications, this witness being put on the stand as an expert to describe the construction and operation of these various devices, and not to construe the patent.

A. This claim, as well as preceding claims, can only be followed by a skilled mechanic in referring to the specifications throughout, and to the drawings as indicated in the claims.

Q. 50. (By Mr. TOWNSEND.) Referring to this specification, what do you find as to the manner of binding referred to, where he says, "Said stubs

(Testimony of Frederick E. Maynard.)

and one side of each carbon sheet being all bound together to form a book”?

Mr. WHITE.—The question is objected to as immaterial, the patentee, not being required under the law to specify all the methods of carrying out his invention, the law only requiring him to point out the best method of embodying the invention of the patent.

A. The specification specifically states that the book embodies the carbon or a plurality of carbons interspersed throughout the thickness of the book, and said carbons and the record sheets and backings also are placed at suitable intervals between the pages, to be all bound together.

Q. 51. (By Mr. TOWNSEND.) Referring to page 1 of the Levison patent sued on, lines 41 to 54, inclusive, I call your attention to the following matter: “The record sheets and the cardboard backings are attached to stubs 7 along lines of perforations 8, so that they can be readily detached from said stubs, and said stubs and one side of each carbon sheet are all bound together to form a book.” Looking at the respondent’s book, exhibit “A,” do you find any record sheets and cardboard backings, attached to stubs along lines of perforation?

Mr. WHITE.—That is objected to as leading.

A. No.

Q. 52. (By Mr. TOWNSEND.) State whether or not you find any cardboard backings in the respondent’s books attached to stubs along lines of perforation so that they can be readily detached

(Testimony of Frederick E. Maynard.)

from the stubs.

Mr. WHITE.—I object to that as leading.

A. I do not.

Mr. WHITE.—I move to strike out the answer on the ground stated in the objection.

Q. 53. (By Mr. TOWNSEND.) State whether or not you find said stubs and one side of each carbon sheet all bound together to form a book in respondent's construction.

Mr. WHITE.—We make the same objection.

A. I do not.

Mr. WHITE.—I move to strike out the answer on the ground stated in the objection, and I hereby notify counsel that I will renew all these motions at the final hearing.

Q. 54. (By Mr. TOWNSEND.) Reading Claim 5, Mr. Maynard, I ask you whether this book shown in exhibit "A" contains a combination of elements of that claim?

Mr. WHITE.—We make the same objection.

A. No, I don't find the elements.

Mr. WHITE.—We give notice of the same motion.

Q. 55. (By Mr. TOWNSEND.) And for what reason?

A. The book of the respondent, exhibit "A," does not comprise a carbon bound into the body of the book, at the stubs, but provides a removable carbon which may be taken from any place and replaced in another place between the leaves, at will. This capacity is not apparent in the patent of Lev-ison without destroying the feature in the patent,

(Testimony of Frederick E. Maynard.)

for the reason that if the Levison carbon is removed, it must be torn from its binding and replaced without having any means for securing it or holding it into the book.

Q. 56. Taking exhibit 1, Mr. Maynard, the patent of Barlow, and also having before you exhibit 9, the model of the Barlow book, I ask you to describe that construction showing the patent and model.

A. The carbon of the exhibit No. 9 and showing the patent exhibit No. 1, might be designated as being and is a removable carbon, carbonized on both sides. The carbon is substantially equal or is equal to two of the sections of the recording leaves, which are both shown in the model and in the patent as being in three sections.

Q. 57. Are those sections separable?

A. They are, along the lines of perforation.

Q. 58. And their relative proportions, what would you say as to that?

A. The relative proportions of the outer two members are substantially the same.

Q. 59. Could you say whether or not those leaves are divided in three parts, what you would call substantially equal, separable parts?

A. They are. These leaves further being bound into the book, and separable along the line of perforation from the contiguous stub of the book into which the cover is bound.

Q. 60. Taking Claim 2 of the Levison patent sued on, I ask you, do you find the device of the Barlow patent, exhibit 1, model exhibit 9, to contain "a

(Testimony of Frederick E. Maynard.)

double carbon sheet"? A. I do.

Q. 61. State whether or not it contains "a plurality of recording sheets." A. It does.

Q. 62. State whether or not it contains "a cardboard backing" or the equivalent thereof.

A. Yes.

Q. 63. What do you call the equivalent of a cardboard backing?

A. The cover in this case, of exhibit No. 9.

Q. 64. Which cover?

A. The outside cover, the top cover.

Q. 65. Which cover?

A. The outside, top cover.

Q. 66. In what manner does that top cover form a cardboard backing?

A. The cover as here shown does not form a cardboard backing in the sense used in the Levison patent; it merely forms a cover for the book generally.

Q. 67. What function does the opposite cover perform, if any?

A. The bottom cover would form a support for the leaves of the book when held in the hand open; the leaves of the record sheets would be supported when the user was inscribing in the book.

Q. 68. What is the purpose in the Levison patent of his cardboard backing referred to?

A. The purpose is substantially the same.

Q. 69. State whether or not the Barlow book and patent before you contains a record sheet, shows a record sheet outside of the stubs, being divided

(Testimony of Frederick E. Maynard.)

into, three substantially equal, separable parts, or not? A. It does.

Q. 70. State whether or not that book and exhibit of Barlow shows "a carbon extending the width of two of said parts." A. It does.

Q. 71. State whether or not the Barlow book and patent shows the "record sheets having stubs to which they are attached along lines of perforation."

A. Exhibit No. 9 and the Barlow patent both show these stubs to which the leaves are connected along the line of perforation; and I might state also that the backing is securely bound to these stubs, but the carbon is removable or loose.

Q. 72. State whether or not "the stubs and one side of the carbon sheet and backing are bound together to form a book" in the Barlow patent.

A. They are.

Q. 73. Is the carbon sheet in that book bound in?

A. It is not.

Q. 74. You have read the Barlow book and the patent in conjunction with the claim, and you have just compared the Barlow book and patent with the claim which you have just referred to, and you state that you find all the elements in the order and sequence that you give them, except that the carbon is loose in the Barlow book, and is bound in the Levison book. I ask you if that is correct?

A. Yes, and it would certainly not take the services of any skilled mechanic to bind that in, as the want or the utility of such a binding might be manifest to any person requiring such a book; and no in-

(Testimony of Frederick E. Maynard.)

genuity was required of a skilled mechanic to bind this carbon in.

Q. 75. Taking Claim 3 of Levison, and comparing it with the Barlow patent and book which we have just been talking about, and I will ask you whether or not you find the following elements in this Claim 3 of the Levison patent: "A manifold book." State whether or not the Barlow book is a manifold book.

A. It is a triplicate manifold book.

Q. 76. "Comprising in order a double carbon sheet." State whether or not you find a double carbon sheet in the Barlow. A. I do.

Q. 77. Do you find a plurality of recording sheets, the record sheets outside the stubs being divided into three substantially equal separable parts? A. I do.

Q. 78. State whether or not you find the carbon sheet extending the width of two of said parts.

A. I do. There is an apparent discrepancy in the drawing, but the specification precisely defines that the carbon sheet extends over two of such sections.

Q. 79. By that you mean the drawing in Figure 1, representing the carbon is not to scale?

A. It is not drawn to scale on the recording sheets in the drawing.

Q. 80. I call your attention to Figure 2 of the Barlow patent and ask if the representation there relatively of the carbon to the record sheet is correct or not? A. Yes, it is correct.

(Testimony of Frederick E. Maynard.)

Q. 81. State whether or not the Barlow patent and book that you have before you shows said recording sheets having stubs to which they are attached along lines of perforations.

A. They do, both the patent to Barlow, exhibit 1, and the model exhibit No. 9.

Q. 82. State whether or not the Barlow shows said stubs, and one side of the carbon sheet being all bound together to form a book.

A. The carbon cannot be said to be bound into this book, but is removable, which has been found to be a disadvantage by the users of the book for the reason that they readily become loose and crumpled; and the drivers of wagons sometimes lose the carbons when they are loose, because the wind will blow over the pages of the book and carry the carbons away.

Q. 83. Now, having compared Claim 3 with the book of Barlow in the patent, state just what difference you find between the Barlow book patent and the combination of elements of the claim I have just read?

A. The elements of the claim are all present, and the leaves are divided into three substantially equal parts.

Q. 84. You don't understand my question, just the point of difference I am asking; not the similarity.

A. The greatest point of difference is that the carbon is not bound permanently into the book.

Q. 85. Is there any other point of difference?

(Testimony of Frederick E. Maynard.)

A. The carbon sheet does not have a stub which is bound into the book along with the stubs of the leaves.

Q. 86. Is that the only point of difference?

A. The backing.

Q. 87. Claim 3 does not call for any backing. I simply asked if there is any point of difference or not, between the Barlow and the claim I have just read of Levison, other than the fact that the Barlow book has a loose carbon and the Levison combination has a fixed carbon—is there any difference other than that? In other words, is it not a fact, if I understand from what you have said, that that is the only difference?

Mr. WHITE.—The question is objected to as grossly leading, informing the witness what he is to say, which is extremely reprehensible in view of the fact that this witness is called as an expert.

Mr. TOWNSEND.—I will withdraw the question and ask that the previous question be read to the witness. (Questions 83, 84, 85, 86, 87, and the answers thereto, read.) Now, I ask that the latter part of my question be omitted, as I do not intend to ask leading questions.

A. I should say that this is the only difference in the books.

Q. 88. Reading Claim 4 and comparing it to the Barlow book and Barlow patent before you, “A manifold book comprising in order a double carbon sheet,” I will ask you whether or not you find the Barlow book to be a manifold book with a double

(Testimony of Frederick E. Maynard.)

sheet? A. I do.

Q. 89. State whether or not you find in the Barlow a plurality of recording sheets. A. I do.

Q. 90. State whether or not you find each of said sheets outside of the stubs being divided into a plurality, not less than, three, of substantially equal separable parts. A. I do.

Q. 91. State whether or not you find in the Barlow a carbon sheet extending the width of said parts, except the outermost. A. I do.

Q. 92. State whether you find in the Barlow said recording sheets having stubs to which they are attached along lines of perforations.

A. I do find such.

Q. 93. State whether or not you find in the Barlow said stubs and one side of the carbon sheet being all bound together to form a book.

A. The carbon in the Barlow patent is not bound in the book.

Q. 94. State what point of difference, or points of difference, then, you find in the Barlow, between the Barlow and claim 4, which I have just read.

A. The only difference in the requirements of the claim and the patent to Barlow, exhibit No. 1, and the book or model exhibit No. 9, is that the carbon is bound permanently into the book, as required in the patent to Levison.

MR. WHITE.—We object to that part of the statement, because such is not the fact. (Question and answer read.)

THE WITNESS.—I did not mean to state that the

(Testimony of Frederick E. Maynard.)

carbon was bound. I said the only difference I found in the two patents, that is the Barlow patent, exhibit No. 1, and the Levison patent book is, that the carbon is not bound into the book.

Q. 95. (By Mr. TOWNSEND.) Do you wish your previous answer corrected? A. I do.

Q. 96. Taking Claim 5, I will ask you to state whether or not the Barlow which we have been speaking of shows a manifold book comprising in order a double carbon sheet. A. I do.

Q. 97. State whether or not the Barlow shows a plurality of recording sheets, each record sheet outside the stub being divided into a plurality not less than three of separable parts, joined along lines of perforations.

A. I do find such recording sheets present in the Barlow.

Q. 98. I will read that again to you. State whether or not you find a plurality of recording sheets, each recording sheet outside the stub being divided into a plurality not less than three of separable parts, joined along lines of perforations.

Mr. WHITE.—The question is objected to as leading, and not within the line of inquiry. It is exceedingly objectionable. The question can be asked if the patent shows—the witness can be asked to compare each one of these claims with the Barlow patent and to point out the similarity and differences without counsel taking up the elements one by one, and suggesting to the witness to state whether or not the same is found in the Barlow book.

(Testimony of Frederick E. Maynard.)

A. I find in the Barlow patent that these recording sheets are divided into not less than three of separable parts, joined along lines of perforations.

Q. 99. (By Mr. TOWNSEND.) State whether or not the Barlow shows each part being not greater than the part next it, on the side toward the stub.

A. It does.

Q. 100. State whether or not the Barlow shows a carbon sheet extending the width of the whole of said parts, except the outermost.

A. The carbon sheet is so shown in the Barlow patent.

Q. 101. State whether or not said recording sheets *having* stubs to which they are attached along lines of perforations.

A. Yes. Stubs are provided in the Barlow patent to which the recording sheets are attached by lines of perforations.

Q. 102. State whether or not the Barlow shows stubs and one side of the carbon sheet being all bound together to form a book.

A. These stubs and one side of the carbon sheet in the Barlow patent are not bound together in the sense of the Levison patent.

Q. 103. What other difference, if any, do you find between the Barlow patent and the claim I have just read of the Levison?

A. I do not find any other difference than that the carbon is bound permanently into the book, as required by the Levison.

(Testimony of Frederick E. Maynard.)

Q. 104. In what case is the carbon bound into the book?

A. In the present case, the carbon is bound into the book.

Q. 105. What is the condition in the Barlow?

A. The Barlow carbon, designated as "F" in the patent, is not found bound into the book.

Q. 106. Taking up Doughty, exhibit 2, Mr. Maynard, and also taking up exhibit 10, reading Claim 2 of the patent sued on, I will ask you whether or not the Doughty patent is a manifold book?

A. Well, the Doughty patent is a triplicate manifolding book.

Q. 107. State whether or not the Doughty comprises in order a double carbon sheet.

A. Yes.

Q. 108. State whether or not it contains a plurality of recording sheets.

A. Yes; it does.

Q. 109. State whether or not the Doughty contains a cardboard backing, or equivalent.

A. It does.

Q. 110. In what respect?

A. In that the recording sheets are secured permanently to the backing along suitable stubs, or stubs as indicated, and the carbon in this patent may be said to—

Q. 111. Please read the question. (Question read.) You say that Doughty contains a cardboard backing or equivalent? Can you designate by reference to the Doughty patent drawings what

(Testimony of Frederick E. Maynard.)

element corresponds to a cardboard backing?

A. The member designated as "A" in figure 2 is represented as being a backing to which the recording sheets are secured.

Q. 112. State whether or not Doughty shows the recording sheets outside the stubs being divided into three substantially equal separable parts.

A. It does.

Q. 113. State whether or not the Doughty shows a carbon sheet extending the width of two of said parts. A. Yes.

Q. 114. State whether or not said recording sheets in the Doughty have stubs to which they are attached along lines of perforations.

A. They have.

Q. 115. Designate by numeral or other reference character those perforations, if they are shown by the Doughty patent.

A. The perforations are shown at c in Figure 2.

Q. 116. State whether or not the stubs in the Doughty and one side of the carbon sheet and backing are bound together to form a book.

A. Yes, the carbon in this case is bound with the leaves and backing to form a book.

Q. 117. In what way is the carbon bound in, in this case?

A. By means of the frame represented by d which carries the carbon and is hinged or flexibly connected at e to the back of the book.

Q. 118. In this case state whether or not you would say that the carbon c is bound into the stubs

(Testimony of Frederick E. Maynard.)
of the leaves.

A. No, the carbon is not bound into the stubs of the leaves in this case, but is bound to the book by means of the frame d.

Q. 119. In order that the testimony may appear clear I will ask you to designate by reference characters—I will go, however, over the claim—the elements referred to. In reading the claim you stated that these various elements were present. Will you indicate by reference characters the double carbon sheet?

A. The double carbon is indicated by C.

Q. 120. Indicate the recording sheets.

A. The recording sheet is divided into a plurality of sections, the outer end of which is designated as b."

Q. 121. State the difference, then, between the patent of Doughty and that to Barlow with reference to the carbon.

A. The only difference here is that the carbon C of Doughty is secured, you might say, to the book; while in the patent of Barlow it is not secured in any way to the book.

Q. 122. I will ask you to read Claim 3 of the Levison patent in suit, and compare it with the device of the Doughty patent and model, and state whether or not you find the same elements present in the Doughty as are enumerated in Claim 3.

A. I find all of the elements present.

Q. 123. Will you state whether or not you find them in substantially the same combination?

(Testimony of Frederick E. Maynard.)

A. They are.

Q. 124. State what difference, if any, you find in the combination of elements of Claim 3 of the patent sued on and the Doughty device.

A. The only difference that I can see is that the carbon is movable respective to the several leaves B of the Doughty patent. What I mean by movable is, that it may be lifted to swing upwardly and away from the leaves, but is still connected to the book so that it is always secured to it, but not permanently secured in the sense that it is in the Levison patent.

Q. 125. In the Doughty would the carbon C fall on the underneath leaves always in the same position when the frame is dropped, or would it fall into a different position each time and have to be adjusted?

A. It would fall into the same position on the leaves.

Q. 126. In the Levison, state whether or not that would be the case.

A. The Levison patent does not provide means by which the carbons could be used in any other point in the book except upon the first leaf under the carbon.

Q. 127. Yes, but in lifting the Levison carbon and dropping it, what difference is there in the action of its lying out on that leaf from the lifting of the carbon in the Doughty and dropping it?

A. Well, they will both assume positions practically the same and covering two sections of the book.

(Testimony of Frederick E. Maynard.)

Q. 128. Will they fall naturally without any hand adjustment over those two sections mentioned?

A. They will fall over the two sections nearer the stub. The outer section of the leaf then being folded once inwardly over the outer end of the carbon, and then the leaves are again folded inwardly so as to form a fold in the carbon itself.

Q. 129. Taking Claim 4 of the Levison patent sued on, I ask you to read that claim carefully and compare it with the Doughty patent and device, and I ask you whether or not the elements of that claim are present in the Doughty device.

A. The several elements are present.

Q. 130. Do you find all the elements of that claim present in the Doughty device?

A. We find a double carbon and a plurality of recording sheets, each of these sheets being divided outside of the stubs into a plurality not less than three of substantially equal parts.

Q. 131. Are those parts separable?

A. They are separable along lines of perforations and the leaf as a whole is separable from the stub into which the leaves are bound to the cover.

Q. 132. State whether or not you find in the Doughty the carbon sheet extending the width of said part except the outermost. A. I do.

Q. 133. State whether or not you find stubs and one side of the carbon sheet all bound together to form a book.

A. That is the only point of difference in the two patents, that the carbon is not bound by means of

(Testimony of Frederick E. Maynard.)

a stub with the remaining stubs of the leaves.

Q. 134. You are referring to Doughty?

A. Referring to the Doughty patent.

Q. 135. Referring now to Claim 5, I will ask you to read that claim and compare it to the Doughty patent. I will ask you if you find all of the elements of that claim present in the Doughty patent.

A. I do.

Q. 136. State whether or not you find those elements in substantially the same combination in the Doughty. A. They are.

Q. 137. Are there any differences between the combination in that claim? If so, please state them.

A. There is no difference in the combination of the elements, both employing carbon sheets and recording sheets, and in both cases the carbon sheet extends over two sections of the recording sheets, the carbon in both cases being double or carbonized on both sides.

Q. 138. I asked the witness if there were any differences between the Doughty and the combination of the elements in Claim 5, and if so, to please point out those differences.

A. I did not catch the word "differences." The difference present in the claim as a whole is that the carbons are not bound to the stubs of the leaves.

Q. 139. In each case?

A. In the Doughty case.

Q. 140. Comparing the device of the Doughty patent and the Levison device here as shown in his drawings, and described in his specifications, I will

(Testimony of Frederick E. Maynard.)

ask you if there is any new mode of operation in the Levison over the Doughty.

A. There is none.

Q. 141. I will ask you if the Levison book performs any new or different function from that performed by Doughty.

A. It does not, as it makes triplicate copies.

Q. 142. Is there any different way in folding the sheet over the carbon in the Levison from the manner shown in folding it in the Doughty?

A. The manner of folding the sheet is the same in each patent, that of the Levison and that of the Doughty.

Q. 143. State whether or not the book of Levison as shown in the patent drawings and specification of the patent sued on shows any new result from the Doughty.

A. There is no new result accomplished in the Levison patent that is not accomplished by the Doughty patent.

Q. 144. Referring to the Barlow patent device, I will ask you if the Levison patent and book performs any new or different function than that performed by the Barlow book. A. It does not.

Q. 145. What difference in the manner of folding the leaves of the Barlow and the leaves of the Levison are there, if any?

A. There is none—the leaves are folded in the same way.

Q. 146. What new result does the Levison book show, if it shows any, or what new result does it ef-

(Testimony of Frederick E. Maynard.)

fect over the device of the Barlow?

A. No new effect is accomplished.

Q. 147. State whether or not Levison has any new or different mode of operation from that of the Barlow.

A. No, there is no difference in the operation of the two patents.

Q. 148. Referring to the Levison book shown in Complainant's Exhibit "A," I call your attention to his folding stop-card which we will mark, with the Court's permission, with the reference No. 2, and I will ask you if you find anything in the prior art as shown by the patents here introduced corresponding to that stop-card.

A. The same stop-card is used in the patent to H. P. Brown, exhibit No. 4.

Q. 149. What reference character in the patent corresponds to the stop-card No. 2 in exhibit "A"?

A. There is a stiff flap or stop-card which is flexibly connected to the cover or back of the book of the Brown patent, this stop-card lifting in the same manner as that shown in Claimant's Exhibit "A." Reference character D corresponds to the stop-card designated as "2" in the Complainant's Exhibit "A."

Q. 150. Are there any instances in the prior art as shown by the patents here introduced to-day in which there are leaves and carbons bound together into a stub in book form?

A. Yes: We have the patent to Abraham which shows the carbon D permanently bound to the stubs

(Testimony of Frederick E. Maynard.)

of the book. In exhibit 7 which is not at hand, according to the best of my recollection the carbon is also bound in.

Q. 151. Do you refer to the patent to Bengough, exhibit 7?

A. To the best of my recollection I do.

Q. 152. Taking exhibit 5, Mr. Maynard, of the Levison original patent No. 694,103, I will ask if you have read and understand that patent.

A. I do.

Q. 153. What is that patent?

A. The original patent granted to Levison, No. 694,103, is for a manifold book, and corresponds as I understand it, precisely with the subject matter and the drawings in the reissue patent.

Q. 154. No. 12,005?

A. Yes. There is no difference that I can find exists in the drawings in the two cases.

Q. 155. As I understand it, the reissue patent in suit is the reissue of the patent I have just asked you regarding. Is that true?

A. Yes, that is true.

Q. 156. Have you read the specifications of the original patent and the reissue of it here sued on?

A. I have read that closely.

Q. 157. Have you compared the specifications together? A. I have.

Q. 158. What is the invention involved in the original patent 694,103?

Mr. WHITE.—The question is objected to as usurping the powers of the Court in construing the

(Testimony of Frederick E. Maynard.)

patent and telling what this invention is. It is within the province of an expert to go on and compare the structures, pointing out their similarities and dissimilarities.

A. The invention is in the art of manifolding books, and as far as set forth in the specification, it consists in this: It states that the object of the invention is to provide a book—reading from the original patent No. 694,103, “The object of my invention is to provide a book of this character which shall be convenient in use, economical in the number of carbons required, which shall give secure protection against alterations and forgeries, and the sheets of which can be readily and conveniently placed on record after the impression has been taken.”

Q. 159. (By Mr. TOWNSEND.) I will ask you if you find any statement in that paragraph you have just read which you do not find anticipated with reference to the Doughty patent?

A. I do not.

Q. 160. What would you say in regard to the same question as compared with the Barlow patent?

A. I should say that the objects of the invention were thoroughly met in both patents. That is to say, the Doughty patent and the Barlow patent.

Mr. WHITE.—We move to strike out the answer of the witness on the ground that it is immaterial. If the objects of two or three inventions are the same, unless the inventions accomplish the objects desired.

Q. 161. (By Mr. TOWNSEND.) Can you state

(Testimony of Frederick E. Maynard.)

from the specification of this original patent what the improvement and invention was that Levison attempted to claim or to protect?

A. The patent, as far as I understand it, attempts to cover manifold books involving the use of double carbons, which is common in the art, and also involving the use of record sheets, which is notoriously common, particularly triple sheets, and also a portion of the claim refers to the binding of the carbons into the body of the book at the stubs, which is well known in the art as exhibited by the Abraham patent.

Q. 162. State whether or not the reading of those two patents, the original and the reissue, whether in your opinion, and from what you find in the reading matter, that the reissue is for the same invention or not, as described in the original.

Mr. WHITE.—The question is objected to as calling for a conclusion of the witness.

A. There is a difference in the body of the specification, and in the insertions, which insertions do not seem to pertain to the original patent; that is to say, that the original patent was apparently to my mind completely drawn, the drawings showing with such clearness that any ordinary mechanic could construct the book from the description furnished by the specification; that is, could construct a book from the patent No. 694,103; whereas in the reissue patent the same drawings apparently are used, the main body of the specification is the same with the exception of a few insertions which have been made,

(Testimony of Frederick E. Maynard.)

to wit: On line 41 of the reissue application I find the words, "outside the stubs" having been inserted, are not found in the original patent; and also the insertion of a whole paragraph is found in the reissue patent which introduces matter not previously mentioned in the original patent. That is the paragraph beginning with line 84 of the reissue patent and continuing down to line 98 of said patent.

Q. 163. State whether or not these insertions you speak of are new matter.

Mr. WHITE.—We object to that as calling for a conclusion of the witness.

A. They are new matter, because they do not assist or help in explaining the construction or the operation of the device. But merely define a specific form or shape or degree or size of the leaves of the book in the reissue patent.

Q. 164. (By Mr. TOWNSEND.) Please state again what is the first of these insertions that you refer to, and its position or line in the specification of the reissue patent.

A. The insertion referred to is found in the reissue patent on page 1 of line 41, and consists of the words "outside the stubs."

Q. 165. Where is the next insertion?

A. The other insertion or entry is the paragraph which has been inserted following line 83 of the reissue patent, down to and including line 98.

(Testimony of Frederick E. Maynard.)

Q. 166. Will you read that?

(It is stipulated that the defendant may have to and including March 15, 1909, in which to close its case.)

(Further hearing adjourned to Saturday, March 6, 1909, at 10 A. M.)

Saturday, March 6, 1909, 10 A. M.

Counsel appearing:

W. K. WHITE, Esq., of MILLER & WHITE,
Solicitors for Complainant.

C. E. TOWNSEND, Esq., Solicitor for De-
fendant.

Examination-in-chief of FREDERICK E. MAY-
NARD, resumed.

(By Mr. TOWNSEND.)

Q. 167. At the close of your examination on last Saturday, Mr. Maynard, you were speaking of the insertions made in the reissue applications, and which insertions you state did not occur in the original patent, exhibit 5. Will you state again specifically, what changes have been made in the specifications of the reissue patent over the original Levison patent, exhibit 5?

Mr. WHITE.—The question is objected to as immaterial.

A. I find that in line 41 in the reissue patent No. 12,005, after the word "sheet" there has been inserted in the reissue patent the words "outside the stub 7." These words are not to be found in the original patent No. 694,103 at this point.

Q. 168. (By Mr. TOWNSEND.) Are they

(Testimony of Frederick E. Maynard.)

found anywhere in the original patent?

A. No, they are not. Further, in line 41 of the reissue patent No. 12,005, after the word "three" there has been inserted the phrase or words "substantially equal" and we find another insertion in line 83 in the reissue patent No. 12,005, a paragraph extending down to and including line 98 of said reissue patent. The subject matter of this paragraph is not to be found anywhere in the reissue patent. Do you wish the paragraph in the record?

Q. 169. Yes, sir.

A. The paragraph is as follows, reading from the reissue patent:

"It has been already stated that the three separable parts of each recording-sheet are substantially equal. They are not exactly equal, since it is preferable to provide the innermost part with an unprinted additional space or margin next the stub through which are punched the holes 9 to facilitate the filing of said part. Moreover, it is better to leave a small space between the edge of the sheet when folded and the line of perforations 8, as this renders it easier to fold the parts. With this exception the separable parts of each recording-sheet are of the same size and in general will contain identical printed matter thereon."

Incidentally I might state that the holes 9 referred to in this paragraph are not to be found on the reissue patent drawings. The reference characters 9 on these drawings simply leading to the line of perforation which is designated by the character 8.

(Testimony of Frederick E. Maynard.)

Q. 170. Do you find the words “three substantially equal” appearing anywhere in the original patent?

Mr. WHITE.—That is objected to as immaterial.

A. I do not.

Q. 171. (By Mr. TOWNSEND.) State whether or not you find such a statement justified by the drawings of the original patent.

Mr. WHITE.—We make the same objection.

A. No; the drawings of the original patent show by measurement that the divisions into which the recording-sheets are divided are not substantially equal, in that the innermost division of these recording leaves is considerably larger than the outer sections.

Q. 172. (By Mr. TOWNSEND.) State whether or not you find any statement in the original patent, speaking of “an unprinted additional space or margin next to the stub” or “moreover, it is better to leave a small space between the edge of the sheet when folded and the line of perforations 8, as this renders it easier to fold the parts.” Those excerpts I have just read being between lines 81 and 95, page 1 of the reissue patent.

A. These excerpts are not to be found; and moreover, I might state that it is not seen that the leaving of an additional amount or enlarging the inner section of the leaf would be of any particular advantage or would assist in the folding of the part, inasmuch as the outer ends of these leaves are foldable along perforations or lines of perforations, and the mere

(Testimony of Frederick E. Maynard.)

length of the inner section does not facilitate this folding in any way.

Q. 173. Do the inserted parts which you have just spoken of last, and which I quoted in my previous question appear essential in any way to the full and complete understanding of the original patent?

A. No, it does not.

Q. 174. Do any of the other insertions such as you have quoted as appearing in lines 41 and following of this paragraph, and relating to the specific division of the sheet into three equal parts, appear essential or necessary to a full and complete understanding of the original patent?

A. No, they do not.

Q. 175. Do they add anything to the understanding of that patent?

A. Nothing whatsoever; the original patent having fully described the construction of the book, and there is no apparent necessity for any of these insertions, and the claim of the original patent fully covers all of the elements and combination of parts set forth in this specification.

Q. 176. Do you find any inadvertence, accident or mistake in these specifications and drawings appearing in the original patent?

Mr. WHITE.—We object to that as immaterial.

A. None whatsoever.

Q. 177. You say you do not find any accident in either of the specifications?

A. I don't find any accident that would render necessary an application for a reissue patent.

(Testimony of Frederick E. Maynard.)

Q. 178. (By Mr. TOWNSEND.) Do you find any inadvertence there that would lead to lack of a clear understanding of the function of the original patent?

Mr. WHITE.—That is objected to as immaterial, the law not contemplating the presence of any accident, inadvertence or mistake appearing on the face of the specifications to justify the reissue.

A. I do not.

Q. 179. (By Mr. TOWNSEND.) What do you find from reading said original letters patent to be the invention of the same, disclosed by the same?

Mr. WHITE.—We object to that as calling for a conclusion of the witness and an attempt on the part of counsel to have the witness to usurp the prerogatives of the court in construing this patent.

A. The invention is clearly set forth in the specification and shown in the drawings and claim, and it consists of a book of the manifold variety built up in a series of sections. This is clearly outlined in the paragraph on page 1 of the specification, which states: "Referring to the drawings, it will be seen that my improved manifold book is formed in sections, each section comprising in order," and so on. The claim of the original patent well covers this feature of the invention, and is sufficiently clear to enable anyone to construct a book intelligently from its composition.

Q. 180. (By Mr. TOWNSEND.) Do you find any evidences in this specification as to what the invention consisted of?

(Testimony of Frederick E. Maynard.)

A. This specification proceeds to describe a book comprising in order a carbon sheet, which carbon sheet, of course, is notoriously common in the art, and further describes a number of recording-sheets 2, equally notorious in the art, and states the specific character of the recording-sheets as being divided into three parts by lines of perforations. This is well known in the past state of the art. It also calls for a backing when one of the sections of the book is considered alone, as is clearly set forth in the paragraph on page 1, column 2, "The use of the cardboard backing." Cardboard backings are common in books of this character and are well known in the art. The last paragraph on this page sets up specifically a plurality of backings. It says: "The cardboard backings are an important feature of my invention, since they permit a large number of sheets to be bound into a book with a small number of carbons without any danger of transmitting the impression from one sheet to another sheet." This paragraph refers, of course, to a book built of a number of sections; that is, referring to the leaves as being divided into several sets or piles of leaves, and having between these piles, carbons and backings. That seems to be the essence of the invention, and is clearly claimed in the original patent.

Q. 181. Speaking of the cardboard backings being in the art, in what way, in what sense do you mean that, Mr. Maynard, speaking of a single section?

A. Speaking of a single section they form backs

(Testimony of Frederick E. Maynard.)

for the book to which the record-sheets are secured.

Q. 182. I understand you mean by "back" the cover of the book? A. Yes.

Q. 183. In your opinion, will such a book cover perform the same function as the backing of a section of the Levison book?

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial.

A. Yes, sir, it does.

Q. 184. (By Mr. TOWNSEND.) Please state again what you find to be the invention, just in a few words, embodied in the original patent.

Mr. WHITE.—We object to that as being a mere repetition of former questions along the same line that have already been answered, and on the further ground that it is an attempt on the part of counsel to have this witness usurp the prerogative of the court in construing this patent.

A. The invention comprises, as set forth in the specification and drawings and claim a book formed of a number of superposed sections.

Q. 185. (By Mr. TOWNSEND.) Referring to the claims of the reissue patent, Levison 12,005, I will ask whether or not the invention embodied in Claims 2, 3, 4 and 5 are found or have a basis in the original patent? I would first add, though, will you state what the invention is that is embodied in Claims 2, 3, 4 and 5 of the reissue patent sued on?

A. The first of these claims, Claim No. 2, is for a manifold book comprising a double carbon sheet, a plurality of recording-sheets and a cardboard back-

(Testimony of Frederick E. Maynard.)

ing; and it further states that these recording-sheets outside of the stubs being divided into substantially equal parts.

Q. 186. Into how many?

A. Substantially three; three substantially equal parts; and that is apparently the basis of this claim in the reissue patent, and this basis is founded entirely upon the insertions in the reissue patent, these insertions having been referred to and described before, and are not found in the original application. The third claim is for a manifold book comprising an ordinary double carbon sheet and a plurality of recording-sheets, the recording-sheets outside of the stubs being divided into three substantially equal parts, and the carbon sheet extending the width of two of said parts. This claim differs only from the preceding claim in that it omits the cardboard backing referred to.

Q. 187. In your answer, state whether or not the matter of Claim 3 is found in the original patent, or what basis you find, if any, in the original patent, for the matter of Claim 3.

A. There is no basis in the original patent for the words in Claim 3 and following the word "three" line 3 of the 2d page of the specification, line 44, these words, "substantially equal," have no basis or foundation whatsoever in the original patent. Claim 4 for "a manifold book comprising in order a double carbon sheet, and a plurality of recording-sheets, each of said sheets outside the stubs"—I will state here that the words "outside the stubs" do not

(Testimony of Frederick E. Maynard.)

appear in the original patent No. 694,103; and also claims further on: "Each of said sheets outside the stubs being divided into a plurality, not less than three, of substantially equal separable parts, and the carbon sheet extending the width of said parts except the outermost, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described."

Q. 188. In what you have read there what insertions, if any, appear therein that do not appear anywhere in the original patent?

A. The words "substantially equal" are used in this claim and have no basis in the original patent.

Q. 189. Taking the original patent as it stood, could a claim have been made or based on the original specification in which the words "three substantially equal" appear?

A. No, it could not.

Q. 190. For what reason?

A. The words "substantially equal" are not used at any point whatsoever in the original patent, but have been inserted into the reissue patent, and this insertion according to the exhibits we have had, was made, as well as the other insertions, after the reissue patent was filed.

Q. 191. Did those insertions form part of the application as actually filed in the reissue case and sworn to?

A. They did not. You asked me to describe the

(Testimony of Frederick E. Maynard.)

four claims. We have not yet taken up Claim 5.

Q. 192. Proceed.

A. Claim 5 calls for "A manifold book comprising in order a double carbon sheet, and a plurality of recording-sheets, each recording-sheet outside the stub being divided into a plurality not less than three of separable parts joined along lines of perforations, each part being not greater than the part next to it on the side toward the stub, and the carbon sheet extending the width of the whole of said parts except the outermost, said recording-sheet having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described." In comparing this claim with the preceding claim, that is Claim 4, I am unable to find any substantial difference in these claims, as the Claim 4 calls in portion for "A plurality of recording-sheets, each of said sheets outside the stubs being divided into a plurality not less than three, of substantially equal separable parts." This claim would cover a book made up of sheets divided into not less than three substantially equal parts, which seems to be specific enough to make itself clear; whereas Claim 5 is merely a repetition of the elements claimed in No. 4, but with the description of the division of the parts being more or less reversed, but not specifying anything substantially different, in that this claim states that recording leaves "outside the stub being divided into a plurality not less than three of separable parts joined along lines of perforations." Com-

(Testimony of Frederick E. Maynard.)

paring these two claims, as we have, it is seen that both are for recording leaves divided into not less than three parts. Claim 4 states that these parts are substantially equal, whereas Claim 5 states "each part being not greater than the part next to it on the side toward the stub," which is certainly equivalent to saying in both the claims that the leaves are of substantially equal separable parts.

Q. 193. In your opinion does such a phraseology as is contained in Claim 5 referring to the recording-sheets, in its divisions, differentiate that recording-sheet from the description of the same recording-sheet in Claim 4?

A. It does not. Further I might say here, that recording-sheets divided into three parts are well known in the art, and one patent in particular calls for a recording-sheet of less than three parts; so that Claim 5 would be readable on a recording-sheet of less than three parts.

Q. 194. The claim says "not less than three parts." A. Yes, so it does.

Q. 195. Are there any of the exhibits which show the carbon sheet divided into more than three parts separable along lines of perforations?

A. An examination of the art as presented shows that the patent to Abraham comprises a manifold book having recording-sheets divided into more than three parts.

Q. 196. The Abraham patent you refer to is exhibit 3? A. Exhibit 3.

Q. 197. Referring to respondent's book repre-

(Testimony of Frederick E. Maynard.)

sented by Complainant's Exhibit "A" and observing the division of the sections outside the stubs, and referring to the insertion previously mentioned in the original patent, of a paragraph between lines 84 and 98, inclusive, and also to the drawings of the original letters patent, and the reissue patent, what distinction, if any, do you note as to the proportional size of these sections outside of the stubs?

A. There is no difference in the divisional parts of the record-leaves, either in the specification in the reissue patent, or in Exhibit "A" of complainant.

Q. 198. Do you find any extreme margin on the first section of the respondent's book such as is described in the paragraph alluded to?

A. There is a small margin—

Q. 199. I should say, outside the stubs? Please measure the leaves, and see what proportion you find to exist between the three sections of the respondent's book.

A. They are substantially equal outside the stubs.

Q. 200. Substantially equal?

A. They are equal.

Q. 201. Do you find it as necessary there to have any extra margin to fold the Kitchen book over or leaf over?

A. There is no essential requirement there, to any practical purpose. It is easy to fold the leaf over in the sections of equal dimensions.

Q. 202. You have just folded the leaf of the respondent's book in making your explanation, have you not? A. I have.

(Testimony of Frederick E. Maynard.)

Q. 203. Would you state that the insertion of the paragraph alluded to in the reissue patent wherein it says that "This margin is left to enable the sheet to be more easily folded" was essential to a clear understanding, or not, of the original patent, in the book described? A. Certainly it is not essential.

Q. 204. You have previously stated, Mr. Maynard, in answer to Question 44 and others following, that you did not find the structure present in respondent's device of the stubs and one side of each carbon sheet being all bound together to form a book. I ask you if you find the equivalent of such a structure in the respondent's book?

A. No, the equivalent is not present.

Q. 205. Claim 3 of the reissue patent calls for the stubs and one side of the carbon sheet being bound together to form a book. You have previously stated here that you do not find that structure present in the respondent's book. I ask you if you find the equivalent of that structure present?

A. I do not find such equivalent present.

Q. 206. I will ask you whether or not you can make the same reply in regard to the same statement in Claims 4 and 5?

A. I would state the same in reference to those claims.

Cross-examination.

(By Mr. WHITE.)

XQ. 1. Where do you practice your profession, Mr. Maynard?

A. In the city of San Francisco.

(Testimony of Frederick E. Maynard.)

XQ. 2. With what firm?

A. Dewey, Strong & Co.

XQ. 3. Counsel for defendant is a member of that firm, is he not?

A. Not that I am aware of.

XQ. 4. He has his offices with that firm?

A. I don't know whether he has any offices there or not, whether he has any offices. He works in the office of Dewey, Strong & Co. His place of business is there. Whether he has any offices there or not, I don't know. I think Mr. Strong is the holder of the offices there, I don't know.

XQ. 5. You say that Mr. Townsend has an adjoining office with Mr. Strong, but you don't know whether Mr. Townsend holds a lease of that adjoining office—is that the idea?

A. Well, I believe that they have two rooms on the same floor. They are all opened into one room. There is no partition except merely temporary partitions, which divide each of the rooms into small compartments, so that there is more privacy in there. The draughtsmen have a room, the bookkeeper has a small room, Mr. Strong has his room and Mr. Townsend has his.

XQ. 6. Mr. Townsend, then, has no connection with the firm of Dewey, Strong & Co.?

A. That I could not say.

XQ. 7. He does not carry on any of their business in connection with Mr. Strong in that firm?

A. He does not carry on any of their business?

XQ. 8. Yes.

(Testimony of Frederick E. Maynard.)

A. I am aware of the fact that he is a specification writer.

XQ. 9. For Dewey, Strong & Co.?

A. For Dewey, Strong & Co.

XQ. 10. And you also are a specification writer for Dewey, Strong & Co.?

A. I divide my time between writing specifications and preparing drawings.

XQ. 11. For what period of time have you acted as an expert witness in patent cases?

A. Well, I have not acted exactly as an expert witness. I have given opinions at various times in patent cases.

XQ. 12. Have you ever appeared before, in any case, as an expert witness? A. I have not.

XQ. 13. Are the carbon sheets in Complainant's Exhibit "A" held in place in substantially the same way that the leaves are held together, by clamps?

A. They are removably held in the book.

XQ. 14. I didn't ask you whether they were removably held. I asked you whether they were held in place in substantially the same way that leaves are held together, where clamps are used. In other words, is not the back of this book, Complainant's Exhibit "A," provided with a clamp holding the carbon leaves?

Mr. TOWNSEND.—We object to that since the patent does not call for backs of leaves, the carbons being clamped together, but not bound together, and the counsel has not stated what the nature of the clamp is that he refers to.

(Testimony of Frederick E. Maynard.)

A. The carbon is not held here by a clamp.

XQ. 15. (By Mr. WHITE.) By what means does a clamp such as is shown in the Doughty patent hold the leaves together—by pressure?

A. In the Doughty patent there is a specific clamp for that purpose.

XQ. 16. Please answer my question, Mr. Maynard. I didn't ask you about the specific construction of that clamp. I asked you if that clamp held the leaves together by pressure or friction or whatever you might call it?

A. The clamp in the Doughty patent is made, if I remember the construction—well, it states that they are held by clamps. I should suppose that they are held very positively by clamping action.

XQ. 17. What is the clamping action?

A. The metal there has been, as far as the drawing shows, doubled up or folded upon itself so as to clamp the leaves between the carbon.

XQ. 18. When leaves are held together in that manner by such a clamp what prevents them from becoming separated?

A. By the clamp in the Doughty patent the leaves are—do you mean the carbon leaves?

XQ. 19. Any of the leaves that are held together there by a clamp. It is immaterial what kind of leaves they are.

A. The carbon is held by a clamp and the back disconnected from the book without severing the carbon.

XQ. 20. What enables the clamp to hold the

(Testimony of Frederick E. Maynard.)

leaves together in the character of a clamp—what is the force that holds the leaves together?

A. Well, I should state that in the Doughty clamp the metal is doubled over and the mechanical strength of the metal at the fold is the feature which holds the carbon.

XQ. 21. What is the purpose of constructing Complainant's Exhibit "A" in the manner shown whereby the carbon is held in place?

A. The purpose of the construction in this case is to enable the carbon to be inserted at different points between the leaves so that the carbon can be removed without injury or destruction.

XQ. 22. The carbon in Complainant's Exhibit "A" is provided with a piece of pasteboard and this piece of pasteboard is inserted in the back of the book. Now, what is the purpose of inserting it in that way?

A. The purpose of inserting it in the back of the book is merely to retain it in the book.

XQ. 23. To hold it in place in the book?

A. Well, if "retain" is equivalent to "hold," it holds it there.

XQ. 24. Does the construction of this book, Complainant's Exhibit "A," secure the carbon in place?

A. It does not secure it in the sense of the Lev-
ison.

XQ. 25. I did not ask you that question; I asked you if it secured it in place, so that it remains in place in the ordinary use of the book?

A. It secures it with sufficient holding power to

(Testimony of Frederick E. Maynard.)
prevent it from dropping out accidentally.

XQ. 26. That is the sole purpose of this construction, is it not, to prevent it from dropping out, being loose and having the wind blow it away, as you stated in your direct examination?

A. The purpose is to hold it in there and to prevent it from being dislodged accidentally, and also to hold it in such a manner that it can be put at any point in the book.

XQ. 27. In ordinary use, do you think this construction embodied in Complainant's Exhibit "A" is sufficient to hold the carbon in place?

A. In ordinary use?

XQ. 28. Yes. A. I do.

XQ. 29. You do? What is the purpose of stitching the carbon in the complainant's book as covered by the patent in suit?

A. The purpose of its being stitched there is to bind it in the book.

XQ. 30. And it is bound there for the purpose of keeping it in place in the ordinary use of the book?

A. It is bound there for the purpose of holding it in position constantly.

XQ. 31. So that we have illustrated in the Complainant's Exhibit "A" and in the complainant's patent a means of holding the carbon in place during the ordinary use of the respective books, is not that the fact?

A. We have two absolutely independent and distinctly different means.

(Testimony of Frederick E. Maynard.)

XQ. 32. We have two means, have we not, in complainant's patent and in Complainant's Exhibit "A" for holding the carbon in place during the ordinary use of the book—is that not a fact?

A. The carbons are held in the book.

XQ. 33. Have you read the Doughty patent?

A. I have.

XQ. 34. You are perfectly familiar with it?

A. I should think so.

XQ. 35. Do you find any technical expressions used there incorrectly?

A. I have not been able to find any technical discrepancies.

XQ. 36. I asked you if you found any technical expressions or expressions pertaining to this particular art which are incorrectly used and which would not convey the correct meaning to those skilled in the art in endeavoring to understand the disclosure covered by the Doughty patent.

Mr. TOWNSEND.—You are entitled to read the patent through.

XQ. 37. (By Mr. WHITE.) Have you not read the patent sufficiently before you came into this case?

A. I have read the patent through sufficiently to become enlightened as to its construction, but not to look into the technical or scientific details.

XQ. 38. Didn't you read it sufficiently to know whether or not it conveys the correct meaning to those who are endeavoring to acquire a knowledge of the invention covered by it? A. Yes.

(Testimony of Frederick E. Maynard.)

XQ. 39. What is your definition of the word "bound"?

A. The word "bound" in my mind means that the things bound are so held together that they could not be separated from one another without severing the binding means.

XQ. 40. When leaves are held together by clamps, then, you would not consider them bound together?

A. If the leaves are held together by a clamp, they are "clamped" together, and if the clamp is of such a nature that the binding means which holds the leaves in the book is such that before the leaves could be removed it would be necessary to break, or disconnect or sever the binding elements, I would say they were bound together.

XQ. 41. Have you compared Defendant's Exhibit No. 10 with the Doughty patent, to see whether or not it is made in accordance with the specifications of the Doughty patent?

A. It is made in an accurate form so as to conform to the requirements of the Doughty patent.

XQ. 42. Now, comparing Defendant's Exhibit 10 with Figure 1 of the Doughty patent, I will ask you to state whether or not such exhibit is made in accordance with such Figure 1?

A. The only difference in the general construction is that the back of the cover is perhaps, considerably longer.

XQ. 43. Does not that make a substantial difference? A. Not in the operation of the book.

(Testimony of Frederick E. Maynard.)

XQ. 44. Is it not a fact that in the Doughty patent the frame to which the carbon is clamped is hinged at the end of the book?

A. That is only a matter of degree.

XQ. 45. Is it not a fact that in the Doughty patent the last section of the leaves are shown as folded prior to being used?

A. That is only a matter of degree, whether the leaves are folded over or not. We will have that perfectly illustrated if we fold the leaves of the exhibit No. 10 over.

XQ. 46. Why was the model made in this way? Why was it not made in this way? Why was it not made in accordance with the Doughty patent?

A. Because the person who made the model, perhaps, did not precisely follow the instructions. He was not instructed, perhaps, to follow this as a copy.

XQ. 47. The model is actually made in much closer resemblance, to the casual observer, to the patent in suit, than the device as shown in the Doughty patent, is it not?

A. No, there is no specific resemblance; merely leaving off the extension of the cover would not constitute a similarity.

XQ. 48. I will ask you to take the model exhibit of the Doughty patent, fold over the last section of the leaves, and then proceed to use the book and describe the operations which are necessary to be made in order to use the book.

A. Taking the model exhibit No. 10 we find that the carbon is connected to the cover of the book by

(Testimony of Frederick E. Maynard.)

a hinge or other flexible connection, enabling it to be turned inwardly towards the stub so as to place the carbon upon the innermost sections of the leaves, the carbon being sufficiently long to cover two sections of the recording-leaves. This leaves the outer section of the recording-leaf free to be folded over inwardly along the line perforations, provided for such folding, and severance; and the leaf which has once been folded is folded again, so that a single fold is given to the carbon. In this way the carbon is folded between the upper sections of the leaf and is in a position to be used.

XQ. 49. Mr. Maynard, I ask you now to fold over the last section of the leaf here in the Doughty patent, just as you find it folded over in the patent.

A. Do you want all of the leaves in the book folded?

XQ. 50. You may fold three or four of them, if you wish.

A. Figure 1 of the Doughty patent shows the uppermost leaf being folded at its outer end so as to enclose a portion of the carbon, and the lower leaves or leaves under the topmost leaf, each have their outer ends folded, this serving apparently the purpose of providing a shorter back.

XQ. 51. Now, Mr. Maynard, we will assume that you have used this book and used the first sheet in this book, and I will ask you to remove it. (The witness removes it.) In removing it I notice that you had to throw the carbon and its frame to one side, to the end of the book, did you not?

(Testimony of Frederick E. Maynard.)

A. I did.

XQ. 52. Now, what will be the next thing to do in order to make use of the second sheet?

A. Merely to throw out the infolded outer section of the recording-sheet and to throw the carbon-carrying frame inwardly over the book. This will result in the carbon falling naturally into place on the leaves of the book.

Mr. WHITE.—In view of the witness' testimony I move to strike out from the files of the case this Defendant's Exhibit No. 10 as not being made in accordance with the Doughty patent introduced in evidence, and not shown to have been used by anyone or representing anything.

XQ. 53. You have studied the Barlow patent very carefully, have you not, Mr. Maynard?

A. I have.

XQ. 54. I believe you stated that the drawing of the carbon sheet in that patent was not shown according to scale—was that correct?

A. I stated so accidentally. It was purely immaterial whether the carbon sheet showed exactly the right size or not.

XQ. 55. It is clearly shown, is it not, in the specifications that the length of the carbon is to be that of two of the sections of the sheet?

A. It so states and is so shown in Figure 2 of the drawings.

XQ. 56. Would anyone reading that patent, anyone skilled in the art, so understand it, that the

(Testimony of Frederick E. Maynard.)

length of the carbon was to be that of two sections of the sheet?

A. The specification states in lines 51, 52 and 53, page 1, of the Barlow patent, exhibit 1: "In using the paper having both faces carbonized, a sheet of sufficient size to cover two of the three sections of each blank is employed." That is sufficiently clear for anyone not to misinterpret the intention of the patent.

XQ. 57. Would anyone skilled in the art, reading this patent, and endeavoring to practice the invention disclosed therein, understand that the carbon was to be the length of two sections?

A. He would.

XQ. 58. Now, Mr. Maynard, do you know why the model introduced in evidence here, disclosing the invention disclosed by this Barlow patent, contains a carbon that is longer than two of the sections of the sheet?

A. The carbon in exhibit marked 9 is somewhat longer, but it is merely a matter of degree.

XQ. 59. And by making this carbon just a little bit longer, it more closely resembles, does it not, the respondent's book, Complainant's Exhibit "A"?

A. I hardly think that any intentional purpose was contemplated in making that a little longer. I didn't make the models.

XQ. 60. It was just carelessness, I presume, that made the man, whoever he was, who made this model, have the carbon sheet a little bit longer than was shown in the patent?

(Testimony of Frederick E. Maynard.)

A. Quite evidently he was not a model maker, otherwise if he had been told to follow the Barlow patent he would have followed it. Since there is no purpose, when we have the patent in front of us showing specifically that the carbon extends over two lengths, of making it any longer.

XQ. 61. The purpose of a model, though, is to more clearly illustrate to the court what was disclosed by the patent, is it not?

A. That should have been the purpose of the model, to follow the patent.

XQ. 62. As a matter of fact, the model did not follow the patent, and therefore does not disclose to the Court more clearly what is disclosed in the patent; is that not correct?

A. Such a variation was quite useless.

XQ. 63. You do not think that the Court would be imposed on by that?

A. I do not, not in view of the patent. If he had no patent he might have been.

Mr. WHITE.—I move to strike out from the files the model of the Barlow patent, Defendant's Exhibit No. 9, on the ground that it does not correctly represent the disclosure of the invention and is not representative of anything in this case.

XQ. 64. Is the carbon in this Defendant's Exhibit 9 held in place by any means?

A. It is not held in place, but I should state that it would not require any ingenuity to bind it in place in view of the prior state of the art.

XQ. 65. Since Mr. Levison did it, I presume you

(Testimony of Frederick E. Maynard.)

could do it? A. Mr. Abraham did it.

XQ. 66. Does Barlow in his patent attempt to accomplish the same result which is accomplished in the Levison patent, to wit; hold the paper in place?

A. He don't attempt to accomplish it, no. He was perhaps, not a constant user.

Mr. TOWNSEND.—That question is objected to as attempting to state what the Levison patent intended to cover.

XQ. 67. (By Mr. WHITE.) By the complicated device disclosed in this Doughty patent, it is evident that the patentee saw the advantage of having the carbon held in place, is it not?

A. I should not think so. I don't think I would have attempted to bind it in by any such complicated means.

XQ. 68. Do you mean to say that the patentee of the Doughty patent did not desire to hold the carbon in place, and for that reason adopted this very complicated means for holding it in place?

A. I do not.

XQ. 69. What do you mean?

A. His intention was absolutely to hold it there.

XQ. 70. To hold it there by this complicated means shown in the patent?

A. He provided just means so that the carbon is movable, but still connected and bound to the book, and in his construction he enabled a person to place the carbon at any point within the body of the book.

XQ. 71. So it was his object then—one of his objects was to hold the carbon in place?

(Testimony of Frederick E. Maynard.)

A. That was one of his objects.

XQ. 72. And he provided this complicated means for doing so?

A. The complication results in an advantage.

XQ. 73. Now, in the respondent's book, Complainant's Exhibit "A," is it the purpose of the construction disclosed in that book to have the carbon removed?

A. Not to have it removed, no, but it is removable; to have it removable.

XQ. 74. For what purpose?

A. For what purpose would it be removable?

XQ. 75. Yes.

A. Well, so that in case anyone made a misstatement in using the book, in using several pages of the recording-sheet, and he wished to save those recording-sheets as records, he could then insert the removable carbon sheet below these sheets, and change an error which had been made.

XQ. 76. So that you find then, in Complainant's Exhibit "A," the respondent's book, the advantages derived from binding or holding the carbon in place, and also the advantages of means permitting the carbon to be moved, if so desired, do you not?

A. He provides a device by which the carbon is held to the book and removable from the book at will.

XQ. 77. So that to the advantages of the Levison construction by which the carbon is held in place the defendant has added the advantages of a removable feature? Is that the fact?

A. The defendant has not added anything to the

(Testimony of Frederick E. Maynard.)

bound-in carbon of Levison.

XQ. 78. Eliminate the word "bound" you have such an aversion to that; and we will use the word "held." The word "held" does not mean "stitched," does it?

A. No, you can hold it without stitching.

XQ. 79. You can hold it without stitching, but you cannot bind it without stitching?

A. Not in the bookbinding. Well, you can bind without stitching.

XQ. 80. Do you understand the word "bound" to mean stitching? A. Not exclusively.

XQ. 81. What does it mean?

A. I said that binding means to hold a thing in such a manner that the binding elements must be severed in order to release it.

XQ. 82. Where did you ever get hold of such a definition?

A. I never got hold of it at all.

XQ. 83. You just manufactured it for this occasion?

A. Perhaps I originated it. I don't know when I manufactured it.

XQ. 84. You originated it in this case?

A. Not necessarily.

XQ. 85. When did you originate such a definition?

A. Whenever it was necessary to use the word "bind" in the sense that the members were permanently connected, such as is frequently necessary in writing specifications, that the definition of the

(Testimony of Frederick E. Maynard.)

word is equivalent.

XQ. 86. You being an expert are necessarily very careful in the use of words and in using words in their proper significance, why is it that you always used the word "permanently" before the word "bound" if in your view the word "bound" means "permanently held together"?

A. Well, because there is two kinds of binding; there is permanent binding and temporary binding.

XQ. 87. Oh, I see. So that the Levison book is limited to permanent binding, and the respondent's book discloses a book which is not bound permanently together—is that the idea?

A. It discloses a book in which there is no real binding at all in any sense applying to the carbon.

XQ. 88. Now, will you give me an illustration of a book bound together, but not bound together permanently?

A. I am not a bookkeeper, but I have seen books temporarily bound by clamps.

XQ. 89. And that is where leaves are bound together but not bound together permanently—is that correct?

A. They are held together so that the leaves may be inserted and removed from the binder without destroying either the binding elements or the leaves.

XQ. 90. So that you do call a clamping device a binding means then?

A. With that distinction.

XQ. 91. What distinction?

A. With the two means of binding, permanent and temporary.

(Testimony of Frederick E. Maynard.)

XQ. 92. And as an example of temporary binding you give the clamp?

A. I give the clamp, yes.

XQ. 93. Now, in Complainant's Exhibit "A" do you find temporary binding leaves?

A. Not set up for that purpose, I do not.

XQ. 94. I did not ask you for what purpose they are set up; I asked you if you found in that exhibit a temporary binding means?

A. Not a binding which binds in the carbon.

XQ. 95. Why does not that bind in the carbon if it holds it in place in the same manner that the clamp holds the leaves together in place?

A. It is a clamp that is usually provided with mechanical means by which the leaves are held. The means are set up for that purpose. In this case there are no means set up for the purpose of binding that carbon. The binding in that book is for the purpose of securing the leaves of that book together.

XQ. 96. Does not the binding in this book hold the carbon in place when it is inserted in the manner shown here in Defendant's Exhibit "A"?

A. The binding of the book holds the leaves together, and enables the carbon to be held in there.

XQ. 97. In the same manner that a clamp would hold the carbon in place? A. No, sir.

XQ. 98. What different force is used in Defendant's Exhibit "A" to hold the carbon in place than is used in clamping?

A. The difference of the elements entering into it.

(Testimony of Frederick E. Maynard.)

XQ. 99. I am not asking you about the elements. I am asking you about the force applied.

A. Well, in a clamp designed for the purpose of holding the books. That is its intention. The function in this case is to hold the carbon.

XQ. 100. You mean that the man who made this stated to himself, "Now, the intention of this binding is not to hold the carbon in place, but evidently he has made that book and I am going to use it to perform that function"?

A. The same as if you stick a card in the book sufficient to hold it from dropping out. That is not binding it in the book.

XQ. 101. Can you give any other example of leaves held together or bound together by means that do not constitute a permanent binder?

A. There are numerous temporary binders which I cannot enumerate at present.

XQ. 102. There are numerous ones, but you can't name any one now.

A. I am sufficiently familiar with them, but I can't mention any clamp except a clamp having a spring in it, for the purpose of holding leaves together.

XQ. 103. Can you name any mere temporary binding means other than a clamping device?

A. No.

XQ. 104. Do you find the word "permanently" used in one of the claims of the patent in suit?

A. No, you don't find it in the claims, but you have to refer to the specification in following those claims.

(Testimony of Frederick E. Maynard.)

XQ. 105. And the claims are limited to the specific construction shown in the specification—is that correct?

A. They are built upon the foundation set up in the specification and drawings.

XQ. 106. Is it your understanding that because a permanent binding means is disclosed in the patent in suit, that the claims are limited to a permanent binding means?

A. The claims are limited to the use of the word “binding” as disclosed, and in view further of the general state of the art that there are two classes of books, the bound book and the loose carbon book.

XQ. 107. In a book constructed in accordance with the Doughty patent, is it possible for the manufacture of the same to determine with how many leaves the carbon sheet shall be used, and thereby economize the use of the carbon?

A. Manufacturers, I think, usually are aware of the number of good impressions that can be taken from one carbon, so that they would provide sufficient carbons.

XQ. 108. A manufacturer is in a better position, is he not, to determine how many sheets may be used, or how many impressions may be taken or used with one carbon, than the ordinary user?

A. The purchaser of the book would probably make his demand that the book meet his requirements. The manufacturer may neglect to put in the requisite number of carbons, to his own advantage. I should think that judgment would determine the

(Testimony of Frederick E. Maynard.)

number of the carbons; that is, the requirements of the users.

XQ. 109. I believe you stated that in the original Levison patent you did not find any accident or any inadvertence or any mistakes?

A. I so stated.

XQ. 110. And it is your understanding of the law that in order that a reissue patent may be had, that there must appear in the original patent such an accident, inadvertence or mistake. Is that correct?

Mr. TOWNSEND.—We object to that as calling for a legal conclusion; and the witness has not testified as to his idea of what the law requires.

A. Yes.

XQ. 111. (By Mr. WHITE.) With that understanding of the law you have given your testimony here?

A. I have not attempted to testify on a question of law.

XQ. 112. I said with that understanding of the law you have given your testimony here. Is that correct? A. Yes.

XQ. 113. Did you ever see an accident in any patent specifications in your life?

A. I have known cases in which the specification did not set up all the matter that was disclosed in the drawing.

XQ. 114. And in that case you would consider those an accident appearing upon the face of the specification? A. An inadvertence, perhaps.

XQ. 115. The same concrete embodiment of the

(Testimony of Frederick E. Maynard.)

invention is shown in the drawing of the original patent in the same manner, not in its details, as it is shown in the reissue patent, is it not?

A. The specification and drawings are similar with the exception of the insertions made in the reissue patent.

XQ. 116. I presume it is your understanding of the law that in the reissue patent any insertions which are not contained in the original patent, that the reissue is void? Is that correct?

Mr. TOWNSEND.—We object to that as calling for a legal conclusion, because the witness has not been asked what his opinion was, or as to the effect of any such omission or insertion, but he has been asked as to the facts, if any, constituting the insertions or omissions, not as to their legal effect.

A. I should not state that the patent is void. It is not my province.

XQ. 117. (By Mr. WHITE.) You said you found new matter in the reissue patent in suit. What do you mean by new matter?

A. Material which does not appear in the specification of the original patent.

XQ. 118. What do you mean by material?

A. Substance, matter.

XQ. 119. You mean new printed matter?

A. New descriptive matter, printed or written.

Mr. WHITE.—That is all.

Mr. TOWNSEND.—I have just handed the Master Exhibit No. 7, which was offered in evidence but was not present at that time. It is now submitted and marked Defendant's Exhibit No. 7.

(Testimony of Frederick E. Maynard.)

Redirect Examination.

(By Mr. TOWNSEND.)

RDQ. 1. You stated in cross-examination, Mr. Maynard, that the art shows two classes of books, those of the bound carbon variety and those of the loose carbon variety? A. I did.

RDQ. 2. Will you please illustrate by reference to the patents and exhibits?

A. The patent to Perry, exhibit No. 6, and the patent to Barlow exhibit No. 1, clearly set forth manifold books in which the carbons are not bound into the book, whereas in the patent to Bengough, exhibit No. 7, to Abraham, exhibit No. 3, and to Doughty, exhibit No. 2, the carbons are bound to the book, thus clearly showing without question two distinct varieties of manifold books, to wit, loose leaf carbons and the bound carbons.

RDQ. 3. To which class does the Levison patent in suit belong?

A. The Levison patent clearly belongs to the class as represented by the Abraham patent, exhibit No. 3, in which the carbon is bound to the book. The Bengough patent, exhibit No. 7, also having the carbon bound into the book.

RDQ. 4. To which class does the respondent's book, Complainant's Exhibit "A," belong?

A. The respondent's book may be classified along with the patent to Perry, exhibit No. 6, showing a triplicate book with loose carbons, the patent to Barlow, exhibit No. 1, showing a triplicate manifold book having a loose carbon.

(Testimony of Frederick E. Maynard.)

RDQ. 5. In the Doughty patent, what is the purpose of mounting the carbon in the manner shown, on a hinged arm?

Mr. WHITE.—We object to that as not proper re-direct examination.

A. The purpose of a carbon mounted on a hinged arm is so that the carbon may be turned down to lie upon the inner sections of the book.

RDQ. 6. (By Mr. TOWNSEND.) What other purposes have they?

A. And to hold it permanently secured to the book.

RDQ. 7. In what way is it permanently secured to the book?

A. By means of the frame to which it is secured, the frame in turn being secured to the cover.

RDQ. 8. State whether or not the carbon is removably held in the frame?

Mr. WHITE.—We object to that as leading. The witness has not stated that it is removably held to the frame.

A. The carbon is held in a clamp secured to the frame.

RDQ. 9. (By Mr. TOWNSEND.) What is that clamp designated?

A. It is designated as D, the clamp being mounted on the free ends of the arms dd.

RDQ. 10. In your understanding of the Doughty patent, what would you say that the clamp D indicated?

A. It would indicate that the carbon was secured

(Testimony of Frederick E. Maynard.)

to the frame C.

RDQ. 11. You stated that the carbon in the Doughty is capable of insertion in the various portions of the book? A. It is.

RDQ. 12. How in that respect does it differ from the respondent's carbon?

A. It differs mainly in that it is secured to the cover of the book, while the respondent's is not secured to the cover; but in each case the carbon is insertable at different points in the book.

RDQ. 13. Is the carbon of the Doughty insertable at different points in the book?

A. It may be inserted between different leaves of the book.

RDQ. 14. State whether or not it is any different in that respect from the carbon of the respondent.

A. No.

RDQ. 15. On cross-examination your attention was called to a means for holding a pad of leaves in the Doughty in place. I will call your attention to the Doughty patent, exhibit No. 2, and will ask you to read lines 46, page 1.

A. (Reading:) B indicates the pile of full leaves, secured together by staples a a at one end and by the same end to the cover by the clamp A'. In the first two figures of the drawings the clamp A' is secured to the inner side of the cover on the right-hand side of the hinge. The bound ends of the leaves are held in this clamp with their free ends extending to the right, but with their end sections b'' turned inward and lying on their respective central sections b'.

(Testimony of Frederick E. Maynard.)

RDQ. 16. Do you find in the specification means enumerated there for binding the pile of leaves together?

A. It is here stated that the leaves are bound together by staples.

RDQ. 17. Does it say anything there in that paragraph that they are bound by the clamp A'?

A. It also states that they are secured at the same end to the cover by the clamp A'.

RDQ. 18. Which end of the leaves is held by the clamp? Does it say there?

A. It states that the leaves are secured together by staples at one end, and by the same end secured to the cover by the clamp A'.

RDQ. 19. Does it state specifically in the first line, on top of column 2, how those ends are bound, how they are clamped?

A. It states that the bound ends of the leaves are held by this clamp by their free ends extending to the right.

RDQ. 20. State what, to your mind, the word "binding" means as used by the patent of Doughty from reading paragraph above mentioned?

A. This states that the ends are bound, and it states also that they are secured together by staples, at one end. Apparently the leaves are first secured together by staples, and they are then again bound to the cover with the clamp, so that their free ends extend to the right.

RDQ. 21. Does it say that they are bound to the cover by the clamp, or that the bound ends of the

(Testimony of Frederick E. Maynard.)

leaves are held by the clamp?

A. It states that the bound ends of the leaves are held in this clamp.

RDQ. 22. What would you say that the binding means are in the Doughty? The staples or the clamp A'?

A. It states that they are secured together by staples, at one end, and by the same end secured to the cover by the clamp. It is a question which is intended to be employed, whether the leaves are bound to the cover or whether the clamp holds them to the cover.

RDQ. 23. When it speaks in the top line of the second column "The bound ends of the leaves are held in this clamp," does it mean that these bound ends are held by the staples or by a clamp?

A. That would infer that the bound ends are held to the cover by the clamps.

RDQ. 24. How do you connect the bound ends of the leaves in the first place?

A. By the staples a.

RDQ. 25. Then, what would you say is meant by binding in the Doughty patent?

A. It certainly states that the binding here is by means of staples.

RDQ. 26. Referring to the Barlow patent, page 1, lines 51 and 52, does it state therein that the carbon must be just the size to cover two sections?

Mr. WHITE.—We object to that as leading, and on the further ground that it is not proper redirect examination. The matter has been gone into fully on direct.

(Testimony of Frederick E. Maynard.)

A. No; it states that the carbon sheets should be sufficient size to cover two of the three sections of each blank employed.

RDQ. 27. (By Mr. TOWNSEND.) Do you find anything in that sentence to limit it precisely to two sections?

Mr. WHITE.—That is objected to as leading.

A. I do not.

RDQ. 28. (By Mr. TOWNSEND.) State whether or not in your opinion you think the Court would be misled in comparing the Doughty patent and the Barlow patent and the Barlow model, exhibit 9.

A. I should not think that the Court would be misled by such a showing.

(Further hearing adjourned to Friday, March 12, 1909, at 10:30 A. M.)

Friday, March 12, 1909, 10 A. M.

Counsel appearing:

W. K. WHITE, Esq., of MILLER & WHITE,
Solicitors for Complainant.

C. E. TOWNSEND, Esq., Solicitor for Defendant.

[Testimony of John Kitchen, Jr., for Defendant.]

Testimony of JOHN KITCHEN, Jr., called for defendant.

(By Mr. TOWNSEND.)

Q. 1. Mr. Kitchen, are you the same John Kitchen, Jr., who has been sworn and has testified in this case already? A. The same.

Q. 2. What is your age, Mr. Kitchen?

(Testimony of John Kitchen, Jr.)

A. Forty-one.

Q. 3. What is your occupation?

A. Employing bookbinder and printer.

Q. 4. How long have you been in that business?

A. 25 or 26 years.

Q. 5. Are you familiar with the bookbinding art?

A. Yes, I am a master mechanic.

Q. 6. Do you recognize Complainant's Exhibit "A"?

A. Yes, I do.

Q. 7. State, Mr. Kitchen, generally, what were the circumstances leading up to the manufacture of books of that character and the furnishing of them to the city.

A. Well, the City and County of San Francisco issue a schedule yearly for books and stationery and printing supplies for the fiscal year, and one of the specifications called for a carbon book, a triplicate book by samples to be submitted, and the samples were submitted and it was approved by the Board of Supervisors, the printing committee of the Board of Supervisors.

Q. 8. Were there any other bidders?

A. Oh, there were various other bidders on this same proposition. A lot of other people bid. Mr. Levison bid.

Q. 9. Mr. Levison who is the complainant in this case?

A. Yes, he bid. He put in an exorbitant figure on the job, such as it was.

Mr. WHITE.—I move to strike out the latter statement of the witness on the ground that it is not responsive.

(Testimony of John Kitchen, Jr.)

Q. 10. (By Mr. TOWNSEND.) You state that Mr. Levison's figure was exorbitant. What do you mean by that?

Mr. WHITE.—I object to that as incompetent, irrelevant and immaterial.

A. I mean that it was about 60 per cent higher than what he would charge the regular consumer, the regular people around the town; between 50 and 60 per cent higher than what he would charge other people.

Q. 11. (By Mr. TOWNSEND.) Do you mean for the same quality of book?

A. The same quality and kind of book.

Q. 12. I show you a paper, Mr. Kitchen, and ask you if you recognize it, to tell me what it is.

A. Yes, that is the patent that I made application for, and which I furnished the City and County of San Francisco the same style of book that is called for in this patent.

Mr. TOWNSEND.—I offer in evidence copy of patent 911,597, dated February 9, 1909, issued to John Kitchen, Jr., for manifolding book, and ask that the same be marked Defendant's Exhibit No. 12.

Mr. WHITE.—We object to that as incompetent, irrelevant and immaterial.

(Marked Defendant's Exhibit No. 12.)

Q. 13. (By Mr. TOWNSEND.) I understand, Mr. Kitchen, you are the patentee mentioned in that exhibit 12? A. I am.

Q. 14. State whether or not Complainant's Exhibit "A" is built according to your patent exhibit 12?

(Testimony of John Kitchen, Jr.)

A. This book is built on the same lines exactly as exhibit 12.

Q. 15. Take Complainant's Exhibit "A," Mr. Kitchen. I will ask you if that book contains or shows the stubs of the recording-sheets and one side of the carbon sheet and backing being all bound together to form a book?

Mr. WHITE.—We object to that as leading.

A. No, it does not.

Q. 16. And for what reason, Mr. Kitchen?

A. Well, it has a removable carbon. The carbon is not bound in.

Q. 17. Any other difference?

A. Well, there are no so-called backing-sheets in this card. This card, this book has a flexible stop-card that can be inter-leaved under any sheet, and is not bound in the book, the same as in Brown.

Q. 19. You mean the Brown patent?

A. Yes, I constructed that stop-card for Brown a good many years ago.

Q. 20. Referring to exhibit 4?

A. Exhibit 4.

Q. 21. Is the construction of that stop-card of this exhibit "A" described and shown in your patent exhibit 12? A. It is.

Q. 22. State whether or not the construction and operation of your carbon is described in your patent also? A. It is.

Q. 23. Taking the Barlow patent, exhibit No. 1, Mr. Kitchen, I will ask you if you are familiar with that?

(Testimony of John Kitchen, Jr.)

A. I am. I have bound a good many thousand of the Barlow patent a good many years ago. The man that owned the patent, that had the patent rights for it was Jacob Bacon & Co.; and when I was a boy learning my trade I bound a good many thousands of those in various forms and styles.

Q. 24. Had those books that you bound then as a boy the recording-sheets bound together and divided into three sections foldable as therein shown?

Mr. WHITE.—We object to that as leading.

A. Exactly as shown in this copy here.

Q. 25. How are the carbons?

A. The carbons were supposed to cover two sections, or a little larger. It don't make any difference. We generally cut them a little larger, for the reason that the carbon rolled up and curled up on the edge, and folded over.

Q. 26. Have you ceased to manufacture those books?

A. No, we have not. We make those books to-day, many of the Barlow books to-day.

Q. 27. Have you recently had occasion to bind any?

A. Yes, just a little while ago. Well, I will say that there is hardly a week goes by that we don't have some form of Barlow book. I have a copy of one.

Q. 28. Will you produce it, one that was bound here recently? (The witness produces.) How recently do you mean?

A. Well, this here was bound in January.

(Testimony of John Kitchen, Jr.)

Q. 29. Of this year?

A. January of this year.

Q. 30. State whether or not that was filled in response to an order for a book of that sort.

A. Yes, it was to fill an order for that book. That was the book that was submitted.

Q. 31. What notice appears on those sheets that you have before you?

A. Letters forming the number and the date. The people who order them have their number and that goes on their order.

Q. 32. For whom were those books made?

A. For Schilling; A. Schilling.

Q. 33. Of this city? A. Yes, sir.

Mr TOWNSEND.—I introduce this book in evidence, and ask that it be marked Defendant's Exhibit No. 13.

(So marked.)

Q. 34. Have you any idea how many of those books, the Barlow, you make?

A. Well, that would be impossible to tell. We have never kept any data, but hardly a week goes by unless we have some form of triplicate books in, similar to the Barlow.

Q. 35. State whether or not the books such as exhibit 13, corresponding to the Barlow patent, are now in general use or not. A. They are.

Q. 36. Are they used by more firms than A. Schilling & Co. in this city?

A. Oh, my! There are numerous firms use them.

Q. 37. Are there more firms than yours? Are

(Testimony of John Kitchen, Jr.)

there other firms than yourself making these books to-day in this city?

A. Yes, every bindery in San Francisco makes them, and every printing office.

Q. 38. Do you recollect any other recent orders than the Schilling order for these books?

A. I cannot recollect them. That was the only one that I had in sheets—that I had any sheets left over of, the only one that I could look up immediately. I say there is hardly a week goes by—

Q. 39. State whether or not it is the rule of your office to make up a number of books required, and deliver the whole lot.

A. Yes, we do make up just what is ordered, and deliver them.

Q. 40. Talking of the Barlow patent before you, this book, exhibit 13, I would ask you if that book is a manifold book? A. It is.

Q. 41. Does it comprise “a double-carbon sheet”? A. It does.

Q. 42. State whether or not it has “a plurality of recording-sheets.” A. It has.

Q. 43. State whether or not it has “a cardboard backing.”

Mr. WHITE.—We object to that as leading.

A. Yes, you could call the book cover of every book a cardboard backing.

Q. 44. (By Mr. TOWNSEND.) What would be the function of the cardboard backing?

A. Well, it is to protect the leaves, and also—well, it would also give you a better carbon copy.

(Testimony of John Kitchen, Jr.)

Q. 45. In what way?

A. Well, it makes a hard surface to write upon.

Q. 46. Will the backing sheet do more than that?

A. No.

Q. 47. Continuing my reading of Claim 2 of the Levison patent sued on, I will ask you whether or not "the recording-sheets outside the stubs of the book we are now looking at, the Barlow book, is divided into three substantially equal, separable parts." A. They are.

Q. 49. State whether or not in that book "the carbon sheet extends the width of two of said parts."

A. Yes, it does, and a little over. It covers two and it is a little bit larger than two.

Q. 50. State whether or not the recording-sheets have stubs to which they are attached along lines of perforation. A. They have.

XQ. 51. State whether or not "the stubs of those recording-sheets and one side of the carbon sheet and backing are all bound together to form a book."

A. The carbon is loose.

Q. 52. State whether or not there is any other distinction notable between the book that you have before you and the paragraphs I have just read to you. A. No.

Q. 53. Now, take Claim 3 of the patent sued on. I will ask you if the manifold book you have before you "comprises in order a double-carbon sheet."

A. It does.

Q. 54. State whether or not it has "a plurality of recording-sheets." A. It has.

(Testimony of John Kitchen, Jr.)

Q. 55. State whether or not "the recording-sheets outside the stubs being divided into three substantially equal separable parts."

A. They are.

Q. 56. State whether or not "the carbon sheet extends the width of two of said parts."

A. It does.

Q. 57. State whether or not "the recording-sheets have stubs to which they are attached along lines of perforation." A. They have.

Q. 58. State whether or not "the stubs and one side of the carbon sheet being all bound together to form a book."

A. No, the carbon sheet is not bound in this.

Q. 59. Did you ever bind carbons into books?

Mr. WHITE.—We object to that as immaterial.

A. Yes, we have.

Q. 60. (By Mr. TOWNSEND.) Did you ever know of carbons being bound into manifolding books when you were learning your apprenticeship?

Mr. WHITE.—That is objected to as indefinite and uncertain as to the form of the manifold book referred to.

A. Yes, I have bound carbons in various forms of manifold books for many years.

Q. 61. (By Mr. TOWNSEND.) State what you mean by "bound carbons."

A. A bound carbon is a carbon wired or sewed into the book whereby it cannot be removed without being torn out or destroying the elements of the binding.

(Testimony of John Kitchen, Jr.)

Q. 62. Are there any distinctions made in the bookbinding business between bound carbons and loose carbons?

A. In the bookbinding art there are two kinds of books, known as a bound book and a loose leaf book.

Q. 63. What class does your exhibit "A," belong to? A. The loose leaf.

Q. 64. State whether or not you bound carbons into manifold books earlier than January 1, 1899.

Mr. WHITE.—We object to that as indefinite and uncertain as to the particular form of manifold book referred to.

A. I did.

Q. 65. I understand you to say you have made books like the Barlow patent and the exhibit 13 as early as that last-named date.

Mr. WHITE.—We object to that as leading.

A. Yes, I have, as far back as 20 or 25 years ago.

Q. 66. (By Mr. TOWNSEND.) From your knowledge and experience of the bookbinding art state whether or not you would have considered you had discovered something new by binding the Barlow carbon into the old Barlow book.

Mr. WHITE.—We object to that as immaterial.

A. I would not.

Q. 67. For what reason?

Mr. WHITE.—We make the same objection.

A. There is nothing to do except to stitch the carbon in. The principle of inter-leaving is a thing that was in vogue years ago in duplicate systems, and was used that way. The Abraham book had a car-

(Testimony of John Kitchen, Jr.)

bon bound in. Doughty has a triplicate book with the carbon bound in.

Q. 68. I read you Claim 4 of the patent sued on, Mr. Kitchen, and ask you if the exhibit 13 before you and the Barlow patent, exhibit 1, show “a manifold book comprising in order a double-carbon sheet.”

Mr. WHITE.—We object to that as leading.

A. I don’t catch the drift of that.

Q. 69. (By Mr. TOWNSEND.) Do they show “a plurality of recording-sheets”?

A. Yes, they both do.

Q. 70. State whether or not it shows each of said “sheets outside of the stub being divided into a plurality, not less than three, of substantially equal separable parts.”

A. More than three.

Q. 71. Do they show “the carbon sheet extending the width of said parts, except the outermost”?

Mr. WHITE.—We make the same objection.

A. They do.

Q. 72. Do “the recording-sheets have stubs to which they are attached along lines of perforation”?

Mr. WHITE.—We make the same objection.

A. They have.

Q. 73. (By Mr. TOWNSEND.) State whether or not “the stubs and one side of the carbon sheet are bound together to form a book.”

Mr. WHITE.—We make the same objection.

A. They are not.

Q. 74. (By Mr. TOWNSEND.) State whether or not you see any other difference between the Barlow book and the description I have just read other

(Testimony of John Kitchen, Jr.)

than the matter of binding the carbons.

A. What is the description? That is what I want.

Q. 75. The description of this claim I have just read to you? A. The Barlow book?

Q. 76. No, Claim 4. I have just read Claim 4 and you have found various elements as I read it, as I read them separately, in the Barlow book, and you stated that the Barlow carbons were not bound in?

A. Well, the claim says the carbons and stubs are all bound together.

Q. 77. I was asking if there was any distinction other than that between the claim, the elements of the claim just read?

A. What claim are you reading from? What patent?

Q. 78. Claim 4. A. What is that?

Q. 79. I have been referring to the Levison patent. I had read Claim 4 of the Levison patent sued on, and had pointed out the different elements in that claim in the Barlow book.

A. In comparison with the Barlow book?

Q. 80. Yes. When I read the phrase, whether the stubs and one side of the carbon sheet were all bound together to form a book, you stated that the carbons were not all bound together in that exhibit 13, or in the Barlow book. I merely asked if there was any other difference than what I have read?

A. There are no backing sheets in this, which the Levison patent claims.

Q. 81. Then the backing sheets were not included

(Testimony of John Kitchen, Jr.)

in that Claim 4?

A. Not in that Claim 4.

Q. 82. I will ask you to explain in regard to Claim 5. I will read the Claim 5 to you of the Levison patent, and ask you if the Barlow patent or the Barlow book, exhibit 13, is "a manifold book comprising in order a double carbon sheet."

Mr. WHITE.—We object to that as leading.

A. It has a double carbon sheet.

Q. 84. (By Mr. TOWNSEND.) State whether or not it has "a plurality of recording-sheets."

Mr. WHITE.—We make the same objection.

A. It has.

Q. 85. (By Mr. TOWNSEND.) State whether or not "each recording-sheet outside the stub is divided into a plurality not less than three of separable parts joined along lines of perforation."

Mr. WHITE.—We make the same objection.

A. It has.

Q. 86. (By Mr. TOWNSEND.) State whether or not "each part being not greater than the part next it on the side toward the stub."

Mr. WHITE.—We make the same objection.

A. The same.

Q. 87. (By Mr. TOWNSEND.) State whether or not "the carbon sheet extends the width of the whole of said parts except the outermost."

Mr. WHITE.—We make the same objection.

A. It does not. It covers two sections.

Q. 88. (By Mr. TOWNSEND.) I will read that again. State whether or not the carbon sheet

(Testimony of John Kitchen, Jr.)

in exhibit No. 13 extends the width of the whole of said parts except the outermost.

Mr. WHITE.—The question is a repetition of the former question and is objected to on the same ground, and also on the ground that the witness has also answered the question.

A. It does not. It extends from the back, the edge of the back, to the third perforation, to the line of the third perforation. It is sufficiently large to cover two sections and a little over.

Q. 89. (By Mr. TOWNSEND.) Is there more than one section uncovered by the carbon?

Mr. WHITE.—We object to that as leading.

A. There is only one section remains uncovered.

Q. 90. (By Mr. TOWNSEND.) Are there more than one uncovered?

Mr. WHITE.—We make the same objection.

A. No, only one.

Q. 91. (By Mr. TOWNSEND.) I will read the question again to you. Does that book, exhibit 13, show “a carbon sheet extending the width of the whole of said parts except the outermost part”?

A. It does.

Q. 92. And do you wish your previous answers corrected? A. I do.

Q. 93. State whether or not “the recording-sheets have stubs to which they are attached along lines of perforation.”

Mr. WHITE.—We object to that as leading.

A. They have.

Q. 94. (By Mr. TOWNSEND.) State whether

(Testimony of John Kitchen, Jr.)

or not "these stubs and one side of the carbon sheet are all bound together to form a book."

Mr. WHITE.—We make the same objection.

A. The carbon sheet is not bound in.

Q. 95. I show you the patent of Doughty, exhibit No. 2, Mr. Kitchen, and ask you if you are familiar with that? A. Yes.

Q. 96. I ask you if that is a manifold book?

A. Yes, it is.

Q. 97. Does it show a double carbon sheet?

A. It does.

Q. 98. Does it show a plurality of recording-sheets? A. It does.

Q. 99. State whether or not it shows a cardboard backing. A. It does.

Q. 100. What do you call a cardboard backing?

A. I call a cardboard backing in this case the binding of the book, the board that is put on to protect the leaves.

Q. 101. Which one of the covers would that ordinarily be?

A. That would be the back cover, or both. The back cover or the front cover. Both protect the leaves, and one could be used as a stop-card.

Q. 102. State whether or not in the Doughty the recording-sheets outside of the stub are divided into three substantially equal separable parts.

A. They are.

Q. 103. State whether or not the carbon sheet extends the width of two of said parts.

A. It does.

(Testimony of John Kitchen, Jr.)

Q. 104. State whether or not the recording-sheets have stubs to which they are attached along lines of perforation.

Mr. WHITE.—We object to that as leading.

A. They have.

Q. 105. (By Mr. TOWNSEND.) State whether or not these stubs and one side of the carbon sheet and backing being all bound together to form a book.

Mr. WHITE.—We make the same objection.

A. The sheets are wired together and then bound with a clamp to the cover.

Q. 106. (By Mr. TOWNSEND.) And how is the carbon?

A. The carbon is clamped to a spring or rod so that it can be held in place and removable.

Q. 107. And does that work with a rod?

A. It works on a hinge.

Q. 108. I understood you in your last answer to say that the leaves were bound together, Mr. Kitchen?

Mr. WHITE.—We object to that as grossly leading.

A. They are bound to the cover.

Q. 109. (By Mr. TOWNSEND.) How are the leaves bound together?

A. The leaves are wired together and fastened to the cover with a clamp.

Q. 110. What kind of a clamp would you call that?

Mr. WHITE.—We object to that as grossly lead-

(Testimony of John Kitchen, Jr.)

ing, the witness having stated very definitely and clearly that the leaves are bound to the cover by a clamp, and there can be no misunderstanding on the part of counsel what kind of clamps the leaves are bound together with. The question is a mere suggestion to the witness to change his testimony.

A. The leaves are wired, stitched together, and held to the cover by a clamp, a spring clamp.

Q. 111. (By Mr. TOWNSEND.) I will read you from Claim 3 of complainant's patent sued on, and ask you if the Doughty book as shown by the patent before you and the model exhibit 10 shows a double carbon sheet? A. It does.

Q. 112. State whether or not it shows a plurality of recording-sheets. A. It does.

Q. 113. State whether or not the recording-sheets outside the stubs are divided into three substantially equal separable parts.

Mr. WHITE.—We object to that as leading.

A. They are.

Q. 114. (By Mr. TOWNSEND.) State whether or not the carbon sheet extends the width of two of said parts.

Mr. WHITE.—We object to that as leading.

A. It does.

Q. 115. (By Mr. TOWNSEND.) State whether or not the Doughty device shows recording-sheets having stubs to which they are attached along lines of perforations. A. They have.

Q. 116. State whether or not the stubs and one

(Testimony of John Kitchen, Jr.)

side of the carbon sheet are bound together to form a book.

Mr. WHITE.—I make the same objection.

A. They are.

Q. 117. (By Mr. TOWNSEND.) Reading from Claim 4 of complainant's patent I will ask you if the Doughty patent and model referred to shows a double-carbon sheet? A. It does.

Q. 118. Does it show a plurality of recording-sheets? A. It does.

Q. 119. Does it show each of said sheets outside of said stubs being divided into a plurality of not less than three substantially equal separable parts?

Mr. WHITE.—We object to that as leading.

A. It does.

Q. 120. (By Mr. TOWNSEND.) State whether or not it shows the carbon sheet extending the width of said parts except the outermost.

Mr. WHITE.—We make the same objection.

A. It does.

Q. 121. (By Mr. TOWNSEND.) State whether or not it shows said recording-sheets having stubs to which they are attached along lines of perforation.

A. It does.

Q. 122. State whether or not said stubs and one side of the carbon sheet are all bound together to form a book?

Mr. WHITE.—We object to that as leading.

A. It does.

Q. 123. I read now from Claim 5 of complainant's patent and ask you if the Doughty patent and

(Testimony of John Kitchen, Jr.)

exhibit referred to show a manifold book comprising in order a double carbon sheet?

A. It does.

Q. 124. And a plurality of recording-sheets?

A. It does.

Q. 125. Each sheet outside the stub, each recording-sheet, being divided into a plurality not less than three of separable parts joined along lines of perforation? A. It does.

Q. 126. State whether or not it shows each part being not greater than the part next it on the side toward the stub. A. It does.

Q. 127. State whether or not in the Doughty the carbon sheet extends the width of the whole of said part except the outermost. A. It does.

Q. 128. State whether or not it shows a recording-sheet having stubs to which they are attached along lines of perforation. A. It does.

Q. 129. State whether or not in the Doughty these stubs and one side of the carbon sheet are all bound together to form a book?

Mr. WHITE.—We object to that as leading.

A. It does.

Q. 130. (By Mr. TOWNSEND.) Mr. Levison has previously testified in this case that he has practically the monopoly of the triplicate shipping receipt business, and that he controls from 75 to 90 per cent of the trade in this city. Have you any knowledge as to the fact?

A. Oh, I know that some of the largest dealers in the town do not handle his books.

(Testimony of John Kitchen, Jr.)

Q. 131. Will you state whether or not you think his statement is correct?

A. I do not think it is correct.

Q. 132. Do you think it is approximately correct?

Mr. WHITE.—We object to that question on the ground that no proper foundation has been laid, it not being shown that the witness is in a position to judge of the fact.

A. I don't think it is.

Q. 133. (By Mr. TOWNSEND.) State whether or not in your opinion Mr. Levison's company has practically the monopoly of that trade.

Mr. WHITE.—We object to that on the ground that no proper foundation has been laid, and that it is calling for a mere conclusion of the witness.

A. No, I would not say that he has. Owing to the size of his plant I don't see how he could.

Q. 134. (By Mr. TOWNSEND.) If his book has met with popularity and success, state what in your opinion you attribute that to?

Mr. WHITE.—We object to that as calling for a mere conclusion of the witness, no proper foundation having been laid.

A. It is attributable to his specializing, making a *speciality* of one thing, going out and working with good salesmen, working on one thing. I have done the same thing on different lines specialized on them and made a success of them.

Q. 135. (By Mr. TOWNSEND.) Do you attribute his success to his patent or to his business

(Testimony of John Kitchen, Jr.)

ability? A. To his business ability.

Mr. TOWNSEND.—Take the witness.

Cross-examination.

(By Mr. WHITE.)

XQ. 1. How is the carbon bound in the Doughty book, Mr. Kitchen? By what means?

A. It is fastened, clamped to the rims by a spring.

XQ. 2. By a spring clamp?

A. A spring of some form, yes.

XQ. 3. You say it is bound in the book?

A. I say that it is an ordinary spring.

XQ. 4. You say it is bound in the book?

A. Bound by a spring, yes.

XQ. 5. How do you reconcile that statement with your definition of your understanding of the word “bound” that you have given on direct examination?

A. “Bound” is something that is secured by a mechanical device whereby you have to undo a spring or a screw or a wire, if it is wired on the side.

XQ. 6. I thought you said you would have to destroy the carbon if it was bound in?

A. This is a removable carbon.

XQ. 7. I thought you said if the carbon was bound in the book it was necessary to destroy it in order to remove it? A. I did.

XQ. 8. So that in the Doughty patent you would have to destroy it?

A. I said in the Doughty book the carbon was bound in by a clamp and I also said that when the carbon was bound in the book it would be necessary

(Testimony of John Kitchen, Jr.)

to destroy it in order to remove it.

XQ. 9. If you remove it from the Doughty book you would have to destroy it?

A. Yes, but if there was a removable carbon, when it was worn out of course it could be torn out and another one put in its place.

XQ. 10. Do you think that is an answer to my question? A. I do.

XQ. 11. How do you reconcile your definition of the word "bound" where you apply it to that book, with your statement—the Doughty book and the Levison book?

A. Certainly my carbon is not bound in.

XQ. 12. You say that in your book the carbon is held in place as firmly as though it was originally bound in when the book was made up? Is that your statement?

A. Yes, it is removable but without any mechanical device or binding.

XQ. 13. What do you mean by using the word "original" in that statement in your patent where you say the carbon is held firmly in place, just as firmly as though they had been bound in the book originally?

A. Well, it holds it in place firmly.

XQ. 14. In other words, you mean after the book is bound up it is bound in place?

A. The carbon can be inserted in any other place you want to put it.

XQ. 15. So in your book the carbon is not bound in place or held in place until after the book is made

(Testimony of John Kitchen, Jr.)

up? A. The book is made first.

XQ. 16. Then the carbon is bound in by being inserted?

A. The carbon is inserted any place you wish to put it. It can be taken out and removed and another sheet put in, if you wish to do so.

XQ. 17. What is the purpose of holding the carbon in your book firmly in place?

A. The object is to keep the carbon from flying away or dropping out.

XQ. 18. You considered it of sufficient importance, did you not, to construct your book in a much more expensive manner than you would have constructed it with your carbons inserted loosely? Is that the fact?

A. In this way, the carbon is always there.

XQ. 19. Is that of any importance to the user of the book?

A. It is. He knows his carbon is there and it does not fly away or get loose.

XQ. 20. Do the users of the book demand such a form of book?

A. I am just introducing this now.

XQ. 21. Do you find it being accepted very readily by merchants?

A. I can't tell as yet, because I have not put in any of them. I have not introduced them to any extent.

XQ. 22. Why did you get up this form of book in which the carbon is held firmly in place? Did you ascertain from the users of the books that they de-

(Testimony of John Kitchen, Jr.)

sired such a kind of book?

A. No, it was purely my own idea. I looked over the matter, and I made various models and things, and finally I thought I had something of value.

XQ. 23. You thought that there was something of value?

A. I thought it was, because I went and paid an attorney, I went to a patent attorney when I thought I had got it perfected.

XQ. 24. In the Barlow patent could you remove the carbon from between any of the leaves and place it in any other portion of the book?

A. Yes, but the wind would blow the carbon out and it might be lost.

XQ. 25. Is that a defect in the Barlow book?

A. Well, no, not if a person wants to handle it in that way. There is lots of Barlow books used to-day.

XQ. 26. In your judgment, is that a defect in the Barlow book?

A. Well, no, not in the Barlow book; it is not considered a defect.

XQ. 27. If it is not considered a defect in the Barlow book, why don't you go to the trouble to put these improvements in your book to hold the carbon in place?

A. Because I thought we had something better.

XQ. 28. Did you think the Barlow book was defective?

A. I thought I had made an improvement on the Barlow.

(Testimony of John Kitchen, Jr.)

XQ. 29. And your improvement consists, does it not, in holding the carbon in place in the book?

A. Holding it, no. It is removable. It is not held in there. It can be moved to any portion of the book.

XQ. 30. The carbon in the Barlow book is removable and can be transferred from between two sheets to another two sheets in the book, so that your book is not any different from the Barlow book in that particular, is it?

A. It is different in various respects, in that the carbon can be taken out and removed from one sheet to another, and it will not blow away.

XQ. 31. What you have said is true of both books, that the carbon may be removed from between two sheets in your book and replaced between two sheets, any other two sheets of your book, and always the carbon can be removed in the Barlow book in the same way, and replaced between any other two sheets of the book? A. Yes.

XQ. 32. Your book differs from the Barlow book just in the particular I have stated, that is, that the carbon is held in place firmly, so that it will not blow away?

A. No, it is held in place. I don't know what term you would use; but it is held in place temporarily. The carbon is removable, whereas in the Barlow book if you were to insert a leaf of the carbon in separately and leave the cover open the carbon would disappear.

XQ. 33. So that the only difference between your

(Testimony of John Kitchen, Jr.)

book and the Barlow book is that the carbon of your book is held firmly in place whereas in the Barlow book it is not held firmly in place?

A. No, my carbon is attached to the stub.

XQ. 34. Your carbon is attached to the stub simply in order that it may be held firmly in place?

A. Yes.

XQ. 35. Is that the only difference between your book and the Barlow book, that in yours it is held firmly in place and in the Barlow book it is not held firmly in place?

A. I will not say that it is held so firmly as not to be removable.

XQ. 36. You do not use the word "firmly" because you are apprehensive that such an expression as that would be considered as equivalent to using the word "bound." Is that correct?

A. No, it is not that, because anything that is—well, I don't know just how I could explain it. Anything that is held firm I would not judge would be removable. If it is held firm it would not be removable.

XQ. 37. Did you state, Mr. Kitchen, that you submitted to the Board of Supervisors or to the printing committee of the Board of Supervisors a sample constructed like Complainant's Exhibit "A"?

A. Yes, it was unprinted.

XQ. 38. Do you mean to say that in that sample that you submitted the carbon was attached to a piece of cardboard in the manner that it is attached in exhibit "A"?

(Testimony of John Kitchen, Jr.)

A. Yes, the same manner as that there, exactly.

XQ. 39. That was the form of book that you submitted on your original bid?

A. That is the one.

XQ. 40. You are certain that this sample that you first submitted to the city with your original bid, the carbon was attached to the piece of cardboard and was not simply a loose piece of carbon as found in the Barlow book?

A. No; I will further state that those samples went before the printing committee of the Board of Supervisors and were passed on.

Q. (By Mr. TOWNSEND.) Your answer, Mr. Kitchen, appears to say that you did not submit the samples.

A. I did submit the samples of the books, because the specifications called for samples to be submitted with the bid.

Q. Do you wish to have your previous answer corrected?

A. Yes, but I did not submit a looseleaf carbon. I submitted a book after that style.

Q. Referring to exhibit "A"?

A. Exhibit "A."

XQ. 41. (By Mr. WHITE.) Did you ever make any efforts to sell to the city manifolding books containing loose carbons?

A. No, I have sold to the city duplicating sets with loose carbons. I will correct that.

XQ. 42. Duplicating books?

A. Duplicating books with loose carbons.

(Testimony of John Kitchen, Jr.)

XQ. 43. But not triplicating books?

A. Not triplicating books, no.

XQ. 44. Do you know how the firm of A. Schilling & Co. used these Barlow books, whether with double carbons or two single semi-carbons?

A. They use them with double carbons, undoubtedly. I could not say for sure whether they do or not.

XQ. 45. Isn't it a fact that for years the Barlow book was used with two semi-carbons and not with one double carbon?

Mr. TOWNSEND.—We object to that as immaterial and not cross-examination.

A. I have used them with both.

XQ. 46. (By Mr. WHITE.) Why were two semi-carbons used in place of one double carbon?

A. I could not explain why they used them in that way. They were used, I think, more with the two semi-carbons after the patent was sold to Payot, Upham & Co.

XQ. 47. Do you know what the patent sold for?

A. For about \$20.

XQ. 48. For about \$20?

A. Yes, I think for about \$20.

Mr. WHITE.—That is all.

Mr. TOWNSEND.—That closes our case.

(Further hearing continued subject to notice.)

(Testimony of H. E. F. Williams.)

Thursday, May 20, 1909, 10 A. M.

Counsel appearing:

W. K. WHITE, Esq., of MILLER & WHITE,
Solicitors for Complainant.

C. E. TOWNSEND, Esq., Solicitor for Defendant.

Mr. TOWNSEND.—Mr. White and I have a stipulation whereby there will be introduced in evidence a specimen of the Levison shipping receipt-book built in accordance with this patent here in suit. Its introduction in our testimony was overlooked. I ask that it be marked for identification.

(Marked Defendant's Exhibit No. 14.)

**[Testimony of H. E. F. Williams, for Complainant
(in Rebuttal).]**

Examination-in-chief of H. E. F. WILLIAMS,
called for complainant in rebuttal, sworn.

(By Mr. WHITE.)

Q. 1. State your name, age, resident and occupation.

A. My name is H. E. F. Williams. My age is 53. My residence is 137 Devisadero street. My business is a binder and printer with the Levison Printing Co.

Q. 2. How long have you been connected with business of that character, Mr. Williams?

A. Fully 25 years.

Q. 3. You are now in the employ of the Levison Printing Co., are you not?

A. Yes, sir.

(Testimony of H. E. F. Williams.)

Q. 4. That company is engaged in selling triplicate shipping receipt books, is it not?

A. Yes.

Q. 5. Of the character embodied here in Defendant's Exhibit No. 14, which book has just been put in evidence?

A. The same as that.

Q. 6. You have recently made an investigation, have you not, of the business portion of this city and county to ascertain to what extent books of the character of exhibit No. 14 are used?

Mr. TOWNSEND.—We object to that as leading, not rebuttal testimony, and as irrelevant and immaterial to any issue in the case.

A. Yes.

Q. 7. (By Mr. WHITE.) Just state briefly the manner in which you made that investigation to ascertain the general use of the book of the character referred to.

Mr. TOWNSEND.—We object that no proper foundation has been laid for the question.

A. In the usual vocation of soliciting which I had regularly. I solicit the town for those books.

Q. 8. (By Mr. WHITE.) In making this investigation did you keep any track of the result of your investigation, and note the same down in written entries?

Mr. TOWNSEND.—We object to that as leading.

A. I did.

Q. 9. (By Mr. WHITE.) I hand you a statement, Mr. Williams, and ask you if the same discloses the result of your investigations along that line?

(Testimony of H. E. F. Williams.)

Mr. TOWNSEND.—We object to that as leading and on the ground that no proper foundation has been laid, and that it is wholly incompetent, irrelevant and immaterial, and not rebuttal testimony.

A. Yes, this is an exact copy.

Q. 10. (By Mr. WHITE.) Just state what these various sheets that I have handed you disclose.

Mr. TOWNSEND.—We make the same objection.

A. In order to be thorough I started on one street, say Pacific street, and I would go up one side and down the other. I would go into every house, irrespective of the fact whether I knew they used our book or not; and I continued on all the streets parallel with Market, down to Market, then I crossed over and went along every street parallel with Market, south of Market, and I stopped at every business house on the streets that run parallel with Market, down to 9th and 10th and Brannan; in fact, to the waterfront, Channel street, I think they call it, parallel with Brannan; then I took in all the Mission district; then I took a scattering list, wherever I could rake up any commercial houses on any of the streets, any houses of any kind or shape at all, and this is the result of my work. In addition to that I took all the streets from East street, Davis and Drumm and Front and Battery, clear up to Market, on the north of Market; then on the south of Market I took in East street and every street running up to East and covered every house that I could possibly find, that did any shipment or occupied any

(Testimony of H. E. F. Williams.)

position in the commercial world.

Mr. TOWNSEND.—I give notice of motion to strike out the answer as wholly irrelevant to any issue in the case. It is an attempt to prove the popularity and the general use of this book. And I would say that that matter was brought up directly by the complainant himself in his testimony in chief, and that it is in no wise proper rebuttal testimony on any ground.

Q. 11. (By Mr. WHITE.) On the first page of this statement, Mr. Williams, I find a list of the various business houses doing business in this city on Mission street. Do I understand that in making your investigation you started at the foot of Mission street on one side and went out and then went on the other side and went back to the foot of Mission street and inquired of each and every house doing a commercial business along that street, to ascertain what character of shipping-book was used by them?

Mr. TOWNSEND.—We object to that as leading, and on the same grounds as stated heretofore in the previous motion.

A. That was the method I followed, yes.

Q. 12. (By Mr. WHITE.) I find here at the top of column 1 the word "Peerless." Does that word refer to the book disclosed here in Defendant's Exhibit No. 14? A. It does.

Q. 13. The first name in this list I find to be Whittier, Coburn Co., and opposite such name the figure 1, under column 1, which is headed with the word "Peerless." Do I understand that from your

(Testimony of H. E. F. Williams.)

investigation that you found that the Whittier, Coburn Co. were using the Peerless book exclusively in their shipping department?

Mr. TOWNSEND.—We make the same objection; leading; it has no bearing on the issues of the case.

A. Yes, sir; that is the plan that was outlined in that memorandum.

Q. 14. (By Mr. WHITE.) I understand, then, that the figure 1 in the first column under the word “Peerless” at the head of such column and opposite the name Whittier, Coburn Co. means that that company uses a Peerless book exclusively in its shipping department. Is that correct?

Mr. TOWNSEND.—We make the same objection.

A. Yes.

Q. 15. (By Mr. WHITE.) At the head of column 2 in this statement I find the word “Machine.” What do you mean by such a word?

A. That there is a machine used for shipping purposes, and wherever I found it used I designated it by putting the figure 1 in the column under the caption “Machine.”

Q. 16. At the head of the 3d column I find the word “Duplex” used. Will you state what significance that has in this statement?

Mr. TOWNSEND.—We object to that as incompetent, irrelevant, and immaterial, and not rebuttal.

A. That is a heading to indicate wherever I found the Duplex book.

(Testimony of H. E. F. Williams.)

Q. 17. (By Mr. WHITE.) In other words, wherever you found a Duplex book used as a shipping-book you designated that fact in the third column of this statement?

Mr. TOWNSEND.—We object to that on the ground that no Duplex book is in issue.

A. Yes, I did. When I came across a Duplex book I gave credit for the book to that customer in that column.

Q. 18. (By Mr. WHITE.) What do you mean by the expression “Duplex Book”?

A. Well, that is generally used to designate what we call a full canvas-bound book for shipping receipt purposes. It is a short, small book, what we call “one on”; one receipt on a page, and bound with full canvas. Allow me to describe that book more fully—the Duplex.

Q. 19. Yes, describe the book which you refer to and designate as Duplex in the third column of this statement.

A. There were two yellow leaves and one leaf of parchment and used with a loose carbon.

Q. 20. I hand you a receipt-book and ask you if the same corresponds to your understanding and use of the word “Duplex” in this statement, and ask you whether or not such word “Duplex” is supposed to cover a book of the character which I have just handed you?

Mr. TOWNSEND.—We object to that because the book referred to is not shown or alleged to be either the book of complainant or defendant, and

(Testimony of H. E. F. Williams.)

any question pertaining thereto and any answer in response to such question can have no possible bearing on this case.

A. Yes, this is the style of book which I have there designated as the Duplex, to distinguish it from the others.

Mr. WHITE.—I ask that this book be marked with the letter “G” for purposes of identification. I will hereafter offer it in evidence.

Mr. TOWNSEND.—The introduction of exhibit “G” for identification is objected to as having no bearing on the case, and as irrelevant and immaterial.

(Marked Complainant’s Exhibit “G” for Identification.)

Q. 21. (By Mr. WHITE.) I hand you another book, Mr. Williams, and ask you if such style of book is also included by you in the expression “Duplex” at the head of the third column of your statement?

A. Yes. I refer to the Duplex to distinguish it from the Levison.

Mr. WHITE.—I ask that this book be marked by the letter “K” for identification. I will hereafter introduce it in evidence.

Mr. TOWNSEND.—The same objection is made to this as was made to exhibit “G” for identification.

(Marked Complainant’s Exhibit “K” for identification.)

Q. 22. (By Mr. WHITE.) I hand you another

(Testimony of H. E. F. Williams.)

book, Mr. Williams, and ask you if such character of book is also included by you in the expression "Duplex" as used in your statement.

A. Yes.

Mr. WHITE.—I ask that that be marked with the letter "E" for purposes of identification.

Mr. TOWNSEND.—We make the same objection to this exhibit.

(Marked Complainant's Exhibit "E" for identification.)

Q. 23. (By Mr. WHITE.) I hand you another book, Mr. Williams, and ask you if such book was also included by you in the expression "Duplex" in your statement.

A. Yes, also that.

Mr. WHITE.—I ask that this book be marked with the letter "F" for purposes of identification.

Mr. TOWNSEND.—We make the same objection.

(Marked Complainant's Exhibit "F" for identification.)

Q. 24. (By Mr. WHITE.) As I understand you, Mr. Williams, in your investigation wherever you found a commercial house using any one of the books introduced here for purposes of identification you credited up such use in your statement by inserting therein, in column 3, under the expression "Duplex" the figure 1. Is that correct?

A. That is correct.

Q. 25. At the head of column 4 of your statement I find the words "Baker & Vater." I will ask you to state what significance such words have in your

(Testimony of H. E. F. Williams.)
statement, and to what they refer?

Mr. TOWNSEND.—The same objection is made as has been made previously to this line of questioning; and I would like to have it understood that my objection shall run to all questions in this line, on the grounds previously stated.

Mr. WHITE.—It is so understood.

A. That is a book that is made in the East, which they are selling out here. Wherever I found one I would credit it to that maker, Baker & Vater, under that column.

Q. 26. (By Mr. WHITE.) Will you describe such book that you characterize in that statement by such words as Baker & Vater?

A. Well, it is a shipping receipt-book, and it is bound with two receipts on a page, side by side, and they use a loose carbon paper. The chief benefit I find from that, is that they could put two receipts on a sheet, of different people, different houses.

Q. 27. On the first page of this statement I find the total under column 1, which is headed by the word "Peerless" as 61. Under column 2 I find "7" and under column 3 the total is 4. Do I understand that in your investigation in regard to the use of the various books by the firms named on this first page of this statement, you found that 61 of said firms used the Peerless book, that 7 of said firms used the Machine and that 4 of said firms used a style of book characterized by you as the Duplex?

Mr. TOWNSEND.—We object to that as grossly leading and immaterial.

(Testimony of H. E. F. Williams.)

A. Yes, that is correct.

Q. 28. (By Mr. WHITE.) So that you found, so far as the first page of this statement is concerned, that out of the 72 houses that you visited that 61 of said houses used the Peerless book which is the book, as I understand it, covered by the patent in suit?

A. Yes.

Q. 29. And that 7 of those houses used the Machine and 4 of those houses used the Duplex book? Is that correct? A. That is correct.

Q. 30. Are the various subsequent pages of this statement gotten up in the same way and do they have the same significance as the first page thereof?

A. Yes, exactly, in the same manner.

Q. 31. On the last page of your statement I find under the heading "Recapitulations" a statement "Peerless (exclusive) 547." By that expression do you mean to say that out of all the commercial houses you visited you found that 547 of the same used the Peerless book exclusive of any other style of book?

Mr. TOWNSEND.—We object to that as leading, irrelevant and immaterial; not rebuttal. No proper foundation laid.

A. Yes, that is correct.

Q. 32. (By Mr. WHITE.) The next statement I find to be "Peerless (combined) 33." What is the meaning of such statement?

Mr. TOWNSEND.—We make the same objection.

A. That is where they used other books in addition to using the Peerless; saying that they still used

(Testimony of H. E. F. Williams.)

the Peerless although they had the other book, some other style.

Q. 33. (By Mr. WHITE.) I find the next statement to be "Stationers selling Peerless, 19." What is the meaning of such statement?

A. That shows that there are 19 stationers that carry that book in stock, owing to the demand.

Q. 34. I find the next statement to be "Total Peerless 599." What do you mean by that statement?

Mr. TOWNSEND.—We make the same objection, as not rebuttal; no foundation laid.

A. That is to show the total number of Peerless used in connection with the whole amount canvassed.

Q. 35. (By Mr. WHITE.) The next statement I find to be "Machine (exclusive) 21." What do you mean by such statement?

A. Out of that amount that there were 21 Machines used.

Q. 36. As I understand it, then, out of all the commercial houses that you visited in making this investigation you found that 21 of those houses used the Machine exclusive to other means of making their receipts? A. Yes.

Q. 37. I find the next statement to be "Machines (combined) with Peerless, 23." What do you mean by such statement?

A. That that amount of houses using the Machine also used the Peerless in addition to the Machine.

(Testimony of H. E. F. Williams.)

Q. 38. The next statement I find to be "Total 44 Machines." What do you mean by that statement?

A. That I only found 44 Machines in use in that canvass.

Q. 39. And among the houses using those 44 Machines, as I understand it, you found 23 of them using the Peerless also?

A. In connection with it, yes, sir.

Q. 40. The next statement I find to be "Duplex (exclusive) 50." What do you mean by that statement?

A. In that canvass of this 600-odd I found that number only of Duplex.

Q. 41. As I understand it then, out of the 600 and more houses that you visited in making this canvass you found only 50 of such houses using the Duplex book?

A. That is correct.

Q. 42. I find the next statement to be "Duplex combined with Peerless, 6." What do you mean by that statement?

A. That is houses using the Duplex that are also using the Peerless.

Q. 43. The next statement appears to be "Total, 56 Duplex." What do you mean by that?

A. Out of 600-odd there was only that number of Duplex exclusive.

Q. 44. I find the next statement to be "Baker Varter exclusive, 10." What do you mean by that statement?

A. In that 600-odd there is only 10 Baker Varter.

Q. 45. The next statement I find to be "Baker

(Testimony of H. E. F. Williams.)

Varter combined with Peerless, 4.” What does that mean?

A. In that same canvass, parties using the Baker Varter and also using the Peerless.

Q. 46. I find the next item, “Total, 14. Baker Varter.” Am I to understand by that, that out of the 600 or more commercial houses visited by you, only 14 used the Baker Varter book?

A. That is correct.

Q. 47. I find the next statement to be “McNutt, Kahn, 3.” What do you mean by that statement?

A. That is a shipping-book got up by McNutt and Kahn. I only found 3 in that 600-odd.

Q. 48. Just describe such character of book.

A. It is got up like a pad, with single sheets, using loose carbon; single sheets all gathered together using loose carbon.

Q. 49. I find in the first column of each page of this statement names which appear to be the names of the streets in this city. Am I to understand that the firm names appearing opposite such names appearing in the first column, do business on such respective streets?

A. Yes, that is correct, outside of any typographical error.

Mr. WHITE.—I offer this statement in evidence and ask that it be marked Complainant’s Exhibit “C.”

Mr. TOWNSEND.—We object to the offering in evidence of exhibit “C” on the ground that it is incompetent, irrelevant and immaterial; has no proper

(Testimony of H. E. F. Williams.)

place in rebuttal; it is not shown that this witness prepared it; and I shall move on the final hearing to have all the testimony relating to this matter of the use of these books or any of the books shown by exhibit "C" to be struck out for the reasons hereinbefore previously stated.

Q. 50. (By Mr. WHITE.) Does this statement which has just been offered in evidence correctly disclose the results of your investigation?

A. Yes, it does, correctly. I proof-read them after they came from the stenographer every day.

Mr. TOWNSEND.—This exhibit "C" is further objected to as being secondary evidence.

Q. 41. (By Mr. WHITE.) After visiting these various houses, Mr. Williams, did you keep any memorandum of the results of your investigation?

A. I wrote the name down as soon as I received word, immediately, while entering the house. If they told me they used the Peerless or the Duplex I wrote it down on a list that I kept in my hand as I went along.

Q. 52. And which statement correctly represents the various memoranda and data collected by you in that manner?

A. And turned in every evening to the stenographer, and that I would re-read the proof in the morning to see that she got it correct.

Q. 53. Did the portion of the City and County of San Francisco covered by you in your investigation include the different principal commercial business houses here?

(Testimony of H. E. F. Williams.)

A. It included all of them.

Mr. WHITE.—Take the witness.

Mr. TOWNSEND.—I move that the testimony of this witness be stricken out for the reasons previously hereinbefore stated, and the motion shall be renewed on the final hearing. Without waiving any of these objections, I will ask the witness a few questions.

Cross-examination.

(By Mr. TOWNSEND.)

XQ. 1. I will ask you, Mr. Williams, if you made this canvass quite recently or not?

A. Quite recently; since we last met here.

XQ. 2. As a matter of fact, Mr. Williams, do not these 600 names that you have here practically represent your own customers in this town?

Mr. WHITE.—Necessarily they do, because it appears by this statement that out of the 600 about 550 used the Peerless, manufactured by the Levison Printing Co.

A. That is the answer I was about to make myself.

Mr. TOWNSEND.—The testimony of counsel is objected to.

XQ. 3. Only 600 firms in this city are using shipping receipts?

A. A great many more appear on that list.

XQ. 4. Do you know how many firms there are in this city using shipping receipts?

A. I do not.

XQ. 5. Don't you know, as a matter of fact, that

(Testimony of H. E. F. Williams.)

there are about 5,000 firms in this city?

A. I do not.

XQ. 6. Do you know how many firms you have omitted from this list that are using shipping receipts?

A. I do not. I might say that if there was one firm in town using shipping receipts I would have made it my business to hunt them up very quickly. I could not find any.

XQ. 7. On these pages of your exhibit "C," where I see the names "Mission street," etc., enclosed between arrows, does that represent the business houses of that street?

A. That represents all the large houses of that street that used shipping receipts. I found that a great many of them shipped by Wells, Fargo and a great many of them by expressmen who stood on the corners, carrying a small book; and a great many bought from Eastern houses who shipped direct from the East, and only took orders here.

XQ. 8. Taking Mission street, for example, the divisions of these pages between the streets show the houses that you interviewed on that street?

A. That is right.

XQ. 9. This you have sworn, Mr. Williams, to be a correct statement of the principal houses on these streets using shipping receipts?

A. Everyone that I could possibly find from a house to house canvass.

XQ. 10. On Battery street, I notice you have got some 17 names on pages 4 and 5, by count. That

(Testimony of H. E. F. Williams.)

represents all the business houses on Battery street?

A. That represents all the business houses on that street using shipping receipts that I could find.

XQ. 11. I don't find the name of Zellerbach & Co., paper people.

A. I think they are on our list. I think they use our book.

XQ. 12. You stated that this was a correct statement of the business houses on Battery street, and Zellerbach's name is not on this list.

A. I guess she left that off, because the name went in. I think you will find it.

Mr. TOWNSEND.—I object to the answer as not responsive to the question and move to strike it out.

The WITNESS.—Let me find it. It may be possibly a continuation. You will find in several places where a street is continued on another page.

XQ. 13. Yes. But I am referring to two pages, where Battery street seems to appear on two pages, and Zellerbach's name is not on either of those two pages.

A. They use our receipt-book.

XQ. 14. That is a big house, is it not?

A. That is a big house.

XQ. 15. The biggest paper house in the city?

A. It ranks about that way.

XQ. 16. One of the biggest mercantile firms?

A. Yes.

XQ. 17. Anyone making a list of merchants of this city and mercantile houses would be pretty sure to include Zellerbach's, wouldn't he?

Mr. WHITE.—I refer counsel to the next to the

(Testimony of H. E. F. Williams.)

last page, where he will find Zellerbach's name.

XQ. 18. (By Mr. TOWNSEND.) Also in the Battery street list I notice the omission of the American Biscuit Co. A. Yes.

XQ. 19. Is that an important house?

A. I think you will find them on the list, as a machine user. They use our machine, our Peerless.

XQ. 20. I don't see them on the list. I object to the answer as not responsive to the question and move that it be struck out. I will show that it does not appear on the Battery street list as given.

A. Well, unless it is a typographical error, as I stated; I stated that there might be typographical errors.

XQ. 21. I don't find the name of the Pacific Coast Biscuit Co., which is also on Battery street. I don't find that name on the list.

A. The Pacific Coast? Well, as I say, unless she has left it off the list. The house was visited. They use our machine.

XQ. 22. This list may be incorrect, then?

A. No, the list is correct, as you find it.

XQ. 23. The list is correct?

A. The list is correct as it speaks for itself, in every particular. It is most emphatically correct.

XQ. 24. I don't find any mention there of business houses on Minna street or Tehama street.

A. I would not look there for business houses.

XQ. 25. There are no business houses on Minna street using shipping receipts?

A. I have some of them. If you could give me

(Testimony of H. E. F. Williams.)

the names of those, I could tell you what books they are using.

XQ. 26. How about Jessie street?

A. I have them also there.

XQ. 27. I am talking about the list there. You said that you had a list there of 600 names which are all the main business houses in the city of San Francisco.

Mr. WHITE.—We object to that as a misstatement of the witness' testimony. The witness simply stated that this included all the business houses of the street. His list does not include all the business houses of San Francisco, and was not intended to.

Mr. TOWNSEND.—Then counsel admits that a great many business houses have been omitted?

Mr. WHITE.—The statement speaks for itself.

The WITNESS.—Yes. I went over away to Folsom and I put every one down that used shipping receipts. But, for instance, if a firm fronted on Mission street and their store ran back to another street—say, for instance, Clementina or some little back street—I would put them down on Mission street and would not put them down on the other streets; for instance, Sloane & Co., they run through.

XQ. 28. (By Mr. TOWNSEND.) We will admit that if a business house faces on Mission street and runs through to another street it should only be counted on Mission street; that is all right. But, as a matter of fact, are there not a great many houses that do not have a double frontage, but are on either

(Testimony of H. E. F. Williams.)

Clementina or Tehama or Minna or Jessie or Stevenson?

A. In all those houses you will find them under the head of "Scattering." All the streets are not mentioned there, all the small streets. A number are under the head of "Scattering."

XQ. 29. Do all the business houses use shipping receipts in San Francisco in all of the streets you have mentioned?

A. Those not on the main streets will be found on the "Scattering" list—all big houses of any note.

XQ. 30. Then I notice that there are no North Beach business houses. Do they not use shipping receipts there?

A. I have them under the head "Scattering." I have a great many of them. You will find them on the list. I could tell you if you mention their names.

XQ. 31. How about the Potrero?

A. I have them also down there. They most likely would come under the head of the Mission district, or the Southern district; George Tay & Co., and Carter-Burger and the Pacific Rolling Mills, they all appear there.

XQ. 32. There are big firms using shipping receipts in the North Beach and Potrero and the outlying districts and the side streets, and they are classified under the head of "Scattering," are they?

A. "Scattering," or "Adjacent districts," as soon as I made them up. Of course I could not survey the city. It is a difficult thing to get around when

(Testimony of H. E. F. Williams.)

you go out to those swamps.

XQ. 33. Then this list is incorrect, is it not?

A. No, it is not incorrect. They are all there, though they may not be all there under the heading of the streets. They are under the head of "Scattering" and under the head of different districts, the Mission district, for instance. Furthermore, those streets are put down there as a general guide to the attorneys in the case, or anyone having reference to the sheets.

XQ. 34. I find the name of Murphy, Grant & Co. appearing on the Sansome street list, on page 4. I also find the name of Murphy, Grant & Co. listed under the name "Scattering," on page 9. Will you explain whether that entry is the same one, the same people or not—the same persons?

A. It is a correct entry, though evidently the stenographer got it in twice there.

XQ. 35. One of these names has been duplicated.

A. Among the 600 maybe one or two has been duplicated.

XQ. 36. Just look, please.

A. I will take your word for it, if you say so. It is liable to be.

XQ. 37. I find Murphy, Grant & Co. double-listed in this 600. Is that not a fact?

Mr. WHITE.—The witness has already admitted that. Do you want him to admit it two or three times?

Mr. TOWNSEND.—I repeat my previous motion, that this exhibit "C" be suppressed, as being, first,

(Testimony of H. E. F. Williams.)

improper under the grounds previously stated; second, that it is a false list in that it does not contain a fair or anywhere near a complete list of the business houses in this city employing shipping receipts, and that it in one instance, at least, has a name duplicated.

Mr. WHITE.—Intentionally, I presume, for the purpose of deceiving and imposing on the Court. Is that your position, Mr. Townsend?

Mr. TOWNSEND.—Counsel is not compelled to fix the blame for the error. The effect of the exhibit is to be seen by the Court.

Redirect Examination.

(By Mr. WHITE.)

RDQ. 1. As I understand, the word “Peerless” in this statement comprises a book similar to exhibit 14.

Mr. TOWNSEND.—We object to that as not redirect examination.

The WITNESS.—Yes, it does.

RDQ. 2. (By Mr. WHITE.) In making this investigation I understand you canvassed houses along certain streets. Am I to understand that this statement is supposed to cover and include all the business houses in San Francisco wherever they may be located, whether out in the Richmond district or the Potrero district or along the Barbary Coast, or in any other locality of the city other than those streets stated in the statement?

A. We have some under the head of “Scattering,” which would take the outlying houses, differ-

(Testimony of H. E. F. Williams.)

ent locations, where there would not be enough to make a list of it; there would not be enough to make it worth while to make a list of it. There might be a street where there were one or two houses on it.

RDQ. 3. This list, however, does not pretend to include every business house in San Francisco which uses a shipping receipt-book, does it?

A. No, it is supposed to be all the principal houses in the commercial districts, all the principal business houses in the commercial district.

Recross-examination.

(By Mr. TOWNSEND.)

RXQ. 1. Do you consider the classified columns of the ordinary city directory a fair index and a reasonable and proper list of business houses in the city?

Mr. WHITE.—We object to that as not proper recross-examination.

A. As houses doing any shipping at all, I would not, by any means, from my experience in that canvass. I was surprised by my experience. I could state, if you wish, the different conditions under which houses ship, which appear as commercial shipping houses.

RXQ. 2. (By Mr. TOWNSEND.) In other words, if the city directory classified list showed any considerable number of business houses in this city in excess of the number given in your list, you would consider that classified list wrong?

A. For instance, a great many only do a local business. They don't do any shipping. A great

(Testimony of H. E. F. Williams.)

many ship through Wells-Fargo and by expressmen on the corner. A great many borrow shipping receipts from neighbors. A great many ship by draymen, McNab & Smith, and Rode & Co., and such teaming concerns supply the shipping receipts.

RXQ. 3. Then, there are 5,000 business houses other than the 600 you have mentioned, that use shipping receipts that are furnished by those teamsters, and out of that 5,000 you don't know how many use the Peerless machine?

A. McNab & Smith and Rode and all those teamsters which appear in that list there use our shipping receipts. Any of those 5,000 houses that would be shipping continuously and using receipts furnished by those teamsters would be using our shipping receipts, and any of those that are shipping by Wells-Fargo's use our shipping receipts.

RXQ. 4. As a matter of fact, lots of these teamsters get a book from the railroad companies, a book furnished by the railroad companies, do they not?

A. Well, I could say that those 5,000 that you speak of, if they get shipping receipts from the railroad companies they would appear on that list.

RXQ. 5. A great many more houses than the 600 you have mentioned in your list do shipping and use shipping receipts, do they not?

A. Of course, I don't guarantee this list.

RXQ. 6. A great many teamsters who do shipping are not on your list, are they—a great many teamsters who furnish receipts to houses who do shipping through them?

(Testimony of H. E. F. Williams.)

A. None that do any great amount of business. All the teamsters that do a large amount of business use our shipping receipts; the Morton Delivery Co. and the Union Transfer and the Overland Transfer—all big teaming concerns and companies use our Peerless receipts. Those names are on this list. McNab & Smith's name appears there, and they furnish a large number of shippers. They all use our shipping receipts.

Redirect Examination.

(By Mr. WHITE.)

RDQ. 1. You spoke about "our shipping receipts." What are you referring to?

A. I am referring to the Peerless when I speak of our shipping receipts.

RDQ. 2. Exhibit No. 14?

A. Exhibit No. 14.

RDQ. 3. If you found a commercial house which was not using any receipt-book at all, would you include the name of that house in this statement?

A. I would not put them down in that list. If they told me "McNab does my teaming" I would not put them on my list, as it would appear under the name McNab, and they are using our book, exhibit 14.

RDQ. So you inserted the name of McNab & Smith and other large draying companies who are using the Peerless book, in this list, the book which is covered by the patent sued on, and you mean to say that the use of them includes the use by the various customers that have their shipping done by

(Testimony of H. E. F. Williams.)

those large draying firms.

A. Yes. I only put down the names of the draying firms. I didn't put down the names of the houses that did the shipping through those draying firms.

RDQ. 5. McNab & Smith are using the Peerless book, and they furnish it to those various customers, then, do they not?

A. Yes, and the names of those customers do not appear on that list as users.

RDQ. 6. So that when you have included the name of McNab & Smith and of other large draying concerns in this statement as being users of the Peerless book, those names, as a matter of fact, include necessarily the various customers who patronize them, as users of such books, does it not?

Mr. TOWNSEND.—We object to that as leading, and not redirect examination, and as a contradiction in fact of the exhibit "C," and of this witness' previous testimony where he stated that he had listed all the business houses in this city using shipping receipts and have credited them accordingly as to the nature of the shipping receipts which they use.

Mr. WHITE.—The witness has made no such statement. He simply stated that he covered certain districts.

RDQ. 7. Is your testimony in regard to McNab & Smith correct when applied to various other concerns doing a drayage business in this city?

Mr. TOWNSEND.—We make the same objection.

A. Yes, sir. Also Farnsworth & Ruggles and

(Testimony of H. E. F. Williams.)

the Western Transfer Co., all under the same conditions as McNab & Smith, using the Peerless, exhibit 14.

RDQ. 8. As I understand it, then, these various houses who ship through those drayage firms are all furnished with receipts by such firms. Is that correct? A. Yes; that is correct.

Mr. WHITE.—That is all.

[Testimony of Harry Levison, for Complainant (in Rebuttal).]

Examination-in-chief of HARRY LEVISON, called for complainant in rebuttal; sworn.

(By Mr. WHITE.)

Q. 1. State your name, age, residence and occupation.

A. Harry Levison; age 31; I reside at 1570 Grove; with the Levison Printing Co.

Q. 2. Your company has been engaged for some time in the manufacture and sale of shipping receipt-books, has it not? A. It has.

Q. 3. How long have you been connected with such company? A. Since about 1895.

Q. 4. During that period have you become familiar with the various types and styles of shipping receipt-books which have been put on the market in this city and county? A. I have.

Q. 5. I desire you to briefly give the history of these various shipping books that have been put on the market and trace the evolution in the art up to the present time; and in doing so I will first refer to

(Testimony of Harry Levison.)

the shipping receipt-book which I now hand you, and ask you to state what character of book the same is, and how it is used.

A. This is a book that was used at the time and prior to the time I went into the printing business. It has three receipts printed alongside one another, on one sheet of paper, and the various sheets bound in book form. The manner of using this book was by writing the receipt three different times. It is a book that I would consider to be the first book used for shipping receipts and the most crude book of all.

Q. 6. As I understand you, in the use of this book no carbon is used?

A. No carbon at all. The receipts are written three times.

Q. 7. So that instead of making one entry in this book it was necessary to make three entries in order to get your three receipts. Is that correct?

A. It is.

Mr. WHITE.—I offer that book in evidence and ask that it be marked Complainant's Exhibit "D."

(So marked.)

Q. 8. In continuing your description of the development of this particular art I now refer you to another book and ask you to describe what the same is and how it is used.

A. This book has the receipts printed on three different kinds of paper, that is to say, there is one receipt on a yellow sheet, one on a pink or other colored sheet, and one on a white sheet. This book was used by using two pieces of carbon, placing one

(Testimony of Harry Levison.)

between the first and second sheet and one between the second and third sheet. In writing upon the original you obtained your copy on the other two. The carbons were loose carbons.

Mr. WHITE.—I offer this book in evidence and ask that it be marked Complainant's Exhibit "E."

Mr. TOWNSEND.—We make the same objection. (Marked Complainant's Exhibit "E.")

Mr. TOWNSEND.—We make the same objection as offered to this book when offered in evidence as previously stated when offered for identification, as having no bearing on the present issues, unless it is offered as showing the prior state of the art.

Q. 9. (By Mr. WHITE.) I ask you to compare Complainant's Exhibit "E" with Defendant's Exhibit No. 14, and ask you to state what advantages or disadvantages arise in the use of such exhibit "E" as compared with such other exhibits?

Mr. TOWNSEND.—We object to that as incompetent, irrelevant, and immaterial; not rebuttal, not based on any exhibit offered by the defense, and having no bearing on the question here at issue.

A. This book here, exhibit "E," was made ostensibly for the purpose of making it easier to get your three copies, writing at once and obtaining the copies through carbon which was evidently not done before. You saved the re-writing of the sheets, as was necessary in the other book. In comparing this with the book Defendant's Exhibit 14, the difference is that in exhibit 14 the copies are printed on one sheet instead of on three sheets, as it is in ex-

(Testimony of Harry Levison.)

hibit "E," and that the carbons are bound to the book instead of loose carbons as they are in exhibit "E." In using Defendant's Exhibit 14 it is not necessary to handle the carbon, where in using exhibit "E" it is necessary to handle two pieces of loose carbon.

Q. 10. (By Mr. WHITE.) State whether or not in the use of these books it is objectionable to be compelled to handle loose carbons?

A. In using a loose carbon the carbon is very often misplaced, that is, placed between the wrong sheets or in an improper place for use. Sometimes they are not placed in the books straight. Very often the carbon is used more than the carbon is made for; that is to say, where the carbon is probably manufactured to take 40 or 50 copies in the course of business, one may use this for 75 or 100 copies, and thereby obtain indistinct copies. Besides that, it is smutty and dirty in handling.

Q. 11. Are books of the style disclosed here in exhibit "E" on the market—or were they on the market at the time that you first became connected with the printing business? A. They were.

Q. 12. Now, continuing your answer regarding the development of this art I will refer you to a book marked exhibit "F" for purposes of identification, and ask you to make the same comparison between such book and exhibit 14, covered by the patent in suit.

Mr. TOWNSEND.—We make the same objection as previously made.

(Testimony of Harry Levison.)

A. This book is similar to the book of exhibit "E," with the exception that in order to make it easier to handle the two pieces of loose carbon, the corners of the original and duplicate were clipped, the duplicate extending a little further than the original and the triplicate extending to the full corner. In that way it was easier to distinguish the original from the duplicate and the duplicate from the triplicate, thereby placing the carbon in its proper position. This book is also like exhibit "E," used with loose carbons, and necessarily using 2 pieces of loose carbon, which is a disadvantage, and in Defendant's Exhibit 14 the book is used with a carbon attached.

Q. 13. (By Mr. WHITE.) Was this book which has been marked "F" for purposes of identification in use at the time that you became connected with the printing business?

A. Yes, this book was in use at that time, and judging by the fact that this was gotten up for the purpose of making the handling of the carbon easier, I imagine that it came into use after the book marked exhibit "E."

Q. 14. In other words, this last-mentioned book marked "F" has some advantages over the other book marked "E," and for that reason you judge that in the development of the art it came after such book "E," as it was a step forward and not backward; is that correct? A. I do.

Mr. WHITE.—We offer this book in evidence and ask that it be marked Complainant's Exhibit "F."

(Testimony of Harry Levison.)

Mr. TOWNSEND.—We object to the introduction of exhibit “F” in evidence, on the same grounds as stated to the introduction of exhibit “E.”

(Marked Complainant’s Exhibit “F.”)

Q. 15. (By Mr. WHITE.) In continuing your answer, now referring to the book marked “G” for purposes of identification, I ask you to make the same comparison between that book and the previous exhibits and Defendant’s Exhibit 14.

Mr. TOWNSEND.—We make the same objection to the comparison, as was previously made.

A. This book is made by a sheet of yellow paper followed by a sheet of thin, transparent paper and then a sheet of pink paper. The idea of using the transparent paper was to do away with the use of two pieces of carbon, as in the previous books, and by using a piece of two-faced carbon and placing it below, with a thin transparent sheet, a carbon impress was obtained on the pink or duplicate sheet and also on the reverse side of the transparent sheet. The sheet being transparent, permitted it to be seen on the carbon side, *and thereby obtaining the carbon side*, and thereby obtaining the carbon impress with one impression and using but one piece of carbon. It is necessary to use a loose carbon, two-faced, where, in Defendant’s Exhibit 14, the carbon is bound to the book and does away with the handling of the carbon, as is necessary in this exhibit “G” for identification.

Q. 16. (By Mr. WHITE.) In your opinion, did the book you have just referred to, marked “G” for

(Testimony of Harry Levison.)

purposes of identification" follow the preceding exhibits in the logical development and progress of this art?

A. I should so imagine, inasmuch as in the previous books it was necessary to handle two pieces of loose carbon, and in this book they do away with the handling of one piece of carbon, and handle but one piece of loose carbon.

Q. 17. As I understand it, then, in such a receipt it is objectionable to be compelled to use loose carbon in these books, and handle the same, and this book necessarily therefore is an improvement on the preceding book, because in the use of the same you are only compelled to handle one piece of carbon in place of two pieces of carbon found in these prior books. Is that correct?

Mr. TOWNSEND.—We object to that as leading, and also for the reasons previously given.

A. It is.

Mr. WHITE.—I offer this book in evidence and ask that it be marked Complainant's Exhibit "G."

Mr. TOWNSEND.—We make the same objection to its offer as was made to the offer of the two previous exhibits.

(Marked Complainant's Exhibit "G.")

Q. 18. (By Mr. WHITE.) I will hand you a book and ask you to state whether or not the same was made under your instructions in accordance with the book disclosed in the Barlow patent, Defendant's Exhibit 1. A. It was.

Q. 19. As I understand it then, this book which

(Testimony of Harry Levison.)

I have just handed you correctly represents and embodies the book disclosed in Defendant's Exhibit No. 1, the Barlow patent? A. It does.

Mr. WHITE.—I offer this book in evidence, and ask that it be marked Complainant's Exhibit "H."

(So marked.)

Q. 20. And I will ask you to examine the book just handed you and marked Complainant's Exhibit "H" and describe it and compare it with Defendant's Exhibit 14, being the book covered by the patent in suit.

A. This book is made with the three receipts printed on one sheet in the manner described by the Barlow patents, and as he describes it and as the book was to be used by loose carbon, by the folding of the sheets with the loose carbon, this book permits you to make 3 copies with the one writing. It had the advantage, or was supposed to have the advantage, over the prior books, inasmuch as they were handling but one sheet of carbon, it was not necessary to have the separate sheets. There were considerable differences in opinion as to the advantages, at that time, but that was what was aimed at. The users of this book, to my knowledge, would use it with two pieces of carbon, two pieces of loose carbon, instead of one piece of carbon, as the Barlow patent called for, because they found it easier to use this book with 2 pieces of loose semi-carbon rather than with one piece of full carbon, as he has described. The advantage in this book in Defendant's Exhibit 14 is a large advantage over this book

(Testimony of Harry Levison.)

Complainant's Exhibit "H," inasmuch as the piece of carbon is bound to the book, and it is unnecessary to look for or to find the place to put the piece of carbon in its proper place. This book, exhibit "H," requires the use of loose carbon, where in Defendant's Exhibit 14, the carbon is always in place for writing, and the carbon is bound to the book.

Q. 21. In the manufacture of the Barlow book is it possible to predetermine the life of the carbon? Or in other words, to predetermine the use to which the loose carbon shall be put?

Mr. TOWNSEND.—We object to that as immaterial.

A. One can predetermine the life of the carbon, but in the using of this Barlow book the user, as a rule, pays very little attention to the life of the carbon, using it until it is about worn out, whereas, in the manufacture of Defendant's Exhibit 14 the life of the carbon is predetermined, and the carbon being bound in its proper place, you will always have a fresh carbon.

Q. 22. (By Mr. WHITE.) As I understand it then, in the use of the book of the type disclosed in Defendant's Exhibit 14, it is not the judgment of the user that determines the life of the carbon, but the judgment of the maker of the book. Is that correct? A. It is.

Q. 23. In connection with Complainant's Exhibit "H" what have you to say in regards to that same proposition?

A. The life of the carbon is not determined by

(Testimony of Harry Levison.)

the manufacturer or maker, but by the user; and he very often uses a carbon longer than the life of the carbon will permit, and by doing so he obtains an indistinct copy. In many cases the fact that there is a carbon in the book, and one being in a hurry to make out receipts is apt to use this carbon or to try to use this carbon throughout the entire book, where the life of the carbon is not made for that purpose. When we first made this book I had in this book two pieces of this semi-carbon. I find but one here now. It has probably been lost by carrying. That was done to show the manner in which the book was being used, instead of the manner in which the use of the book is called for in the patent. There is but one in the book now; there ought to be two.

Q. 24. In continuing your answer to the original question regarding the development and growth and progress of this art, I now refer you to another receipt-book and ask you to describe the same, and make the same comparison between it and the Defendant's Exhibit 14.

A. This book, according to the statement of the paper on the back, was made after the Barlow patent. It shows that the effort was to use the Barlow book with one piece of full carbon and that that was unhandy and awkward, and that it was found to be impracticable; that is, that it was considered so by some people, and in the effort to get the copies, the 3 copies, more readily, they made a book which consisted of one piece of thin, transparent paper extending along the width of it and a second sheet of

(Testimony of Harry Levison.)

yellow paper. A piece of loose carbon was placed below the piece of thin, transparent paper, and the outer half of the yellow sheet was folded over the transparent sheet. By writing upon that outer half you obtained a carbon copy on the inner half of the yellow sheet and also upon the transparent sheet. This book was gotten up with the idea of handling one piece of carbon and being able to place it more readily than in the previous book. But this has the same objection as other books; inasmuch as you are handling a loose piece of carbon, that carbon is very often used longer than it was supposed to be used, where, in Defendant's Exhibit 14, the carbon is attached to the book and the life is predetermined by the manufacturer instead of by the user, as in this book.

Mr. TOWNSEND.—We move that that portion of the answer to the last question referring to the intention or object of the patentee of the book under discussion be stricken out, because it shows that this patent was obtained long before the witness was connected with this business, before he was old enough to know anything about it, and is merely his conclusions as to the objections to the Barlow book; and the purposes and advantages of this are merely the mere guess of the witness.

Q. 25. (By Mr. WHITE.) Your answer, Mr. Levison, as I understand it, is based upon your present knowledge of this art, and not upon your knowledge of the art of the year 1890, when counsel says you were not old enough to appreciate the advan-

(Testimony of Harry Levison.)

tages or disadvantages of these various conditions. Is that correct?

Mr. TOWNSEND.—We object to that as leading and irrelevant.

A. I might say that it is based upon my knowledge of the art now, and also upon common sense.

Mr. WHITE.—We offer this book in evidence and ask that it be marked Complainant's Exhibit "I."

Mr. TOWNSEND.—As showing the state of the art there is no objection to the admission of this book.

(Marked Complainant's Exhibit "I.")

Q. 26. (By Mr. WHITE.) Continuing your answer to the original question, I will ask you now to refer to the book marked for identification "K," and you can make the same comparison with reference to Defendant's Exhibit 14 and these prior exhibits to which you have heretofore referred.

A. This being simply a sheet of yellow paper followed by a thin, transparent sheet and then by another sheet of paper. The first two sheets are made a trifle smaller than the third sheet. This book was used by a single piece of two-faced carbon. The reason for making the third sheet a little larger than the 2 first sheets, the 2 preceding sheets, was in order to be able to find the proper place for placing the loose piece of carbon; whereas in other books, it was apt to be misplaced or placed in the wrong set, or the wrong division. This book was evidently gotten up for the purpose of making it easier to handle the loose carbon, and with the idea of being able to make

(Testimony of Harry Levison.)

your 3 copies quicker than you could with any of the previous books. In Defendant's Exhibit 14 it does away with the handling of a loose carbon, as is necessary in this book. The life of the carbon in this exhibit "K" must be determined by the user, whereas in exhibit No. 14 the life of the carbon is predetermined by the manufacturer.

Q. 27. Can you state about what time this book marked "K" first came into the market?

A. This book came on the market a little prior to the time when I went into the business. I see the book is marked "Patented September 6, 1892," so that it must have come on the market after any of the previous books.

Mr. WHITE.—I offer the book in evidence and ask that it be marked Complainant's Exhibit "K." (So marked.)

Q. 28. What means did you say were embodied in this exhibit "K" for facilitating the handling of the carbon and inserting it in the correct place, between the proper leaves?

A. The first and second sheets were made a trifle smaller than the third sheet, the third sheet extending beyond the first and second sheets, which was easily distinguished and the proper place of placing the carbon was easily found.

Q. 29. The fact that this book does disclose such means indicates, does it not, that in prior books on the market difficulty was experienced in placing the carbon in the requisite place?

Mr. TOWNSEND.—We object to that as leading,

(Testimony of Harry Levison.)

irrelevant and immaterial.

A. So it would indicate. In fact, the thing strived at in all these books was to facilitate the handling of the carbons.

Q. 30. As I understand it, these various books had to be handled, the carbons had to be handled by reason of their not being attached to the book, but being loose. Is that correct? A. It is.

(At the hour of 12 M. recess was had until 2 P. M., when the examination of the witness was resumed as follows:)

Q. 31. In continuing your answer to the original question regarding the progress of this art, I will ask you to refer to a book I now hand you, and request that you state whether or not the same is constructed in accordance with the drawings and specification for the Bengough patent, Defendant's Exhibit No. 7.

Mr. TOWNSEND.—We object to that as leading; no foundation having been laid.

A. It is.

Mr. WHITE.—I offer this book in evidence and ask that it be marked Complainant's Exhibit "L."

(So marked.)

Q. 32. Please compare Complainant's Exhibit "L" with the Peerless book, Defendant's Exhibit No. 14 and the prior exhibit.

A. The thing aimed at in all the previous books was the purpose of getting a triplicate copy with the least amount of handling carbons. This particular book here is made up with 2 pieces of carbon bound

(Testimony of Harry Levison.)

in the center of the book or between a series of sheets that extend one-half the length of a series of sheets following. The long sheets are folded in the center and placed between the two pieces of carbon, and by writing upon the short sheet you obtain a carbon impression on the 2 other sheets. The book is worked from the center. After the impression is made you tear out the 2 sheets in the center of the book and leave the carbon in place for the writing on the other sheets. I have never seen this book on the market, no doubt because it was an awkward book to handle. The handling of the two carbons in the book appear to me to be even more awkward than handling loose carbons. In exhibit 14 there is one carbon attached to the book, where in this book here there are 2 pieces of carbon attached to the book. The fact that the carbon is bound in the center of the book and that you work from the center to the outside of the book makes it obvious that when you reach the outside edge, the sheets, through being such a thickness of stubs between the sheet that you write on and the sheet upon which the impression is to be taken, that the register is not perfect; and furthermore, the thickness of the stubs at the binding space makes a hollow surface upon which to write; therefore the writing would not be as clear; one is apt to punch a hole through the sheets with his pencil. The register is not likely to be perfect. And the fact of binding, confining these two pieces of carbon and separating them in order to place your sheets in proper position is just as awkward

(Testimony of Harry Levison.)

to handle as to place 2 pieces of loose carbon. In Defendant's Exhibit 14 of the Peerless book the carbon is always in the proper place and need not be handled. Another thing about this book is that there is just one set of carbons to bind in the book, and if the book is made of any particular thickness, why, the carbons are apt to be worn out before you reach the end of the book; where, in the book Defendant's Exhibit 14, the Peerless book, by interspersing the carbons you can make the book of any thickness you want. In this book it is impossible to get a good book and make the book as thick as it might be required.

Mr. TOWNSEND.—I move that the answer last given be struck out, as not relative to any question in issue, and also as in great part a mere guess of the witness; also that the claim has nothing whatever to say about a plurality of carbons in the plaintiff's patent, the claims all being based on a single series of a carbon and record sheet, and the comparison is wholly irrelevant and immaterial.

Q. 33. (By Mr. WHITE.) I hand you a book, Mr. Levison, and ask you to state whether or not the same is constructed in accordance with the specification and drawings of the Perry patent, Defendant's Exhibit No. 6. A. It is.

Mr. WHITE.—I offer this book in evidence, and ask that it be marked Complainant's Exhibit "M."

(So marked.)

Q. 34. Now, continuing your answer, I will ask you to describe the manner in which this book is con-

(Testimony of Harry Levison.)

structed and is used, and compare the same with Defendant's Exhibit No. 14 and the prior books put in evidence.

A. This particular book is also contrived with the idea of making the handling of carbon easier than the previous patents. While this patent—that is, the Perry patent—is not on the book, the patent is on the manner in which the sheets are printed, and it does not provide in the patent that the sheets be bound in any particular way. The patent merely calls for the transverse printing on the middle copy. In order to do this it is necessary to use a transparent sheet of paper or a very thin sheet of paper, which is not a practical sheet of paper to be used in the business world; and you use it by folding the middle section over the inner section and then reversing the fold and folding the outer section over the middle section. By placing one piece of carbon paper which is carbonized on both sides between the middle and inner section, you get your three copies with the one writing. As I said before, this here requires the use of thin paper, which cannot always be used in business. The carbon is loose and cannot be attached to the book owing to the fact that the third copy remains in the book, and it is impossible to bind or attach a piece of carbon to that book. To my knowledge I have never seen this book on the market, and probably for the reason that it can only be used with this thin paper. The defendant's Exhibit 14 can be used with any kind of paper of reasonable thickness, and therefore is adaptable to all

(Testimony of Harry Levison.)

business purposes. Defendant's Exhibit 14 provides for a book with the carbon held in place or attached to the book. This is with the loose carbon, but this merely shows an effort on the part of the inventor to provide some means of doing away with the handling of several sheets of carbon, but it has never been used to my knowledge.

Q. 35. In using a single loose sheet of carbon with this book just referred to, and folding the 3 sections of paper in the manner shown in this book, why is it necessary to have the paper so thin?

A. Because they use but one piece of carbon, and they place that between the second and third fold. The carbon impression is taken on the back of the second fold or middle sheet, and the impression must be seen through the sheet in order to be read properly and read on the right side of the sheet. The papers call merely for the printing, call for the taking of an impression of the printing on the back of the sheet so that it will be seen through on the front.

Q. 36. I hand you another book, Mr. Levison, and ask you to state whether or not such book is constructed in accordance with the Brown patent, Defendant's Exhibit No. 4.

A. This book is made in accordance with the design or the drawing shown in the patent. The Brown patent is on sheets having applied upon the printed back thereof a surface of non-drying, transferable ink, and this particular book is made in that way. The idea of the Brown book was to do away with the handling of the carbon, and for that reason

(Testimony of Harry Levison.)

he printed upon the back of the sheet a non-drying, transferable ink, which carried the impression of the writing upon the front of it, to the second or third sheet, or whichever sheet may be under it. This particular book is made in duplicate; but in making the Brown book they always made them in triplicate. This book was not taken very favorably, inasmuch as the back of the paper, being made of this non-drying ink, was smutty and dirty and filthy to everything that it came in contact with, and not only smutty and dirty, but it smutted and dirtied the book in which it was bound and also smutted and dirtied the papers or anything that might be lying about it, after it had been detached from the book.

Mr. TOWNSEND.—My objections are reserved until the book is offered in evidence.

Mr. WHITE.—We offer this book in evidence and ask that it be marked Complainant's Exhibit "N."

Mr. TOWNSEND.—We object to this exhibit "N," the so-called Brown book, because the testimony of the witness shows that it is not a correct representation of the Brown book shown in Defendant's Exhibit 4; that it is shown by a mere inspection of the book and a comparison of the Brown patent that the stop-card in the patent is omitted, and the defendant's testimony on this Brown book was directed to the stop-card D, and therefore all the evidence on this Brown book, Exhibit "N," is irrelevant and immaterial, and it is not rebuttal testimony; and I move that the exhibit be suppressed as wholly irrelevant and immaterial, and an impo-

(Testimony of Harry Levison.)

sition on the Court.

Mr. WHITE.—Where is the imposition that you insinuate is being practiced upon the Court, Mr. Townsend?

Mr. TOWNSEND.—I did not mean to say that counsel was in anywise responsible.

Mr. WHITE.—Has the witness stated that this book was made in accordance with the Brown patent? He has just stated that it was not.

Mr. TOWNSEND.—It is given as a book representing the Brown patent.

Mr. WHITE.—I know what I am putting it in as. I know my own intention. When the time comes I will state it to the Court.

Mr. TOWNSEND.—Furthermore, the witness' testimony has been directed as to what Brown's claims were, and that is wholly a legal question, and irrelevant and immaterial.

(Marked Complainant's Exhibit "N.")

Q. 37. (By Mr. WHITE.) As I understand you, Mr. Levison, the Brown book as disclosed here in Defendant's Exhibit 4 consists of a series of three leaves, the back, or the respective backs of the first two leaves of the series being carbonized or provided with this non-drying ink, so that anything written on the first sheet of the series is transferred by non-drying ink on the back of such first leaf to the face or upper surface of the second leaf, and then is again transferred to the third sheet of the series by the ink upon the back of the second sheet of the series? Is that correct?

(Testimony of Harry Levison.)

Mr. TOWNSEND.—We object to that as leading, irrelevant and immaterial, and not rebuttal.

A. That is the manner in which the book represented in the drawing of the Brown patents is made up.

Q. 38. (By Mr. WHITE.) The manner of preparing sheets in this Brown patent with this non-drying ink on the backs of the same is illustrated, is it not, in the book marked Complainant's Exhibit "N"? A. It is.

Q. 39. So that this feature of the Brown patent is correctly shown and illustrated in Complainant's Exhibit "N," is it not? And by that feature I have reference to the preparation of the back of the leaf for transferring any impression made on its surface to the sheet below? A. It is.

Q. 40. Did you ever see on the market a book constructed in accordance with the Exhibit "N"?

Mr. TOWNSEND.—We object to that as irrelevant and immaterial, exhibit "N" not representing any patent in the case. There was no claim ever made that it was on the market. I don't care whether it ever was or not.

Mr. WHITE.—We claim that it was in use once and has been practically discarded because it was impracticable, and has been superseded.

A. I have seen this book on the market, and especially so, prior to the fire of 1906, when there were a few on the market; but since that time, when most of the books were destroyed, we find very few of these in use anywhere. In fact, in our efforts to ob-

(Testimony of Harry Levison.)

tain one of these as a sample of the Brown book, in order to place it here as an exhibit, we could only obtain two samples, and that was after a very diligent search. We found but this duplicating book and one other triplicating book, but neither one of these two books are made in exact accordance with the design as shown in the patents, but they both of them show the manner in which the non-drying ink is applied upon the book. The fact that the book has not been used is shown by the fact that we had to make a very thorough and diligent search before we could find these two books.

Mr. TOWNSEND.—I move to strike that answer out for various reasons, and among others that the witness has previously said that this Brown book, exhibit “N,” is not made in accordance with the patent.

Q. 41. (By Mr. WHITE.) As I understand it, pursuant to the request of your counsel, for purposes of this case you endeavored to secure in town a copy of the book constructed in accordance with the Brown patent, Defendant’s Exhibit 4, and that notwithstanding the diligent search on your part, you were unable to find any such book. Is that correct?

A. That is correct.

Q. 42. And as I further understand the matter, as a result of such search you were able to find a book which has been introduced in evidence as Complainant’s Exhibit “N”? Is that correct?

A. That is correct.

Q. 43. You also referred to another Brown book

(Testimony of Harry Levison.)

which you secured by making this effort to find a book constructed in accordance with Defendant's Exhibit 4; and I now hand you a book and ask you if that is the book to which you have referred?

A. This is the book.

Q. 44. Please describe such book and the manner in which it is used.

A. This particular book is made with a series of sheets; first, a sheet of white paper which is followed by a sheet—first a sheet of white paper which is printed on the back with this non-drying, transferable ink, followed by a sheet of paper which is 3 times the size of this first sheet and which is printed on the inner sheet with the form that is to be used. In the middle it is printed with the non-drying, transferable ink on one side and on the other side with merely an advertisement of the Brown book, but it might be blank; and on the outer end is the printing of the form. In order to use this particular book it is necessary to take the two outer sheets of this, the two outer ends of this end sheet and fold them over the third sheet, making the first fold from the right to the left and the second fold from the left to the right, and writing upon the outer sheet. By having the non-drying ink on the back of the middle sheet and the 3d sheet, which always has this non-drying ink on the back of it, an impression is made through the four sheets of paper, and after this is done the outer 2 pieces of the long sheet are detached from the inner sheet. The middle section of the long sheet, which is composed of this non-

(Testimony of Harry Levison.)

drying, transferable ink, is detached from the outer section and thrown away. The third sheet is detached from the book as a receipt. It can readily be seen that in order to use this book, in addition to the objectionable feature of having a smutty, dirty sheet to work upon you must handle 4 pieces of paper, and that after having used it it is necessary to detach one piece of paper that is of no use, but simply there to be thrown away. If this particular book were to be taken and analyzed, and considering this non-drying ink as a carbon, it is really a book bound together with a piece of carbon paper between either sheet that is written upon; while in Defendant's Exhibit 14 it consists of a sheet with one piece of carbon attached to the book which has a place for a certain number of sheets, and then when that certain number of sheets are used the piece of carbon is worn out, and there is another carbon there to take its place; where in this book it requires a piece of carbon between every set, or several pieces of carbon, between every set; there it requires only one piece of carbon for any number of sets.

Mr. WHITE.—We offer this book in evidence and ask that it be marked Complainant's Exhibit "O."

Mr. TOWNSEND.—So far as this purports to be a representation of the Brown patent its admission is objected to.

Mr. WHITE.—The witness has already explained that after the most diligent search in this city he was unable to obtain anywhere a book constructed in ac-

(Testimony of Harry Levison.)

cordance with the Brown patent. Such a book is not on the market.

Mr. TOWNSEND.—The book in question is wholly irrelevant and immaterial as evidence.

Mr. WHITE.—It is very material. You put in the Brown patent as an anticipation of the patent in suit. Now, we find that there is no such book on the market.

Mr. TOWNSEND.—Anticipation is not proven by what is on the market or what is not on the market. The stop-card that was introduced is the same stop-card that defendant used in exhibit “A.”

(The book last offered by counsel for complainant is marked Complainant’s Exhibit “O.”)

The WITNESS.—I was just about to add—I had forgotten about the stop-card. In addition to that there is a stop-card bound to the outer edge of the book, but because every sheet of paper, or almost every sheet of paper is carbonized, and that unless something were placed between the sheets and in proper place, your impression writing on the first sheet may be copied on the several sheets and you may make several more impressions than are required or what are wanted, and thereby destroy or prevent the use of some of the future sheets. This stop-card is provided, and before the writing can be done it is necessary for the user to first find the proper place and then to insert the stop-card, and then to lay the sheet down and begin to write. It can be readily seen, and is most obvious, that to place this stop-card in its proper position just as much

(Testimony of Harry Levison.)

trouble and just as much work would be necessary as would be to place one piece of carbon as has been done in many previous books. In the present book, or Defendant's Exhibit 14, it is not necessary to place any stop-card or to handle anything whatever except the sheet upon which you wish to write. And this is the time saving and the labor saving convenience and the advantage of that particular book over all other books.

Q 45. (By Mr. WHITE.) I hand you a book, Mr. Levison, and ask you to state whether or not the same is constructed in accordance with Figure 2 of the Doughty patent, Defendant's Exhibit No. 2?

A. It is.

Q. 46. I ask you to describe this book and compare it with Defendant's Exhibit No. 14.

A. This book is made in a series of sheets which are printed so as to permit the folding over of the sheet on the arm, the metal arm. A metal arm of some kind is attached to the outer edge of the book, and the carbon is attached to the outside or the end of the arm. In order to use this book it is necessary to take this carbon or this arm upon which lies a piece of carbon and to lay this arm over the two inner side portions of the sheet, fold the outside portion of the sheet over the middle portion, and the middle portion over the inner portion, folding the carbon with it at the same time. After having written upon it it is necessary to unfold the sheet, throw the arm out of the way which holds the carbon, detach your sheets, the two outer sheets from the

(Testimony of Harry Levison.)

inner sheet, lay the inner sheet out of the way, unfold the outer edge of the next succeeding sheet, fold your arm back again into position and place your carbon in its proper position, then refold the sheet as described before. This is a laborious task, entirely impracticable, and to my knowledge I have never seen this book on the market. It is very evident that to use this book would require more trouble and more work than it would to use or insert a dozen pieces of carbon in the entire book. Defendant's Exhibit 14 does away with this mechanical work, does away with this arm and all this extensive and extravagant manner with which to hold the carbon to the book. In handling this book of Doughty you are required to handle the carbon even more than you are required in any of the other books while in Defendant's Exhibit 14 you do not handle the carbon at all. In this particular book it is shown that there has been an effort on the part of the inventor to do away with the handling of the carbon, but it is very evident that he did not succeed.

Mr. WHITE.—We offer the book in evidence and ask that it be marked Complainant's Exhibit "P."
(So marked.)

Q. 47. Can you state whether or not you have ever seen such a character of book as Complainant's Exhibit "P" on the market?

A. I have never seen this particular book on the market, or a book of that character on the market.

Q. 48. Did you ever hear of a book of that character being on the market?

(Testimony of Harry Levison.)

Mr. TOWNSEND.—We make the same objection.

A. I have never heard of the book being on the market. I never knew or heard anything of the book at all until I seen these paper patents.

Q. 49. (By Mr. WHITE.) Now, I hand you another book, Mr. Levison, and ask you to state whether or not the same is constructed in accordance with Figure 4 of the Doughty patent, Defendant's Exhibit No. 2? A. It is.

Q. 50. In what particular feature does this book differ from the preceding exhibit, Complainant's Exhibit "P"?

A. In this book it provides for the arm being attached about the middle of the cover, of the back cover, and by attaching a piece of semi-carbon or one-side carbon to the book and allowing that to extend the length of the inner sheet, and attaching another piece of one-side carbon to the arm that must be thrown into position, you fold the outer edge of the sheet over the arm and this one piece of semi-carbon and lay the arm and the piece of semi-carbon and the sheet over the inner piece of semi-carbon and the inner sheet. After this is done then you write upon the middle portion of the sheet. After this is done then you unfold the arm and the sheet, take the sheet off the arm, detach it from the book, and before writing must fold the other sheets in the manner described.

Mr. WHITE.—I offer this book in evidence and ask that it be marked Complainant's Exhibit "Q." (So marked.)

(Testimony of Harry Levison.)

Q. 51. In Complainant's Exhibit "Q," as I understand you, semi-carbons are used instead of the single double-carbons which are used in the case of Complainant's Exhibit "P." Is that correct?

A. That is correct.

Q. 52. Did you ever see any such book on the market as Complainant's Exhibit "Q"?

Mr. TOWNSEND.—We object to that as incompetent and irrelevant. A. I have not.

Q. 53. (By Mr. WHITE.) Did you ever hear of any such book on the market?

A. No, I never heard of any such book on the market.

Q. 54. If this Complainant's Exhibit "Q" had been on the market in San Francisco, would your position with the Levison Printing Co., and your connection with that house, put you in a position to know about the same?

Mr. TOWNSEND.—We make the same objection.

A. Having made a study of manifold books and having always had my eyes open for any improvement in manifold books, if such a book had been anywhere in or about San Francisco I would no doubt have seen it.

Q. 55. (By Mr. WHITE.) I hand you another book, Mr. Levison, and ask you to state whether or not the same is constructed in accordance with the Abraham's patent, Defendant's Exhibit No. 3?

Mr. TOWNSEND.—We object to that as leading.

A. It is.

Mr. WHITE.—We offer this book in evidence and

(Testimony of Harry Levison.)

ask that it be marked Complainant's Exhibit "R."
(So marked.)

Q. 56. Please describe this book.

A. This book is merely a duplicating book. The manner of taking copies is similar to any other duplicating book and all other duplication books that had been made, or some of the books that had been made up in that style. The Abraham patent is merely on the form. The fact that it has a perforation across the—it has four perforations of the sheet. By writing upon the upper sheet twice it takes the same two impressions on the lower sheets, and as Abraham says, you get four copies, but it is necessary to write twice in order to get four copies. His patent is more in regard to the form of printing than in the manner of binding or attaching or holding the carbon in place. In fact, it is merely on a duplicate book.

Q. 57. What is meant by the words or expression "to bind"? Or the word "bound" in the art of which the various exhibits form a part?

A. Do you mean to use the word "bind" in the art of making these books? I would say that the word "bind" means anything that is attached to, that is held; in other words, if you would take a dictionary you would find that the definition of the word "bind" is to confine or restrain or hold by physical force or influence of any kind; to be restrained from motion or from customary or natural action. Therefore anything that is restrained in any manner or by any influence is bound.

(Testimony of Harry Levison.)

Q. 58. Are there various means used in the art for binding the leaves of a book or loose leaves, together? And if so, state some of those various means?

A. There are, yes. They can be bound either by glue, paste, sewing, stitching, by clamping, by friction, or by pressure. Any of those things would bind.

Q. 59. I hand you a device and ask you what the same is designated and called by those skilled in the art, in this city?

A. This is called a binder or a magazine binder. It is manufactured by James Ready & Brother, binders, and loose-leaf systems of New York.

Q. 60. Is this device designated by that company as a binder? A. It is.

Mr. WHITE.—We offer this binder in evidence, and ask that it be marked Complainant's Exhibit "S."

Mr. TOWNSEND.—Exhibit "S" is objected to as irrelevant and immaterial and not representing anything in the case.

(Marked Complainant's Exhibit "S.")

Q. 61. (By Mr. WHITE.) I hand you another device, Mr. Levison, and ask you to state what the same is and what it is designated in the art, by those skilled in the art?

A. This is the Torsion binder, and is so designated by the manufacturer. In fact, on the inside cover is a label, placed there by the manufacturer, the Barrett Bindery Co. of Chicago. It says on this

(Testimony of Harry Levison.)

label that the Torsion binder was patented August 14, 1906; made only by the Barrett Bindery Co. of Chicago. It is a binder used for the holding of magazines. Stamped on the outside of the cover it says "Ainslee's." So it would be presumed that this book was made for holding the Ainslee magazines.

Mr. WHITE.—I offer this binder in evidence and ask that it be marked Complainant's Exhibit "T."

Mr. TOWNSEND.—We object to it as irrelevant and immaterial, and not representing anything in issue.

(Marked Complainant's Exhibit "T.")

Mr. WHITE.—By your last objection made, I understand that you do not contend that the carbon in the Kitchen book is not bound in the book?

Mr. TOWNSEND.—I don't understand the point of your question. We are not using any temporary binders, and have made no claim for the use of any such, and have not introduced in evidence any such anticipatory matter. We are not holding our carbon by any such means. We are not binding our carbon in any sense as shown by the testimony of previous witnesses.

Q. 62. (By Mr. WHITE.) I hand you a catalogue of the Barrett Bindery Co. and ask you to state whether or not the same discloses various and sundry means of binding objects together other than by stitching?

A. It does. In the very first page of this book it heads off with large letters, "Binders that Bind." And the first one that is put in there is the Torsion,

(Testimony of Harry Levison.)

the one that is marked Exhibit "T." And as you go through the book you will find that he shows a binder on page 7 which is held by cords, string, through the holes in the sheet; while on page 13 he describes a book or shows a picture of a book and on the top of it it is called a spring back binder. This is evidently according to the description, simply a binder which holds sheets in place by a spring, clamping at the binding place. In other words, the sheets of the books are held in place by friction created by a spring clamp.

Mr. TOWNSEND.—We move that the answer be struck out, as irrelevant and immaterial, and based on hearsay.

Q. 63. (By Mr. WHITE.) Are you basing your answer on hearsay or on what you see in the catalogue which you hold?

A. Just on the catalogue. Not a word has been said to me except what is printed in the book.

Mr. WHITE.—I offer this catalogue in evidence and ask that it be marked Complainant's Exhibit "U." (So marked.)

Mr. TOWNSEND.—I object to it as irrelevant and immaterial.

Q. 64. (By Mr. WHITE.) In referring to this catalogue, you stated you saw a spring binder mentioned therein, and I will hand you a device and ask you to state whether or not the same represents such spring binder advertised in such catalogue?

A. It does. It is so labeled on the outside of the cover. There is a printed label pasted there by the

(Testimony of Harry Levison.)

manufacturer, on which it says "Barrett Spring Book Binder for Magazines and Weeklies, Indispensable to Libraries, Clubs, and Reading Rooms. Has a grip like Death. Made by the Barrett Binding Co. of Chicago."

Mr. WHITE.—I offer that binder in evidence; and ask that it be marked Complainant's Exhibit "V."

Mr. TOWNSEND.—We object to it as incompetent, irrelevant and immaterial.

(Marked Complainant's Exhibit "V.")

Q. 65. (By Mr. WHITE.) As I understand it, Mr. Levison, such binder marked Complainant's Exhibit "V" is advertised and sold under the term "Binder"? Is that correct? A. It is.

Mr. TOWNSEND.—The further objection is made with regard to these various clamp exhibits last introduced, in that they are in a different art than the art of bookbinding or the art of making up books. They pertain simply to devices for holding loose leaves, and things of that sort, or magazines which are already bound.

Q. 66. (By Mr. WHITE.) I will ask you to compare, Mr. Levison, the means or force used in holding and binding the carbon in place in defendant's book, Complainant's Exhibit "A," with the means and force used in this last mentioned binder, Complainant's Exhibit "V"?

A. In Complainant's Exhibit "A" the carbon is forced into the binding space and between the stitches of the book, and the friction created by the

(Testimony of Harry Levison.)

stitches, or the spring created by the force of these stitches, in the binding, holds the carbon in place and virtually binds it in place in exactly the same manner as the spring in the binder of Complainant's Exhibit "V." In this particular exhibit a book or sheet or anything that is placed in the binder is held there by the friction created by the spring or clamp; while in this Complainant's Exhibit "A" the carbon is held in place by the friction created by the thread, binding, stitches or anything that holds the sheets together, causing friction, which holds the carbon in place. And I would consider them bound in the spring binder—I would consider the binding to be caused in the same manner as it is caused in exhibit "A."

Mr. TOWNSEND.—I move that the answer be struck out, as the comparison made is wholly irrelevant and immaterial to any question in issue. It is merely a question as to whether this book exhibit "A," infringes upon complainant's patent. And I don't believe it is contended by the complainant that Exhibit "V" illustrates complainant's patent.

Q. 67. (By Mr. WHITE.) I show you another device, Mr. Levison, and ask you to state what the same is, and what it is designated as by the manufacture of the same?

Mr. TOWNSEND.—We make the same objection; that it is irrelevant and immaterial.

A. This is a binder designated by the manufacturer, as shown by the label pasted on the binder, and on which it says "Wagner's Free Hand Binder,

(Testimony of Harry Levison.)

patented May 22, 1906, August 13, 1907; others pending; can be operated by one hand. To open, depress the handle with the thumb, at the same time pushing in the automatic lock with the forefinger. To close, simply depress handle and it will lock automatically. This binder is made in over 40 different sizes. Marcus, Ward & Co., Brooklyn, New York. Patents protected by the Patent Title & Guarantee Co. of New York." In addition to that it has got a leaf here, printed on all over it, that this is a free-hand binder, "Wagner's Free Hand Binder." In using this binder the sheets are placed below the clamping device, and by simply depressing the handle until it is locked, the spring which is on the rod holds the binding edge of it in position, and the friction created by this spring, the pressure created by this spring, holds whatever is in there, or binds it, binds them together.

Mr. WHITE.—I offer this device in evidence, and ask that it be marked Complainant's Exhibit "W."

Mr. TOWNSEND.—We object to the offer as irrelevant and immaterial, and representing nothing in the case.

(Marked Complainant's Exhibit "W.")

Q. 68. (By Mr. WHITE.) I hand you a catalogue or circular of Payot, Stratford & Kerr of this city, and ask you to state whether or not the same discloses various devices and various means for binding leaves together other than by stitching?

A. It does, as illustrated in there. I see a picture and a description of Wagner's Free Hand Binder,

(Testimony of Harry Levison.)

and it specifies that "This binder holds more sheets by three times than any other made." It also illustrates a binder which holds cards and is called the "Peerless Card and Lever Binder Case," which holds sheets together by pressure. It also mentions a few other binders.

Q. 69. And this device which you have referred to as being described in this circular and these other devices there described are designated in the circular as binders, are they not? A. They are.

Mr. WHITE.—I offer this circular in evidence, and ask that it be marked Complainant's Exhibit "X."

Mr. TOWNSEND.—We make the same objection to this offer as was made to the other circulars. And the further objection is made to all these so-called temporary binders, offered as exhibits, in that they are not in the art of manifold books, and they are only remotely allied to the art of bookbinding. They have no relevancy whatever, to any issue in the present case.

Q. 70. (By Mr. WHITE.) I hand you another device, Mr. Levison, and ask you to state what the same is, and by what expression the same is designated by the manufacturer of it.

A. This is a binder for cards. There is a paster attached to this which says that this is the "Peerless Patent Scored Cards, made by the John P. Wiggins Co., sole manufacturers, Chicago, U. S. A. These cards are trimmed exact size to fit our lever binder case." This is a binder that is held together by

(Testimony of Harry Levison.)

pressure created by a lever, and is a similar binder to the one described in the circular of Payot, Stratford & Kerr, marked Exhibit "X." So that this is not only called a binder by Wiggins & Company of Chicago, but is also called a binder by Payot, Stratford & Kerr of San Francisco.

Q. 71. That device was patented in 1899, was it not? A. So it says here on this label.

Mr. WHITE.—I offer that device in evidence, and ask that it be marked Complainant's Exhibit "Y."

Mr. TOWNSEND.—Its admission is objected to as irrelevant and immaterial, and also on the ground that it is not in the art of bookbinding; not in the art of manifolding books, especially. As far as illustrating the claim is concerned, it shows no more than the Doughty patent shows.

Mr. WHITE.—Do I understand, Mr. Townsend, that you admit that the Doughty patent discloses a clamp for binding leaves in any book ?

Mr. TOWNSEND.—The Doughty patent shows that the leaves are held, that they are bound as stated by the patentee at the bottom of Claim 1, and that the specifications "a" are covered by the clamp A'. Your little Exhibit "Y" apparently shows the same thing, except that your leaves are not bound together, but are loosely inserted into the clamp.

Q. 72. (By Mr. WHITE.) I hand you a catalogue of J. S. McDonald Co. of Chicago, Illinois, and ask you to state whether or not this refers to various devices in there, as binders, which are adapted to hold sheets together by other means than stitching?

(Testimony of Harry Levison.)

Mr. TOWNSEND.—We make the same objection; irrelevant and immaterial; no foundation laid, nor the catalogue accounted for.

A. It does, in a number of cases. On the very cover it says “Gravity Lock Binder.” It shows that it binds in other ways than by stitching. And throughout the book it speaks of different styles of binders.

Mr. WHITE.—I offer this catalogue in evidence, and ask that it be marked Complainant’s Exhibit “Z.” (So marked.)

Q. 73. (By Mr. WHITE.) I hand you another device, Mr. Levison, and ask you to state by what term the same is designated by the manufacturer thereof.

A. This is designated by a stamp on the inside of the cover as “The Simplex Binder, Makers, James R. Ready & Bros., Binders, Files, Loose Leaf Systems, 18 Cedar Street, New York.”

Mr. WHITE.—I offer this binder in evidence and ask that it be marked Complainant’s Exhibit “AA.”

Mr. TOWNSEND.—We object to it as irrelevant and immaterial and not belonging to the art of manifolding books or bookbinding proper.

(Marked Complainant’s Exhibit “AA.”)

Q. 74. (By Mr. WHITE.) I show you a catalogue of the Chicago Shipping & Receipt Book Co., Mr. Levison, and ask you to state whether or not the same discloses various and sundry devices adapted for binding leaves together.

A. It does, several of them; many of them.

(Testimony of Harry Levison.)

Q. 75. Are such devices designated in such catalogue by the expression "Binder?" or "Binders?"

A. Some of them are called Lock Binders, some of them are called Post Binders, and some of them are called Transfer Binders.

Mr. WHITE.—I offer this catalogue in evidence and ask that it be marked Complainant's Exhibit "BB."

Mr. TOWNSEND.—Its introduction is objected to as irrelevant and immaterial, secondary evidence, no foundation laid.

(Marked Complainant's Exhibit "BB.")

Q. 76. (By Mr. WHITE.) Do you know where these various catalogues were secured, Mr. Levison, that have been put in evidence?

A. They were secured through circular letters sent out by the various manufacturers by these houses, without any great effort on our part to get these circulars. We got these circulars and catalogues from time to time from these different houses.

Q. 77. As one familiar with the art and skilled in the art involved in this suit, what have you to say regarding the meaning of the word "bound"? Or the words "to bind" in the year 1902, when the patent in suit was granted?

A. Well, I consider the words "to bind" to mean just exactly what Webster's unabridged dictionary would put it. In the art we consider it to mean nothing else but what the dictionary calls for. Anything that is held together in any manner is bound, whether it be held by friction, clamped, by stitches, glue,

(Testimony of Harry Levison.)

paste, or anything whatever. As long as it is restrained from moving about or from natural movement, it is bound. In fact, the word "bind" means to attach, to hold, to confine, to restrain, and so on.

Q. 78. In the ordinary and everyday use of a book constructed like Complainant's Exhibit "A" would the carbon be held or bound in place so that it would not become misplaced or fall out of the book?

Mr. TOWNSEND.—We object to that as leading.

A. No, sir; it cannot fall out of the book. We consider it bound to the book, held to the book. In fact, if I had to make that book in our shop I would have to go, in order to get that book made, to the bookbinder and he would bind the book, and in binding the book he would have to attach and keep the carbon in the binding space, as shown in that particular book.

Q. 79. (By Mr. WHITE.) Can you state what the purpose is of attaching the carbon in this book, Complainant's Exhibit "A," to a piece of cardboard, and cutting out places in such cardboard, as shown here?

A. As near as I can see, it is that unless this piece of cardboard be cut in that manner it would be stitched to the back, and that the reason for doing that is that this here should slip alongside of the stitching, and instead of this being bound in the book when the book was made, it would be bound to the book after it had been made.

Q. 80. Do you know what requirements there are in the city and county of San Francisco in regards to

(Testimony of Harry Levison.)

triplicating receipt-books purchased by the city, or contemplated being purchased by the city, for the coming fiscal year?

Mr. TOWNSEND.—We object to that as irrelevant and immaterial, and not rebuttal.

A. It calls for books consisting, as described here, of pads with suitable backs, having covers with suitable stop-card and four pieces of double-carbon paper bound in or to the pad, the carbon paper arranged to allow the folding over of the sheet, and taking two copies at one writing, etc.

Q. 81. (By Mr. WHITE.) In answering my question to what document did you refer?

A. I referred to the schedule of estimated yearly supplies of books required by the various departments and offices and officers of the city and county of San Francisco during the fiscal year commencing July 1, 1909, and ending June 30, 1910.

Q. 82. As I understand it, then, the city and county of San Francisco can only accept bids for books having carbons attached to the same. Is that correct?

A. According to the schedule here such is the request.

Q. 83. By whose authority is this document or schedule which you have just referred to issued?

A. As I understand it, this is issued by the Printing Committee of the Board of Supervisors, the prices to be placed in these spaces here, and addressed to the Honorable Board of Supervisors of the City and County of San Francisco.

(Testimony of Harry Levison.)

Mr. WHITE.—Take the witness.

Cross-examination.

(By Mr. TOWNSEND.)

XQ. 1. You are connected with the Levison Company, are you not, the defendant?

A. Yes.

XQ. 2. You are interested in this company?

A. I am a stockholder.

XQ. 3. You are therefore interested in this suit, then, in the outcome of this suit? A. Yes.

XQ. 4. You read a few moments ago from the specifications for fee-books, quoting that the carbon paper is to be bound in or attached to the pad. Are all books which have carbons attached to the pad considered bound books, in your opinion?

A. They are.

XQ. 5. You also stated, I believe, that as long as a carbon cannot fall out of the book it is bound in the book, from your statement that you made awhile ago?

A. Anything that cannot be moved about is bound.

XQ. 6. You stated that as long as the carbon could not fall out of the book it was bound in the book? A. Bound in the book.

XQ. 7. You recognize exhibit "P," the Doughty model, as a manifold book, do you not?

A. I do.

XQ. 8. And as a triplicating book, do you not?

A. I do.

XQ. 9. Cannot the carbon fall out of that book?

(Testimony of Harry Levison.)

A. Not if you consider that arm to be a portion of the book, it could not fall out of the book.

XQ. 10. How do you consider that arm?

A. I would say that the arm was attached to the cover of the book. In other words, I would say that the arm was bound to the cover of the book, and that the carbon was bound to the arm, or attached to the arm, or held to the arm.

XQ. 11. Then you would consider that a bound carbon?

A. I would say that that carbon was bound to the arm, held.

XQ. 12. This exhibit "P," Mr. Levison, contains a double-faced carbon, does it not?

A. It does.

XQ. 13. This exhibit "P" of the Doughty patent contains a plurality of carbons, does it not—exhibit "P," the Doughty book? A. It does.

XQ. 14. It has a cardboard back, has it not, to which the arms are attached? A. It has.

XQ. 15. And the record sheets in the Doughty book outside the stubs are divided into three substantially equal separable parts, are they not?

A. They are.

XQ. 16. And the carbon sheet of the Doughty extends the width of 2 of said parts, does it not?

A. After it is laid over the sheet it extends the width of 2 of them, not before.

XQ. 17. The recording sheets having stubs to which they are attached along lines of perforations?

A. I would say that the recording sheet is not at-

(Testimony of Harry Levison.)

tached to a stub along lines of perforation, but that the recording sheet can be separated into 3 parts along lines of perforation.

XQ. 18. I call your attention to the Doughty patent. You stated that this exhibit "P" was an exact representation of the Doughty patent, Figure 2? A. It is.

XQ. 19. And in this Doughty patent it has the clamp that you have shown in exhibit "P" and it shows means of perforations, c, just outside the clamp?

A. I will say that in the figure 1 it does not show a perforation just outside the clamp, but in figure 2 it does. The reason for that is, that as described in his patent here, it says that "The triplicate, which latter can be retained in the book or removed as desired." Now, to retain it in the book the perforation is not there, but if it were removed the perforation would be there.

XQ. 20. You say that in figure 2 the perforations are shown outside the clamp.

A. In figure 2, but not in figure 1.

XQ. 21. I understood you to testify on your direct examination that exhibit "P" was and is a representation of figure 2.

A. I may have said that, but I think I said it was a representation of Figure 1.

XQ. 22. The testimony will speak for itself.

A. I may have said it was an exact representation of figure 2, inasmuch as I may have overlooked that small perforation marked c.

(Testimony of Harry Levison.)

XQ. 23. If this refers to Figure 2 then your perforations in the stub were there?

A. The only change that would be necessary in order to make that represent Figure 2 instead of Figure 1 would be a perforation just outside the spring binding portion.

XQ. 24. No mention has been made of the spring, so that is immaterial, or the clamp, either. But if this is a correct representation of Figure 2, then these record sheets show stubs to which they are attached along lines of perforations. Is that not true?

A. Figure 2? Yes.

XQ. 25. And these stubs are bound to the back, according to your definition?

A. They are, yes.

XQ. 26. And the carbon sheet is also bound to the back? A. It is bound to the cover.

XQ. 27. The backing, as shown there?

A. Binding to the back, I would say, I mean not the binding to the back; I mean the cover.

XQ. 28. And they are all bound together with stubs and carbons to form a book?

A. Yes, it all forms a book; yes. I will say for your benefit that the patentee of that book is trying to get at the proposition of binding a carbon to a book, so that it could be easily handled, but that he has got a very awkward manner of binding the carbon to the book, and a very awkward manner of handling the carbon.

XQ. 29. I will take this in another way. We have here the carbon sheets extending the width of

(Testimony of Harry Levison.)

the parts of the record sheets, except the outermost, have we not?

A. When you lay your carbon down, when you place your carbon in position, it extends the width of two, except the outermost.

XQ. 30. And we also have in this Doughty Exhibit "P" a plurality of recording sheets, each recording sheet outside of the stub being divided into a plurality of not less than three of separable parts joined along lines of perforations? You have stated that; each part being not greater than the part next it on the side toward the stub; is that not true?

A. Yes.

Redirect Examination.

(By Mr. WHITE.)

RDQ. 1. In Defendant's Exhibit 14, being the book covered by the patent in suit, state whether or not one edge of the carbon is bound with the stubs of the various sheets in the book. A. It is.

RDQ. 2. State whether or not in this book, Complainant's Exhibit 1, the carbon or one edge of the carbon is bound together with the stubs of the various sheets of the book. A. It is not.

Mr. WHITE.—That is all.

(Testimony closed.)

[Examiner's Certificate to Depositions.]

United States of America,
State and Northern District of California.
City and County of San Francisco,—ss.

I hereby certify, that the foregoing depositions were taken in pursuance of the notices hereunto annexed, at the place stated in the captions of said depositions, and upon the days set forth in said depositions, in my presence and in the presence of counsel for the respective parties to the cause in said caption entitled. That previous to giving their testimony the said witnesses were by me duly sworn to tell the truth, the whole truth and nothing but the truth in said cause. That said depositions were taken down in shorthand writing and transcribed by Brainard C. Brown, in pursuance of stipulation of counsel; that the reading and signing of said depositions were, by stipulation of the respective counsel, waived; and that I have retained said depositions for the purpose of delivering the same with my own hand to the Court for which they were taken.

Accompanying said depositions and forming part thereof are the several exhibits introduced in evidence therewith and referred to and specified therein.

I further certify, that I am not attorney nor of counsel for any of the parties to said cause, nor in any way interested in the event thereof.

In witness whereof, I have hereunto set my hand
this 29th day of June, 1909.

E. H. HEACOCK,
Examiner in Chancery, U. S. Circuit Court, Ninth
Judicial Circuit, Northern District of Cali-
fornia.

[Endorsed]: Published and Filed Sept. 8th, 1909.
Southard Hoffman, Clerk. By J. A. Schaertzer,
Deputy Clerk.

At a stated term, to wit, the July term, A. D. 1910,
of the Circuit Court of the United States of
America, of the Ninth Judicial Circuit, in and
for the Northern District of California, held at
the courtroom in the City and County of San
Francisco, on Monday, the 1st day of August,
in the year of our Lord, one thousand nine hun-
dred and ten. Present: The Honorable WILL-
IAM C. VAN FLEET, District Judge.

No. 14,772.

ALEXANDER LEVISON

vs.

J. KITCHEN JR. COMPANY.

Order for Entry of Interlocutory Decree.

This cause heretofore submitted to the Court being
now fully considered and the Court having rendered
its oral opinion thereon, it was ordered, in accord-
ance therewith, that an interlocutory decree in favor
of complainant, be signed, filed and entered, with
reference to the Master for an accounting.

*In the Circuit Court of the United States, Ninth
Judicial Circuit, Northern District of Cali-
fornia.*

Hon. W. C. VAN FLEET, Judge.

No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. COMPANY,

Defendant.

Oral Opinion.

Monday, August 1st, 1910.

Appearances:

JOHN H. MILLER, WILLIAM K. WHITE,
for Complainant.

CHARLES TOWNSEND, for Defendant.

THE COURT (Orally). In the case of Alexander Levison vs. J. Kitchen Jr. Company, I requested counsel in the case to be here this morning that I might announce my conclusions. I have given the case very careful consideration and reviewed the evidence thoroughly, and I have reached the conclusion that the decree must go in favor of the complainant and a reference had to the Master to ascertain the damages.

The bill is one for the infringement of letters patent for what is called a manifold book,—used by express and commercial houses where it is necessary to have more than one copy of a receipt. The defenses

are want of invention, growing out of anticipation; the validity of the patent as a reissue; and further that there is no infringement.

As to the defense of want of invention by reason of anticipation, it appears that prior history of the art is made up of a large number of devices theretofore patented wherein it is disclosed that it has been the aim, object and desire of those interested for a great many years, a quarter of a century perhaps, to attain some simple device by which in manifold books of this character the use of carbon paper may be had under conditions which would avoid the necessity of handling it and having it in loose sheets, as it had existed for a great many years, because of its unpleasant nature and the inconvenience. The patent of the complainant covers such a device. It is one which covers a manifold book where the carbon paper is attached by binding in with the sheets of the book to the book itself; a certain number of recording sheets, such as would by estimation and experience exhaust the life of one sheet of carbon are put in the book, and the sheet of carbon bound in; then a like number of recording sheets are put in with another sheet of carbon, and in that way a book of any number of desired recording sheets is made. It appears from an examination of the prior art that this is not the first time that a device has been invented whereby the carbon paper is bound in the book, but it does disclose very clearly to my mind, and without any conflict of a substantial character in the evidence, that this is the first instance in which a practicable device of this character has been in-

vented; and of course it is well established that a device that is of a practical and successful character cannot be anticipated by one that is not, although it may include all of the elements that may appear in the successful device. It is very strenuously urged, however, that it does appear that the change by which the success in this device is brought about is a perfectly simple and obvious one, growing out of the art as it theretofore existed. I am entirely unable to coincide with this view. The simplicity of the change is not the test of its patentability; its simplicity is not the test of its obviousness. It is well established that, in order to determine whether a thing is so obvious that by an inspection of the prior art the skilled artisan could have evolved the device which is the subject of the patent without the intervention of the inventive faculty, other things than its mere simplicity must be regarded. Simplicity, it is aptly said, is of high value in mechanics, and especially in the inventive art, and in itself is no objection to patentability. Arguments of that sort have ever been used against the employment of the inventive faculty. The determinative factor is, what has been accomplished as shown by the result of the patented device in the way of a successful attainment of the purpose that is shown to have been sought. It is a very usual defense in instances of improvement patents or secondary patents as they are termed, where the art has any previous history, to base a defense upon the claim of simplicity and obvious anticipation through the existing art; but it is not a defense that is favored; it is one that the courts regard rather

jealously, and they will examine carefully the results obtained to see if in fact the apparent simplicity and obviousness, which very frequently strikes one when a thing has been accomplished, is not due to the employment of the inventive faculty; and that, as I say, is to be determined largely from the successful operation of the device and what it accomplishes.

The history of this art shows that, although there had been at least two previous devices patented wherein the carbon was bound into the book, neither one of those was a practicable device. That is particularly true of the Doughty patent, where there was a device by which the carbon was bound in the middle of the book and by a cumbersome and complicated arrangement the carbon could be used by folding over the sheets first on one side and then on the other; but that was proven and shown very clearly to my mind to be entirely impracticable and was not a success and has practically gone out of existence. The other device, the Bengough patent, is not to my mind in any sense an anticipation of the present one. It was a very cumbersome arrangement whereby the carbon was attached to the book by a wire frame, was not bound into the book in any proper sense at all; it was merely attached to it, and when the book was opened to be prepared for use, by throwing this framework over it would put this carbon in a position where the recording sheets could be folded upon it, and thereby a manifold register made. An inspection of these two devices, that is the Doughty device and the Bengough device, tends to satisfy me as much perhaps as any other thing

in the case that the idea of the complainant in creating his device was not obvious; that it was merely one of those happy thoughts which came to him by some sort of inspiration and brought about success out of what had been previously comparative failure; and this, as heretofore indicated, is always potent evidence of invention. I am therefore fully satisfied in my own mind that so far as the defense of anticipation is concerned, it is wholly unsustained by the record.

As to the defense of invalidity through reissue, I do not think that there is anything of substance in that defense. The statute very clearly provides for instances in which a reissue may be had, growing out of accident or inadvertence or omission to fully state in the claims of the original patent the invention that the patent really covers. You cannot expand your invention but you can expand and correct your claims so as to avail yourself of the invention that is covered by the patent; and that is all that was done in this instance. The reissue was had within 15 or 16 days after the original patent. That is, the application for reissue was had within a very few days, and I think that the record shows that the reissue was had within a short time after the original patent was issued; so that I am satisfied that the application for a reissue was strictly within the limitation of the statute, which would show good faith, and that the application itself discloses that it was one of those instances which was clearly within the provisions of the statute authorizing a reissue under the circumstances. I am therefore satisfied, as sug-

gested, that there is nothing in that defense.

The only remaining defense is, as indicated, that there really is no infringement by the device of the defendant, and that is based largely upon the theory that by reason of the prior art the claims of the complainant's patent are so restricted in their construction that they must be confined to a device proceeding precisely upon the lines of that described in the patent; in other words, that the patent is not entitled to the doctrine of equivalents. The argument largely proceeds along the line that the patent is to be so narrowed in its construction by the prior art that it is not entitled to the doctrine of equivalents, and that inasmuch as the defendant's device is to be differentiated from that of the complainant, it cannot operate as an infringement. The doctrine, or rather what was supposed to be the doctrine for some years under the decisions of the Supreme Court, that pioneer or primary inventions only are entitled to invoke, in their protection, the doctrine of equivalents, has been entirely exploded, and that Court has decided definitely and finally in the Paper Bag Patent case, so called, 210 U. S. 405, that that Court never did announce any such doctrine, under its decisions when properly interpreted. The rule is, as declared in the Paper Bag case, that a secondary or improvement patent, equally with a primary patent is to have a fair and reasonable construction, and is entitled to the protection of the doctrine of equivalents to the extent that it shows a substantial improvement in the art; it is not, of course, entitled to the broad application of the doctrine equally with

a pioneer or primary patent, but it is entitled to the application of that doctrine to the extent that its claims, fairly and justly construed, will so entitle it. Now, applying that doctrine, it seems to me, under the evidence in this case, and in view of the high and successful character of the device of the defendant, and where the infringement is by a device so palpably the equivalent of that called for in the complainant's patent, that there can be no question that it should be entitled to the protection of that principle. The defendant's device is this: the book is practically of the same character in its general make-up as that of the complainant, and of course as to this there is no claim of novelty. The carbon is not bound in with the binding of the book; it is attached to a piece of rigid cardboard, so cut as to leave certain points on the external edge; the book itself is bound by staples and in such manner that the leaves may be separated at any point, and the carbon, through the use of this rigid piece of cardboard, may have those points firmly inserted so that they will enter on each side of these staples and thereby the carbon is securely held in place; so that, as was illustrated at the argument, you can pick the book up and handle it in any way and the carbon still remains firmly in place. I am entirely satisfied in my mind that this is the equivalent of binding it in the book at the printer's or at the bindery. It would not seem to make any difference how the carbon is secured so long as it is firmly attached. The novelty of the device of the complainant is in its having solved the idea of having a fixed carbon so

arranged that it makes a practicable and successfully operating book, and the patent does not pretend to confine it to the one form. Of course the claim uses the term "bound in," but the patentee does not undertake to confine himself to the manner in which it shall be bound; it simply provides for the binding of the carbon in the book. Supposing that defendant had had his carbons arranged with this patent paste or mucilage attachment such as we often see, where you can dampen or wet it with a sponge and attach it to anything; you could take any book in the world that I have ever seen and if that carbon was so arranged you could lift those leaves and stick or paste it at the inner edge and it would be as perfectly bound in that book as any leaf of the book. The fact is you often see such insertions of illustrations in books; they are not bound or sewed in with the leaves of the book, but they are inserted through the book in their proper places by the use of paste or mucilage or other adhesive material, and they are bound in the book just as effectually as though they were sewed in; and so here it seems to me that it is the purest evasion and attempt to get around the device of the complainant by adopting a means of securing precisely the same end by what to my mind must be held as in all material respects an equivalent method; and that cannot be allowed. As intimated, I have no doubt from the evidence in the case that the invention of the plaintiff's device was of such material character that entitles it to a substantial application of the doctrine of equivalents; and under that doctrine the defendant's device is clearly an in-

vasion of his rights and an infringement.

These, expressed in a very crude and general way, are the reasons that have affected me in reaching the conclusion that the decree in the case must go for the complainant, and that a reference be had to the Master to determine the damages.

[Endorsed]: Filed August 1st, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

In the Circuit Court of the United States for the Northern District of California, Ninth Circuit.

No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Defendant.

At a stated term, to wit, the July Term, of the above-entitled court, held at the courtroom thereof in the City and County of San Francisco, State of California, on the eighth day of August, A. D. 1910,—Present, Honorable WILLIAM C. VAN FLEET, District Judge, presiding:

Interlocutory Decree.

This cause having heretofore come on regularly to be heard upon the pleadings and proofs documentary and oral taken and submitted in the case, and being of record therein, the complainant being represented by Messrs. Miller & White, and the de-

fendant by Charles E. Townsend, Esq., and the cause having been duly argued and submitted to the Court for its consideration and decision, and the Court being now fully advised in the premises, it is ORDERED, ADJUDGED AND DECREED as follows:

That the defendant was and is a corporation organized and existing as alleged in the bill of complaint herein.

That the letters patent sued on herein, to wit, United States Reissued Letters Patent No. 12,005, issued on July 1, 1902, to Alexander Levison, complainant herein, for Improvements in Manifold Books, are, so far as Claims 3, 4 and 5 thereof are concerned (said Claims 3, 4 and 5 being the only claims thereof charged to have been infringed by the defendant, and, therefore, the only claims considered by the Court), in all respects good and valid in law; that said Alexander Levison was the original and first inventor of the inventions described and claimed in said reissued letters patent; that ever since the issuance of said reissued letters patent to him, as aforesaid, complainant has been and still is the sole and exclusive owner of the same, together with all claims, demands and causes of action for the past infringement thereof; that since the issuance of said reissued letters patent and within six years prior to the commencement of this suit, the defendant herein, without the license or consent of complainant, within the Northern District of California, has infringed upon said Claims 3, 4 and 5 of said reissued letters patent No. 12,005 by making, using and selling manifold books containing and embodying the

inventions respectively claimed and patented in and by said Claims 3, 4 and 5 and each of them.

And it is further ORDERED, ADJUDGED AND DECREED that the defendant J. Kitchen Jr. Co., its officers, agents, servants, attorneys, workmen and employees, be and they are hereby perpetually enjoined and restrained from further making, using or selling any manifold books containing or embodying the inventions respectively claimed and patented in and by said Claims 3, 4 and 5 of said reissued letters patent, or any of them, and from further infringing upon said Claims 3, 4 and 5 of said reissued letters patent, and each of them.

And it is further ORDERED, ADJUDGED AND DECREED that the complainant recover of the defendant the damages which complainant has suffered, together with the gains, profits and advantages which the defendant has realized from and by reason of its infringement aforesaid.

For the purpose of stating the account of the gains, profits and advantages by the said defendant received, or which have arisen or accrued to defendant from infringing the said exclusive rights of complainant, by the manufacture, use and sale of said patented inventions, and for ascertaining the damages suffered by the complainant thereby, it is ORDERED, ADJUDGED AND DECREED that this cause be and is hereby referred to H. M. Wright, Esq., Master in Chancery of this court, to ascertain, take, state and report to the Court an account of the said gains, profits and advantages by the said defendant had, received, arisen or accrued, and all damages

by the said complainant sustained by reason of the said infringement, and that the complainant on such accounting have the right to cause an examination of the officers of the said defendant *ore tenus*, or otherwise, and also the production of its books, vouchers and documents, and that the said officers of the defendant attend for such purpose before the Master from time to time as such Master shall direct.

And it is further ORDERED, ADJUDGED AND DECREED that the complainant do have and recover of the defendant its costs and disbursements in this suit taxed by the clerk at the sum of ———— dollars.

Dated August 8th, 1910.

WM. C. VAN FLEET,
Judge.

[Endorsed]: Filed and entered August 8th, 1910.
Southard Hoffman, Clerk.

*In the United States Circuit Court for the Ninth Circuit,
Northern District of California.*

IN EQUITY—No. 14,772.

ALEXANDER LEVISON,

Complainant,

VS.

J. KITCHEN JR. CO.,

Respondent.

Petition for Order Allowing Appeal.

J. Kitchen Jr. Co., respondent in the above-entitled cause, conceiving itself aggrieved by the final order and decree filed and entered on the 8th day of Au-

gust, 1910, in pursuance of the decretal order of August 1, 1910, in the above-entitled cause, whereby infringement and accounting in favor of complainant and against defendant was ordered, adjudged and decreed, as prayed for in the Bill of Complaint in said cause in the case, Charles E. Townsend, Esq., solicitor and counsel for respondent, petitions said Court for an order allowing respondent, J. Kitchen Jr. Co., to prosecute an appeal from said final order and decree, and the Honorable, the United States Circuit Court of Appeals for the Ninth Circuit under and according to the laws of the United States in that behalf made and provided; and also that an order be made fixing the amount of security which defendant, J. Kitchen Jr. Co., shall give and furnish upon such appeal, and that upon giving such security all further proceedings in this court be suspended and stayed until the determination of said appeal by said United States Circuit Court of Appeals for the Ninth Circuit, and your petitioner will ever pray.

CHAS. E. TOWNSEND,

Solicitor for Respondent.

[Endorsed]: Filed Aug. 12, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

*In the United States Circuit Court of Appeals in the
Ninth Circuit in the Northern District of Cali-
fornia.*

J. KITCHEN JR. CO.,

Appellant,

vs.

ALEXANDER LEVISON,

Appellee.

Assignment of Errors.

Now comes J. Kitchen Jr. Co., respondent in the cause in the court below, entitled "Alexander Levison, Complainant, vs. J. Kitchen Jr. Co., Respondent," No. 14,772, in the Circuit Court of the United States for the Northern District of California, and appellant herein, by Charles E. Townsend, Esq., its solicitor and counsel, and says that in the record and proceedings in the said cause in the said court below there is manifest error, and it particularly specifies the following as the errors upon which it will rely and which it will urge upon its appeal in the above-entitled cause:

1. That the Circuit Court of the United States for the Northern District of California erred in holding that the claims of complainant's patent, and especially Claims 3, 4 and 5 sued on, were, or any of them, valid.

2. That the Circuit Court of the United States for the Northern District of California erred in holding that the claims of complainant's patent, and

especially the claims sued on, were not each and all anticipated by the prior art.

3. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant's patent, with especial reference to the claims sued on, presented patentable novelty in view of the Barlow, or Doughty, or Abrahams patents.

4. That the Circuit Court of the United States for the Northern District of California erred in holding that the claims of complainant's patent sued on, or either of them, represented a patentable invention.

5. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant's patent was not void as a reissue.

6. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant's patent, and especially the claims sued on, and each of them, or any of them, were entitled to a liberal construction and application of the doctrine of mechanical equivalents.

7. That the Circuit Court of the United States for the Northern District of California erred in holding, in view of the prior art, that the defendant's device did not represent a distinct, different and independent invention from complainant's.

8. That the Circuit Court of the United States for the Northern District of California erred in holding that the loose carbon of appellant was the equivalent of the bound carbon of complainant appellee.

9. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant's patent was infringed.

10. That the Circuit Court of the United States for the Northern District of California erred in enjoining the respondent.

11. That the Circuit Court of the United States for the Northern District of California erred in sustaining the bill of complaint.

In order that the foregoing assignments of errors may be and appear of record, the appellant presents the same to the Court, and prays that such disposition be made thereof as in accordance with the law and the statutes of the United States in such cases made and provided.

All of which is respectfully submitted.

CHAS. E. TOWNSEND,

Solicitor for Appellant.

[Endorsed]: Filed Aug. 12, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

*In the United States Circuit Court for the Ninth
Circuit, Northern District of California.*

IN EQUITY—No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Respondent.

Order Allowing Appeal.

On motion of Charles E. Townsend, Esq., solicitor and counsel for J. Kitchen Jr. Co., respondent, in the above-entitled cause, it is ordered that the appeal to the United States Circuit Court of Appeals for the Ninth Circuit from the final order and decree filed and entered herein to wit, on the 8th day of August, 1910, be and the same hereby is allowed; that the transcript of the record, testimony, exhibits, and all proceedings herein be forthwith transmitted to the United States Circuit Court of Appeals for the Ninth Circuit upon said respondent, J. Kitchen Jr. Co., giving a bond in the sum of Five Hundred (\$500.00) Dollars and all further proceedings in this Court be suspended and stayed until the determination of said appeal by the said United States Circuit Court of Appeals for the Ninth Circuit.

WM. C. VAN FLEET,

Judge.

[Endorsed]: Filed Aug. 12, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

*In the United States Circuit Court for the Ninth
Circuit, Northern District of California.*

IN EQUITY—No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Respondent.

Order Allowing Withdrawal of Original Exhibits.

On motion of Charles E. Townsend, Esq., solicitor and counsel for J. Kitchen Jr. Co., respondent, and good cause appearing therefor, it is by the Court now ordered:

That all of the exhibits in the above-entitled case, both complainant's exhibits and respondent's exhibits, including models, drawings, copies of patents, etc., and which are impracticable to have copied or duplicated, be and hereby are allowed to be withdrawn from the files of the Court in this case and transmitted by the Clerk of this Court to the United States Circuit Court of Appeals for the Ninth Circuit as a part of the record upon appeal for the respondent herein to said Circuit Court of Appeals; said original exhibits to be returned to the files of this Court upon the determination of said appeal by said Circuit Court of Appeals.

WM. C. VAN FLEET,
Judge.

[Endorsed]: Filed Aug. 12, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

AMERICAN BONDING COMPANY OF BALTI-
MORE,

HOME OFFICE: BALTIMORE, MD.

*In the United States Circuit Court for the Ninth
Circuit, Northern District of California.*

IN EQUITY.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Respondent.

Bond on Appeal No. 14,772.

Know All Men By These Presents, that the undersigned J. Kitchen Jr. Co. of the City and County of San Francisco, State of California, the appellant herein, as principal, and the American Bonding Company, of Baltimore, a corporation organized under the laws of the State of Maryland, and duly licensed to transact its business in the State of California, as surety, are held and firmly bound unto the above-named appellee, Alexander Levison, in the sum of five hundred and 00/100 dollars (\$500.00), lawful money of the United States of America, to be paid to said appellee, his heirs and assigns, to which payment, well and truly to be made, we bind ourselves, our heirs, executors, administrators and successors, jointly and severally, firmly by these presents.

The condition of the above obligation is such, that whereas, said appellant has taken an appeal to the

United States Circuit Court of Appeals for the 9th Circuit, to reverse the final order and decree rendered and entered by the Circuit Court of the United States, 9th Judicial Circuit, in and for the Northern District of California, in the case entitled Alexander Levison vs. J. Kitchen Jr. Co., No. 14,772, which said final order and decree was rendered and entered in said Circuit Court on the 8th day of August, 1910, being a day in March term, of said Circuit Court, and an appeal allowed superseding said decree.

Now, therefore, if the above-named appellant shall prosecute said appeal to effect, and answer all damages and costs, if it shall fail to make good its plea, then this obligation shall be void, otherwise to remain in full force and effect.

In witness whereof, the seal and signature of said principal is hereto affixed and the corporate name of the said surety is hereto affixed and attested by its duly authorized officer at San Francisco, California, this twelfth day of August, 1910.

[Seal John Kitchen Co.]

JOHN KITCHEN JR. CO.

By JOHN KITCHEN, JR.,

Pres.

[Seal American Bonding Co.]

AMERICAN BONDING COMPANY OF
BALTIMORE,

By JOY LICHTENSTEIN,

Agent and Attorney in Fact.

Approved this 12th day of August, 1910.

WM. C. VAN FLEET,

Judge.

[Endorsed]: Filed Aug. 12, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

**[Certificate of Clerk U. S. Circuit Court to Record
on Appeal.]**

*In the Circuit Court of the United States, Ninth
Judicial Circuit, Northern District of California.*

No. 14,772.

ALEXANDER LEVISON,

Complainant,

vs.

J. KITCHEN JR. CO.,

Defendant.

I, Southard Hoffman, Clerk of the Circuit Court of the United States of America, of the Ninth Judicial Circuit, in and for the Northern District of California, do hereby certify the foregoing two hundred and twenty-eight pages, numbered from 1 to 228, inclusive, to be a full, true and correct copy of the record and proceedings in the above-entitled cause, excepting therefrom the following original exhibits, viz.: Complainant's Exhibits "A," "B," "C," "D," "E," "F," "G," "H," "I," "K," "L," "M," "N," "O," "P," "Q," "R," "S," "T," "U," "V," "W," "X," "Y," "Z," "AA," and "BB," and Defendant's Exhibits Nos. 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13 and 14 (which by order of Court are allowed to be withdrawn and transmitted

herewith as a part of this record), and that the same constitutes the record on appeal to the United States Circuit Court of Appeals, for the Ninth Circuit.

I further certify that the cost of the foregoing Transcript of Record on appeal is \$135.20; that the said amount was paid by Charles E. Townsend, solicitor for defendant, and that the original citation issued in said cause is hereto annexed.

In testimony whereof, I have hereunto set my hand, and affixed the seal of said Circuit Court, this 8th day of September, A. D. 1910.

[Seal] SOUTHARD HOFFMAN,
Clerk of the Circuit Court of the United States,
Ninth Judicial Circuit, Northern District of
California.

[Citation (Original).]

UNITED STATES OF AMERICA,—ss.
The President of the United States, to Alexander
Levison, Greeting:

You are hereby cited and admonished to be and appear at a United States Circuit Court of Appeals, for the Ninth Circuit, to be holden at the city of San Francisco, in the State of California, on the 10th day of September, 1910, being within thirty days from the date hereof, pursuant to an order allowing appeal filed in the Clerk's office of the Circuit Court of the United States, for the Northern District of California, wherein J. Kitchen Jr. Co. is appellant, and you are appellee, to show cause, if any there be, why the Interlocutory Decree rendered

against the said appellant, as in the said order allowing appeal mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable WILLIAM C. VAN FLEET, United States District Judge for the Northern District of California, this 15th day of August, A. D. 1910.

WM. C. VAN FLEET,
United States District Judge.

Service of within Citation, by copy, admitted this 15th day of August, A. D. 1910.

MILLER & WHITE,
Attorney for Alexander Levison.

[Endorsed]: No. 14,772. In the Circuit Court of the United States for the Ninth Circuit, Northern District of California. Alexander Levison vs. J. Kitchen Jr. Co. Citation. Filed August 17th, 1910. Southard Hoffman, Clerk. By J. A. Schaertzer, Deputy Clerk.

[Endorsed]: No. 1900. United States Circuit Court of Appeals for the Ninth Circuit. J. Kitchen Jr. Company (a Corporation), Appellant, vs. Alexander Levison, Appellee. Transcript of Record. Upon Appeal from the United States Circuit Court for the Northern District of California.

Filed September 8, 1910.

F. D. MONCKTON,
Clerk.

Complainant's Exhibit "B."

[Endorsed]: #12,005. A. Levison, Manifold Books. Reissued July 1st, 1902. No. 14,772. In U. S. Circuit Court, Northern District of California. Alex. Levison vs. J. Kitchen Jr. Co. Complainant's Exhibit "B." E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Complainant's Exhibit "B." Received Sep. 8, 1910. F. D. Monckton, Clerk.

(Application filed Mar. 13, 1902.)

Fig. 1

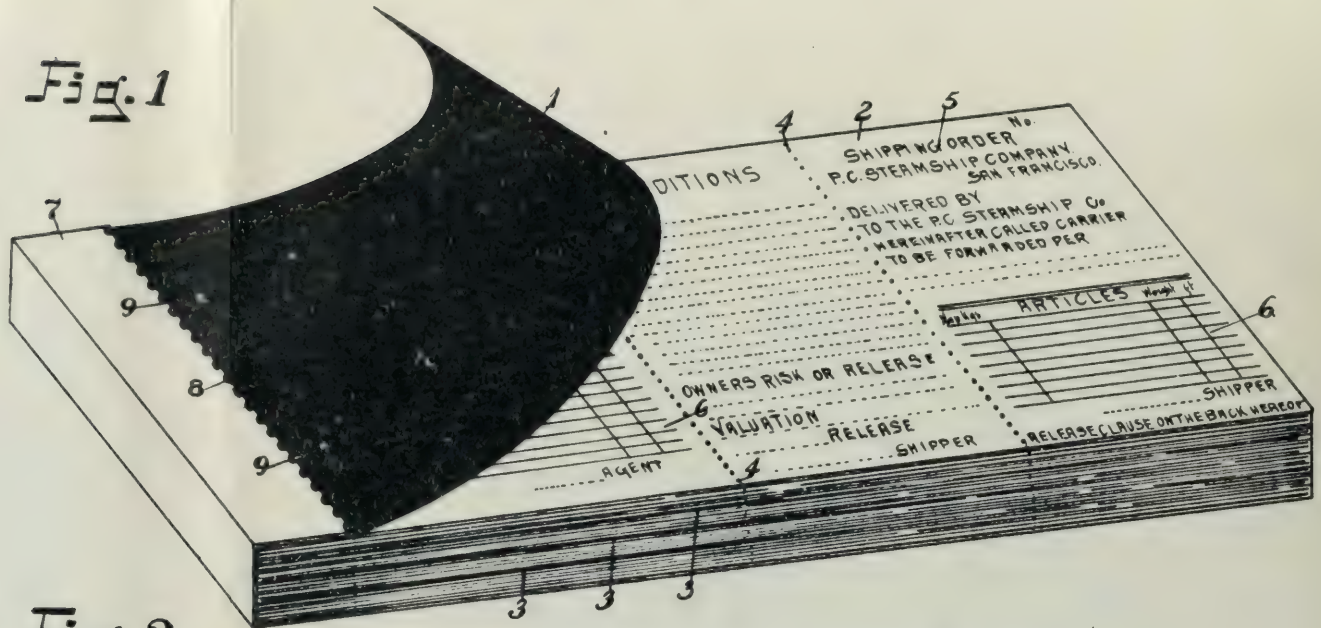


Fig. 2

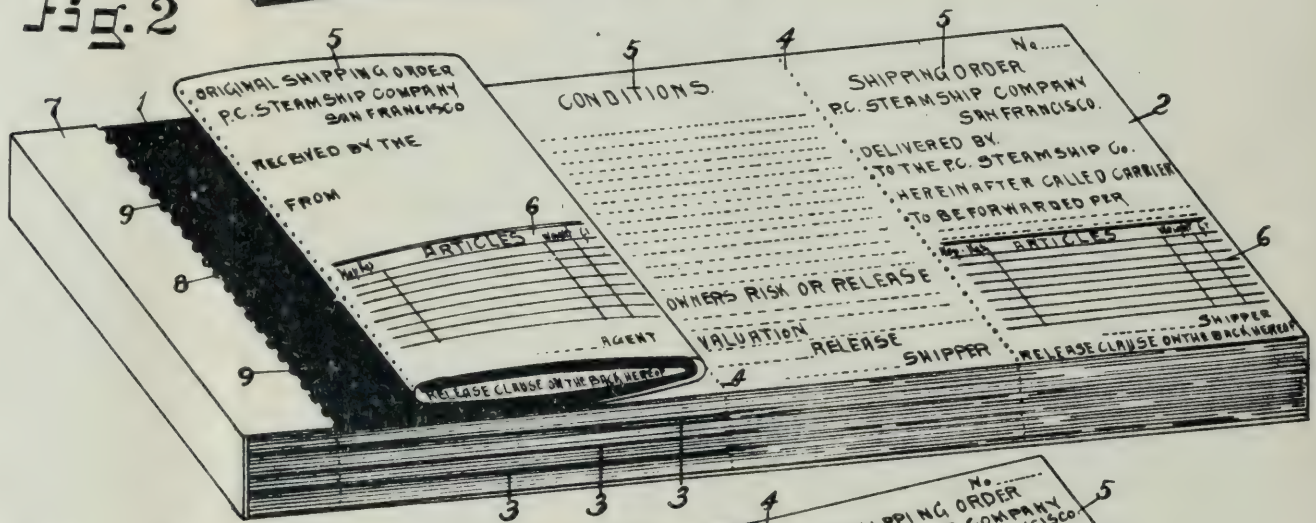
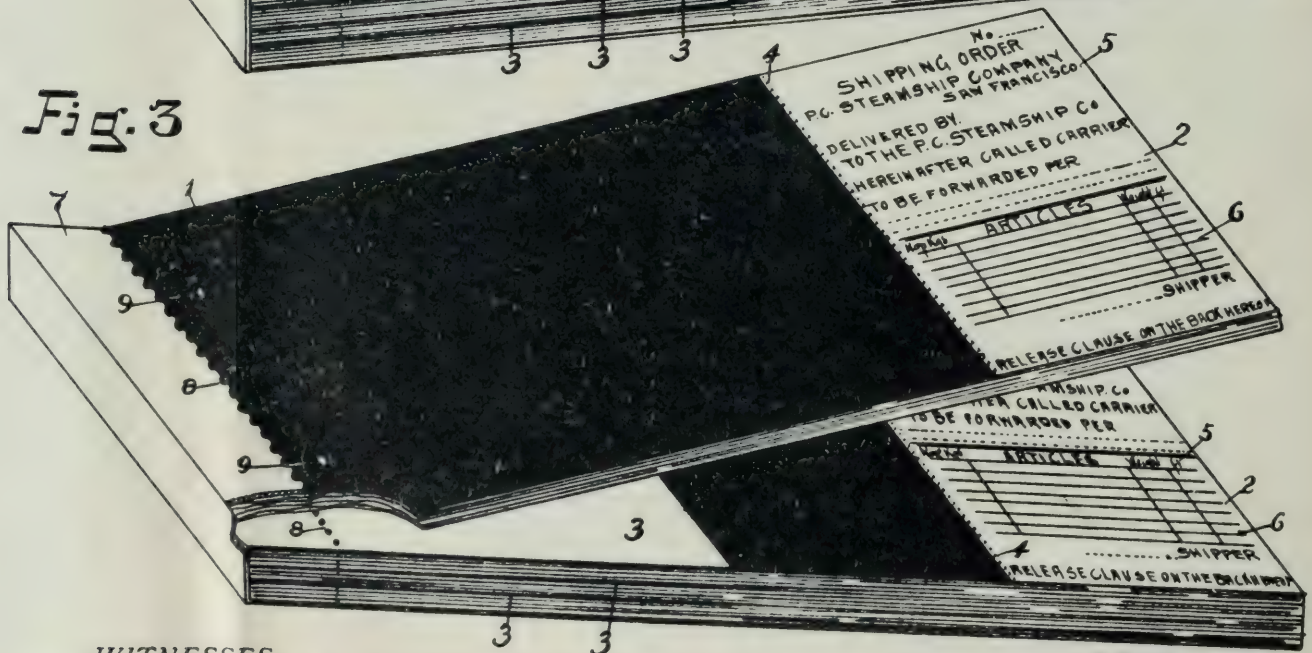


Fig. 3



WITNESSES:

WITNESSES:
Oscar Thune, Earsen.
Bessie Gorfinkel

INVENTOR.

Alexander Levison
BY Francis M. Wright
ATTORNEY.

UNITED STATES PATENT OFFICE.

ALEXANDER LEVISON, OF SAN FRANCISCO, CALIFORNIA.

MANIFOLD-BOOK.

SPECIFICATION forming part of Reissued Letters Patent No. 12,005, dated July 1, 1902.

Original No. 694,103, dated February 26, 1902. Application for reissue filed March 13, 1902. Serial No. 98,113.

To all whom it may concern:

Be it known that I, ALEXANDER LEVISON, a citizen of the United States, residing at San Francisco, in the county of San Francisco and State of California, have invented certain new and useful Improvements in Manifold-Books, of which the following is a specification.

My invention relates to an improved manifold receipt and record book for mercantile, railway, express, or other business uses.

The object of my invention is to provide a book of this character which shall be convenient in use, economical in the number of carbons required, which shall give secure protection against alterations and forgeries, and the sheets of which can be readily and conveniently placed on record after the impression has been taken.

My invention therefore resides in the novel construction, combination, and arrangement of parts for the above ends hereinafter fully specified, and particularly pointed out in the claims.

In the accompanying drawings, Figure 1 is a perspective view of one of my improved manifold-books before use. Fig. 2 is a similar view showing the position when folded for use; and Fig. 3 is a perspective view of the book, a number of sheets being turned up and the book being broken away to show a cardboard backing and carbon-paper.

Referring to the drawings, it will be seen that my improved manifold-book is formed in sections, each section comprising in order, first, a carbon-sheet 1, of about two-thirds the width of the book, then below said carbon-sheet 1 a number of sheets 2, of ordinary paper, the full width of the book; then a sheet 3 of hard thick cardboard. Each record-sheet outside the stub 7 is divided into three substantially equal parts by vertical lines of perforations 4, said parts having suitable printed matter 5 and blank lines 6, whereon to inscribe the desired record. The carbon-sheets 1 are of sufficient width to extend over two of said parts, while the cardboard backing 3 occupies the width of the inner parts only of the sheets above it. The record-sheets and the cardboard backings are attached to stubs 7 along lines of perforations 8, so that they can be readily detached from said stubs, and said

stubs and one side of each carbon-sheet are all bound together to form a book.

In use the record-sheet is first folded on the outer line of perforations 4, so as to cover about one-half of the carbon-sheet, and it is then folded in the same direction on the second line of perforations, so that the carbon is now folded inside of the record-sheet, as shown in Fig. 2. The record will now be written upon what was the back of the middle portion of the sheet when it was flat and unfolded, which will now, however, have come to the top. The carbon-sheet is double or carbonized on both sides, so that a copy of the record will be made upon each of the two terminal parts of the sheet. Also an inverted or backhanded copy of the writing will be formed upon the back of each part, except the inner one. This latter feature gives additional security against subsequent alteration of the record, since it is difficult to erase and rewrite both the original and the reverse copy.

The use of the cardboard backing is to provide a hard substance to form a smooth writing-surface and also to protect the carbon-paper and sheets below it from receiving an impression written upon a sheet above said backing. The inner edge of the inner part of the record-sheet is punched with two holes to facilitate the filing of said part.

It has been already stated that the three separable parts of each recording-sheet are substantially equal. They are not exactly equal, since it is preferable to provide the innermost part with an unprinted additional space or margin next the stub through which are punched the holes 9 to facilitate the filing of said part. Moreover, it is better to leave a small space between the edge of the sheet when folded and the line of perforations 8, as this renders it easier to fold the parts. With this exception the separable parts of each recording-sheet are of the same size and in general will contain identical printed matter thereon.

The advantages of the above construction are that any kind of paper can be used for the record-sheets, and the construction does not require any transparent paper. The carbon naturally falls into the position for use for the next record-sheet when one record-

sheet has been removed and the record-sheet is very readily folded in the desired manner, the fold being twice in the same direction. The device is economical of carbon-paper.

5 The cardboard backings are an important feature of my invention, since they permit a large number of sheets to be bound into a book with a small number of carbons without any danger of transmitting an impression from one sheet to another sheet. They are readily removable by means of the lines of perforations when all the sheets above them have been used.

I claim—

15 1. A manifold-book composed of sections, each section comprising in order a double carbon-sheet, a plurality of recording-sheets, and a cardboard backing, the record-sheets outside the stubs being divided into three
20 substantially equal separable parts, the carbon-sheets extending the width of two of said parts, and the cardboard backing extending the width of one of said parts, said recording-sheets and backings having stubs
25 to which they are attached along lines of perforations, said stubs and one side of each carbon-sheet being all bound together to form a book, substantially as described.

2. A manifold-book comprising in order a
30 double carbon-sheet, a plurality of recording-sheets, and a cardboard backing, the record-sheets outside the stubs being divided into three substantially equal separable parts, and the carbon-sheet extending the width of
35 two of said parts, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet and backing being all bound together to form a book, substantially
40 as described.

3. A manifold-book comprising in order a

double carbon-sheet, and a plurality of recording-sheets, the record-sheets outside the stubs being divided into three substantially equal separable parts, and the carbon-sheet extending the width of two of said parts, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.

4. A manifold-book comprising in order a double carbon-sheet, and a plurality of recording-sheets, each of said sheets outside the stubs being divided into a plurality, not less than three, of substantially equal separable parts, and the carbon-sheet extending the width of said parts except the outermost, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.

5. A manifold-book comprising in order a double carbon-sheet, and a plurality of recording-sheets, each recording-sheet outside the stub being divided into a plurality not less than three of separable parts joined along lines of perforations, each part being not greater than the part next it on the side toward the stub, and the carbon-sheet extending the width of the whole of said parts except the outermost, said recording-sheet having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.

A. LEVISON.

Witnesses:

FRANCIS M. WRIGHT,
BESSIE GORFINKEL.

Complainant's Exhibit "C."

	Peerless.	Machine.	Duplex.	Baker Vorter.
Mission St.				
Whittier Coburn Co.....	1			
Pacific Pipe Co.....	1			
Paynes Bolt Works	1			
J. A. Folger		1		
Corson Gas Engine Co.....	1			
Brandstein		1		
Chevalier Co.....	1			
Pacific Steel & Supply Co.....	1			
Pacific Tool & Wire Co.....	1			
Pacific Coast Rubber Co.....	1			
Jones Drayage Co.....	1			
C. C. Moore Co.....	1			
Pacific Mill & Supply Co.....	1			
Pennsylvania Rubber Co.....	1			
Richardson & Berlin		1		
F. A. Worth Drayage Co.....	1			
Eureka Boiler Works	1			
Studebaker Bros.....	1			
Libby & McNeil	1			
Helbing Hat Co.....	1			
W. P. Fuller Co.....	1			
Union Gas Engine Co.....	1			
DeFremery & Co.....	1			
Shea, Bocqueraz & Co.			1	
Neustadter Bros.....	1			
Hollabird & Reynolds	1			
Laventhal & Co.....	1			
Cahn, Nickelsburg Co.....	1			
Mangram, Otter Co.....		1		
Troy Laundry Machinery Co.....	1			
American Drug Co.....	1			
Wallenstein & Hanly	1			
Mauzy Reid Shoe Co.....	1			
Buckingham & Hecht Co.....		1		
Diamond Rubber Co.....	1			
George H. Tay Co.....	1			
Dolliver & Bros.....	1			
Gosliner & Co.			1	

	Peerless.	Machine.	Duplex.	Baker Vorter.
Sloane & Co.....	1			
Keystone Type Foundry	1			
Gerson Breyer Co.....	1			
Lemle Levy Co.....	1			
Library Bureau	1			
Western Builders Supply Co.....	1			
Oberdeener Co.....	1			
Howard St.				
Garlock Packing Co.....	1			
Conreich & Co.....	1			
William Marvin Co.....		1		
Jesse Moore Hunt Co.....	1			
Kinney & Co.....	1			
Occidental Supply Co.....	1			
Western Tool Co.....			1	
Thompson Drayage Co.....			1	
Crane & Co.....	1			
E. A. Howard & Co.....	1			
Allens & Higgins Lumber Co.....	1			
Standard Copper Works	1			
White Bros.....	1			
H. N. Cook Belting	1			
Abner Doble Co.....	1			
Ward & Son	1			
Butter Drayage Co.....	1			
Barton Squires Co.....	1			
Continental Steel & Supply Co.....	1			
Nolan Drayage Co.....	1			
H. M. Rogers Co.....	1			
Pratt & Lambert	1			
Egan Shoe Co.....	1			
Folsom St.				
Rosenblatt		1		
S. O. Meyer Mfg. Chemist	1			
G. W. Caswell Co.....		1		
Schilling Tea Co.....	1			
Lally & Co.....	1			
	<hr/>	<hr/>	<hr/>	
	61	7	4	

	Peerless.	7 Machine.	4 Duplex.	Baker Vorter.
Total forward.....	61			
Fairbanks, Morse Co.....	1			
Simonds Saw Works	1			
Johns Manville Co.....	1			
Steuart St.				
Ray Manufacturing Co.....	1			
Squires Byrnes Co.....	1			
Morton Special Delivery Co.....	1			
McGriffick & Co.	1			
People's Express Co.....	1			
Great Western Smelting Co.	1			
Spear St.				
Sperry Flour Co.....	1			
Sussman Wormser Co.....	1			
DeLano Bros.....	1			
Seller Bros.....	1			
Kuhls, Schwarke Co.....	1			
Mission St.				
Rothschild				1
Heyman, Weil Co.....	1			
Goldstone	1			
Greenebaum, Weil & Michels	1			
California Blanket & Flannel Mills.....	1			
Samter & Co.....	1			
Eastman Kodak Co.....	1			
Mandel, Weiner Co.....	1			
Main St.				
J. Whelen & Co.....	1			
Foucar, Ray & Simon.....	1			
Taber, Bigelow Co.....	1			
Hasford Bros.....	1			
S. Foster	1			
H. Peterson & Co.....		1		
Wilmerding, Loewe Co.....	1			
Josselyn Co.....	1			
Plant Rubber Co.....	1			
Wm. Wolf Co.....	1			
Whittier, Coburn Co.....	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.
Greenberg & Son.....	1			
Murray Bros.....	1			
Merten & Co.....	1			
Beale St.				
Sun Tent & Awning Co.		1		
Jos. Wagner			1	
Sherwood & Sherwood	1			
Anglo-American Crockery Co.....	1			
John Wehthe Co.....	1			
A. Pickthall	1			
Fremont St.				
Jones, Paddock Co.....	1			
A. J. Rankin	1			
H. Bohls Co.....	1			
Eberhard & Co.....	1			
Engineering Maintenance Co.....	1			
Woodin & Little	1			
Henshaw, Bulkley	1			
Grafton & Knight	1			
Gorham Rubber Co.		1		
Asbestos Manufacturing Co.....	1			
Hale Bros.....	1			
Union Transfer Co.....	1			
Second St.				
Goodyear Rubber Co.....	1			
A. & J. R. Cook.....	1			
Wieland Brewery	1			
Sterling & Co.....	1			
H. Campe	1			
Keystone Bros.....	1			
Scattering.				
Ulman, Seeligshon & Brown	1			
Johns, Manville Co.....	1			
Farnsworth Electrical Co.....	1			
Brooks, Follis Co.....	1			
Sterling Electrical Co.....		1		
Standard Electrical Co.....	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.
First St.				
Langley, Michels	1			
Eagleson, Hawkins Co.....	1			
Gutta Percha Rubber Co.....	1			
Eccles, Smith Co.....	1			
C. W. Marwedel Co.....	1			
Revers Rubber Co.....	1			
Bonestell & Co.	1			
	128	11	5	1
Total forward	128	11	5	1
Mees & Gottfried	1			
San Francisco Mill Furnishing Co.....	1			
Pacific Sheet Metal Works.....	1			
Fairbanks, Morse Co.....	1			
Simond Manufacturing Co.....	1			
J. H. Butcher		1		
Selby Smelting & Refining Co.....	1			
Jackson Iron Works	1			
Golden State & Mission Iron Works.....	1			
California Ink Co.....	1			
Spottswood-Helfer Co.....	1			
Grant Leonard & Co.....	1			
Scattering.				
Brown Forman Co.	1			
E. Goslinsky Co.	1			
Lachman Jacobi	1			
Arata Barbieri Co.	1			
Marani & Cassi Co.	1			
Mission St.				
McLeod Hatje Co.	1			
San Francisco Casket Co.	1			
Livingston Co.	1			
Taussig Co.	1			
Nonotuck Silk Co.	1			
Pacific Heater & Blower Co.	1			
Chemical Engine Co.	1			
Davis & Son	1			
Harband Bros.	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.
Broadway Brewing Co.	1			
Jacob Unna	1			
Brunswick-Balke-Collender Co.	1			
Hirschfelder & Meany	1			
Henry Rhine Co.	1			
Sunset White Lead Works	1			
Crescent Feather Co.		1		
Pelton Water Co.	1			
Enterprise Foundry	1			
Long Syrup Co.	1			
California Paper Box Co.	1			
Mission Soap Co.	1			
L. P. Degnan Co.	1			
Steiger Kerr Stove Co.	1			
H. Freiderichs	1			
C. A. Malm Co.	1			
Schlesinger & Bender	1			
Gottfried Meese Co.	1			
Great American Importing Tea Co.	1			
John P. Cleese Co.	1			
McRoskey Co.	1			
Harry Johnson Co.	1			
Ruhstaller Beer Co.	1			
French American Wine Co.	1			
³ Jackson St.				
H. C. Fisher	1			
Standard Biscuit Co.		1		
A. Guilani & Co.	1			
J. Revalk	1			
A. Cora	1			
Berton & Leport	1			
³ Columbia Paste Co.	1			
Brizzolara & Sons	1			
Cutter Drayage Co.		1		
Geoffrey Drayage Co.	1			
Garcia & Maggini	1			
Scatena Co.	1			
Oliveto Wine Co.	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.
Washington St.				
C. C. Moore Co.	1			
Coughlin Drayage Co.	1			
Statson Renner Co.	1			
William Peck Co.				1
Western Fish Co.	1			
Kohlberg Co.	1			
D. N. Schoenfield	1			
L. R. Podesta	1			
	<hr/> 194	<hr/> 15	<hr/> 5	<hr/> 2
Total forward	194	15	5	2
Hetteride & Co.	1			
Cerruti Mercantile Co.	1			
Brown Strauss Co.	1			
A. Sonntag Co.	1			
Milan Cerrera	1			
Lubert & Escola	1			
Joundin Co.	1			
Joundin Co.	1			
H. Zanco Co.	1			
Ivanovich Co.	1			
California Produce Co.	1			
Chambers, Lemos & Hanscom	1			
Jacob Malcolm	1			
Scatena Co.	1			
San Francisco Produce Co.	1			
Castenetti Belt Co.			1	
N. Botto Co.	1			
Clay St.				
Voohries Co.	1			
Moorehouse, Nelson & Le Baron	1			
L. R. Lazerlere		1		
Wichmans-Lutgen Co.		1		
Marshall Reimers Co.	1			
Fred B. Haright	1			
McCullough	1			
Benjamin Harris Co.	1			
Makins Produce Co.	1			

	Peerless.	Machine.	Duplex.	Baker Vortex.
Bishop & Co.	1			
Kron Tanning Co.	1			
Louis Zeiss & Sons	1			
Mitchell & Goodall	1			
Levy & Zettner		1		
Hunt-Hatch Co.	1			
Giovanni Co.	1			
Simon Levy Co.			1	
Adolph Hariss	1			
Giovanni & Pera	1			
Claudius & Co.	1			
Green & Foster	1			
Felix Coblitz	1			
Schlengel & Co.	1			
Pacific Drayage Co.	1			
Bray Bros.	1			
Jacobsen Reimers Co.	1			
Paul Keyser Co.			1	
M. D. Kant	1			
Smith Leyden Co.	1			
Vonn Ronn Lohrsbach	1			
Courier Produce Co.	1			
English Wallace Co.	1			
Sansome St.				
Hildebrandt-Posner Co.	1			
Roth, Bloom Co.	1			
Guggenhime Co.	1			
Murphy-Grant Co.	1			
Heller Klein Co.	1			
Johnson Locke Co.	1			
Rothenberg Co.	1			
Sevin Vincent Co.			1	
Wilner Bottle Supply Co.			1	
C. Nauman Co.	1			
Battery St.				
L. Dinkelspiel Co.	1			
Levi Strauss Co.	1			
Eloesser Heyneman Co.			1	
Willard Bros.	1			

	Peerless.	Machine.	Duplex.	Baker Voter.
Cartan, McCarthy Co.	1			
S. H. Frank	1			
B. Seiller	1			
Davis St.				
Farnsworth, Ruggles Co.	1			
Wheaten Harrold Co.		1		
San Francisco Drayage Co.	1			
Kilmer & Co.	1			
James Force Co.	1			
	<hr/>	<hr/>	<hr/>	<hr/>
	256	19	11	2
Total forward	256	19	11	2
E. A. Fargo & Co.	1			
Snook & Co.	1			
Front St.				
Atlantic Fish Co.	1			
Galli Fruit Co.				1
M. Wetmore Co.			1	
Minaker	1			
Eveleth Nash Co.	1			
Growers Protective Assn.			1	
Levaggi, Granucchi & Garibaldi	1			
Sanford Co.	1			
Ballinger	1			
North American Mercantile Co.	1			
Sutter Home Wine & Distilling Co.	1			
California Fireworks Co.	1			
Western Transfer & Storage Co.	1			
M. A. Gunst Co.	1			
Klatt & Hirsch Co.	1			
Thos. E. Dunne Co.	1			
H. Helbash Co.	1			
Hyland & Jarvis	1			
Levinson & Co.	1			
Battery St.				
Heyneman & Co.	1			
J. Bollman Co.	1			
Chas. F. Thierbach	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.
Ami Vignier Co.	1			
Pacific States Type Foundry	1			
D. De Bernardi & Co.	1			
Irvine & Co.	1			
Newton Gum Co.	1			
Saroni & Co.	1			
Standard Gas Engine Co.	1			
Front St.				
Levaggi & Co.	1			
Hammer & Co.	1			
Onesti & Ducati	1			
J. N. Sresovich Co.	1			
Hopkins Co.	1			
Jos. Herrescher Co.	1			
Roussell Davidson	1			
South San Francisco Packing Co.			1	
Sherry Frietas Co.	1			
Rothsberger Co.	1			
L. T. Snow	1			
Rothenberg Co.	1			
Ehrman Bros.	1			
Moorehouse Co.	1			
Demartini Co.	1			
L. E. Boyle	1			
Western Wire Equipment Co.	1			
Justinian Caire Co.	1			
Davis St.				
Marshall Taggart Co.	1			
Herman Heyneman	1			
Ivancovich Trobock	1			
Ragoletti Corosi	1			
Portuguese Commercial Co.	1			
Getz Bros.	1			
C. Baldochi			1	
Olcese & Co.	1			
Pacific Produce Co.	1			
L. Harter Co.			1	
Wetzell & Baker	1			
Harburgh & Co.	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.
Haas Co.	1			
McNab & Smith	1			
Repsold & Co.	1			
Drumm St.				
Otzen & Co.	1			
W. A. Plummer	1			
Jacobsen Malcolm	1			
Dunbar & Harris	1			
Jones & Erlanger	1			
Schultz & Hansen	1			
Kingan	1			
	<hr/>	<hr/>	<hr/>	<hr/>
	321	19	16	3
Total forward	321	19	16	3
Messrs. Garcia & Maggini Co.	1			
Cutter & Co.	1			
Welsbank & Co.	1			
Harris, Roder & Wetherbee	1			
California Fruit Cannery Assn.	1			
Horn & Co.	1			
Morris Bros.	1			
Kinsman, Grimes & Miller	1			
De Lavel	1			
Martin Dangiers				1
South of Folsom St., West of Third St.				
C. F. Weber & Co.	1			
A. C. Boldeman & Co.	1			
Great Western Meat Co.		1		
Geo. H. Croley	1			
Geo. Thompson	1			
Winsor Patent Terra Cotta Works	1			
Van Arsdale Harris Lumber Co.	1			
Nehouse Hardware Co.	1			
Union Transfer Co.	1			
John Horstman Co.	1			
S. H. Harmon Lumber Co.	1			
Ocean Shore Iron Works	1			
Rulofsen Metal Works	1			

	Peerless.	Machine.	Duplex.	Baker Vorter.	McNutt, Kahn.
Cribben & Sexton	1				
Carl Cooperage Co.	1				
California Saw Works	1				
K. C. Schmidt	1				
Shasta Water Co.			1		
Eilers Music Co.	1				
D. N. & E. Walter & Co.	1				
Homes Lime Co.	1				
Robinson Co.	1				
Redwood Lumber Co.	1				
Lyons-Raas Co.	1				
Valvoline Oil Co.	1				
Guittard Co.	1				
Phoenix Furniture Co.	1				
Milwaukee Furniture Co.	1				
Standard Wall Paper Co.	1				
Midvale Steel Co.	1				
J. R. Cole	1				
Yates			1		
Lansing Wheelbarrow Co.	1				
American Electrical Novelty Co.	1				
Royal Heating Co.			1		
Jesse M. Levy Co.	1				
M. Friedman & Co.	1				
Western Basket Co.	1				
C. G. Clinch	1				
Pacific Oil & Lead Co.	1				
M. E. Moraghan Oyster Co.	1				
Nevada Gypsum Co.	1				
Western Asbestos Magnesia Co.			1		
United Cigar Co.	1				
Sunset Feather Co.	1				
Enterprise Paper Box Factory Co.	1				
Riddle Bros.			1		
California Artistic Metal & Wire Co.	1				
N. K. Davis Machine Works				1	
Western Art Metal Works	1				
Patek & Co.	1				
Swift & Co.	1				
Shasta Water Co.				1	

	Peerless.	Machine.	Duplex.	Baker Vorter.	McNutt, Kahn.
Winsor Pottery Co.	1				
Aetna Mills					1
Pacific Butcher Supply Co.	1				
Lamson Cash & Parcel Express	1				
Seovel Iron Store Co.					
California Art Glass Co.			1		
Raisin & Zabura			1		
O. N. Nelson			1		
Sterling Furniture Co.	1				
Royal Worcester Corset Co.	1				
	<hr/>	<hr/>	<hr/>	<hr/>	<hr/>
	380	20	24	6	1
Total forward	380	20	24	6	1
Mission St.					
E. E. George Shoe Co.	1				
A. Armier Co.	1				
Whitaker Ray	1				
Golden Gate Yeast Co.	1				
Berger Manufacturing Co.	1				
T. H. Meek	1				
Builders Supply Co.	1				
Emporium	1				
De Laporte	1				
Eng Skell Co.	1				
Consolidated Electric Appliance Co.	1				
Marwedel & Co.	1				
Thomas Co.	1				
Roth Herbert Co.	1				
U. S. Faucet Co.	1				
Boesch Lamp Co.	1				
A. Galet	1				
Tyndall			1		
Hoffman Robinson	1				
California Casket Co.	1				
Roberts Mfg. Co.	1				
Son Bros.	1				
Indianapolis Furniture Co.	1				
Naber, Alfs & Brune	1				
California Upholstery Co.					1

	Peerless.	Machine.	Duplex.	Baker Vort.	McNutt, Kahn.
Bernhardt Mattress Co.	1				
O'Rourke Eubanks Hat Co.	1				
The Elkus Co.	1				
Folsom St.					
Geo. Solch Co.	1				
Parks Bros.	1				
Charles Harley	1				
Holt	1				
R. B. Moore Lumber Mill Co.	1				
Atalass Brass Works	1				
American Faucet Co.	1				
Pacific Preserve Co.			1		
Heywood Bros. & Wakefield Co.	1				
Joost Bros.			1		
Penn Hardware Co.	1				
Mission St., between First and Third Sts.					
Serwe & Prien	1				
Emerson Drug Co.	1				
Johansen Bros. Shoe Co.	1				
Laventhal Bros.	1				
American Druggist Syndicate	1				
Jas. Thieben			1		
Thompson Glove Fitting Corset Co.	1				
Whitall Tatum Co.	1				
Wm. Grosse	1				
F. C. Anderson	1				
Scattering.					
Electric Hose Rubber Co.	1				
Oceanic Wholesale Co.	1				
Imperial Cash Store	1				
Spiro Harness Co.	1				
J. O. Kane			1		
Mission St.					
Gerson & Breyer	1				
Lemle Levy Co.	1				
Louis Strauss	1				
Fort Wayne Electric Works	1				
Pleasanton Drayage Co.	1				

	Peerless.	Machine.	Duplex.	Baker Vorter.	McNutt, Kahn.
Waldron & Deitrich Co.	1				
Moore & Shahan			1		
Western Builders Supply Co.	1				
Main St.					
U. S. Glass Co.					
Herman Safe Co.	1				
J. Spencer Turner Co.	1				
Bergfeldt Co.	1				
Olson & Cook	1				
Oceanic Express Co.	1				
A. J. Gordon	1				
W. R. Bunting Drayage Co.	1				
Herzog & Dahl	1				
	<hr/> 443	<hr/> 20	<hr/> 30	<hr/> 6	<hr/> 1
Total forward	443	20	30	6	1
Main St.					
Simpson & Fisher	1				
E. Henrix	1				
Main St. Iron Works	1				
Howe Scale Co.	1				
Moore & Scott			1		
Thos. F. Maher			1		
Enterprise Foundry		1			
Liberty Iron Works	1				
Golden Gate Gas Eng.			1		
California Tool Works.....	1				
South of Market, East of Third.					
Thos. Wagner			1		
Krough Mfg. Co.	1				
Ramona Candy Co.	1				
Thos. W. Collins	1				
Repold Select Vintage	1				
National Cash Store	1				
Saalburg Co.	1				
Waterbury Co.	1				
Western Creamery Co.			1		

	Peerless.	Machine.	Duplex.	Baker Vorter.	McNutt. Kahn.
Waldorf-Astoria Cigar Co.	1				
W. G. Stafford Co.	1				
Swain & Anderson	1				
J. R. McGuffick Co.	1				
Ford Barstown Co.			1		
J. R. Wilson	1				
Oakland Parcel Delivery	1				
Matthew Turner Co.	1				
Carley Drayage Co.	1				
Haviside, Withers & Davis	1				
Staples & Pfeiffer	1				
Morrison & Bevilockaway			1		
Peoples Express Co.	1				
Marshall Newell Supply Co.	1				
W. T. Garratt Co.	1				
Hills Bros.				1	
C. H. Evans	1				
Oscar Krenz Copper & Brass Wks.			1		
Betts Spring Works					1
Corliss Gas Engine Works			1		
Alaska Pacific S. S. Co.	1				
Keystone Boiler Works	1				
Easton Coal Co.			1		
Central Coal Co.	1				
Western Fuel Co.	1				
Union Fish Co.	1				
Oliver Salt Co.	1				
Western Iron Works	1				
Farren Hardware Co.	1				
Phoenix Tool & Valve Co.	1				
Blakeway Sheet Metal Works			1		
Sanders Copper Works	1				
Los. Dos Naciones Cigar Co.	1				
Imperial Whiskies	1				
Hamburger & Co.	1				
Newman Bros.	1				
Chauche & Bon			1		
Renald & Beebe			1		
A. Lazansky & Co.	1				
Schwarz Gottlieb	1				

	Peerless.	Machine.	Duplex.	Baker Vorter.	McNatt, Kahn.
Bancroft Whitney	1				
West Disinfecting Co.	1				
James Barker Co.	1				
Geo. Breck Co.	1				
Milton & Bradley	1				
California Hydraulic Co.	1				
Roman & Thomas	1				
Compressed Air Machinery Co.	1				
Smith Roberts Co.	1				
Crown Distilleries Co.	1				
Worthington Co.			1		
Geo. E. Dow Pump Works	1				
	497	21	44	7	2
	—	—	—	—	—
Total forward	497	21	44	7	2
South of Market, West of Fourth.					
Redwood Manufacturing Co.	1				
Seymour & Elliot	1				
Haslett Warehouse Co.	1				
King & Co.	1				
Hartwood Lumber Co.	1				
Wilson Bros. & Co.			1		
W. A. Miller			1		
W. A. Magner Co.	1				
Union Oil Co.	1				
Doak Steel Co.	1				
Francis Smith Co.					1
Union Machine Co.	1				
Enterprise Foundry	1				
California Plumbing Supply Co.	1				
Pacific Bone Coal & Fertilizing Co.			1		
Scattering.					
Murphy Grant Co.	1				
Carlson Currier Co.	1				
Hirsch & Kaiser	1				
Edmusn Leowe Co.	1				
H. Semeria	1				
A. Shirek & Sons	1				
Washauer Bros.	1				

	Peerless.	Machine.	Duplex.	Baker Vorter.	McNutt, Kahn.
L. Kline Co.	1				
B. Schmidt	1				
Heller Klein	1				
Bauer Bros.	1				
California Fireworks Co.	1				
P. A. Smith Co.	1				
Sherman Clay Co.	1				
Scharlach Hat Co.	1				
Martin, Dangers & Emerson				1	
W. A. Plummer	1				
Spohr & Co.	1				
City of Hamburg	1				
Galli & Co.				1	
Goldberg, Bowen & Co.	1				
Kisen Co.	1				
Ciocca Lombardi Co.	1				
Merle Co.	1				
Del Monte Milling Co.	1				
South of Market, West of Ninth.					
Kinspel Co.			1		
McNamara & Moran	1				
Hogan & Co.	1				
Oest & Co.	1				
D. Woerner Co.	1				
Illinois Glass Works				1	
Oakland Art Pottery Co.	1				
City Street Improvement Co.	1				
Mission Stove Works	1				
Wolf Lumber & Hardware Co.			1		
Paraffine Paint Co.	1				
Robinson Chemical Co.	1				
Bay City Iron Works	1				
Schrader Iron Works	1				
Consumers Ice Co.			1		
Ruffino & Bianchi	1				
Haines-Jones & Cadbury	1				
Arnstein Simon	1				
Berger, Carter Co.	1				
Somers Hay Co.	1				
	547	21	50	10	3

	Peerless & Machine.	Peerless & Duplex.	Peerless & Baker- Vortor.
Scattering.			
Cluff Bros.			1
Braun-Knecht-Heimann Co.	1		
Dalzelle Moeller Co.	1		
Berry Co.			1
Winslow ...	1		
Robling Wire Works	1		
Waterhouse & Lester	1		
Norton Teller Co.	1		
Electric Appliance Co.	1		
M. Getz	1		
Redington & Co.			1
Steiger Pottery Co.		1	
Newbour & Co.	1		
Columbia Coffee & Spice Co.		1	
Collins & McCarthy	1		
Zellerbach Paper Co.	1		
James & Hug	1		
Pacific Coast Syrup Co.	1		
E. Harris & Neville	1		
Smith Co.	1		
Wieland Bros.			1
Johnsons Harness & Saddlery Co.	1		
Electric Appliance Co.	1		
Sadler Co.	1		
Western Electric Co.	1		
Sherwin Williams Co.	1		
Fleischmann Co.	1		
Jos. Graham Mfg. Co.	1		
S. Bachman & Co.		1	
Cyclops Iron Works		1	
Rainier Beer Co.	1		
John Wood Manufacturing Co.		1	
N. Meyer Cigar Co.		1	
	—	—	—
	23	6	4

STATIONERS USING PEERLESS BOOKS.

Brown & Power.
 Le Count, Clark & Ormond.
 Dixon, Fish Co.
 Payot, Strarford & Kerr.

Standard Office Supplies.
 Hicks Judd Co.
 Isaac Upham Co.
 Sanborn Vail Co.
 Schwabacher Frey.
 Shapro Co.
 H. S. Crocker Co.
 Cunningham, Curtis & Welch.
 Ehrlick Bros.
 Rogers Stat. Co.
 Carlisle & Co.
 Hardy & Smith.
 E. H. Wobber.
 Emporium.
 McNutt, Kahn Co.

RECAPITULATIONS.

Peerless, (exclusive)	547
“ (combined)	33
Stationers selling Peerless	19

Total Peerless	599	PEERLESS.
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Machine, (exclusive)	21
“ (combined) with Peerless	23

Total	44	MACHINE.
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Duplex, (exclusive)	50
“ combined with Peerless	6

Total	56	DUPLEX.
-----------------	----	---------

Baker Varter (exclusive)	10
“ “ combined with Peerless	4

Total	14	BAKER VORTER.
-----------------	----	---------------

McNutt, Kahn	3	McNUTT, KAHN.
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[Endorsed]: List of Names Compiled by Mr. Williams. No. 14,772. In U. S. Circuit Court, Northern District of California. Alex. Levison vs. J. Kitchen Jr. Co. Complainant's Exhibit "C." E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Complainant's Exhibit "C." Received Sep. 8, 1910. F. D. Monckton, Clerk.

Defendant's Exhibit No. 1.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Defts. Exhibit No. 1. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 1. Received Sep. 8, 1910. F. D. Monckton, Clerk.

(No Model.)

H. G. & J. B. BARLOW.
 DEVICE FOR MANIFOLD COPYING.

No. 297,556.

Patented Apr. 29. 1884.

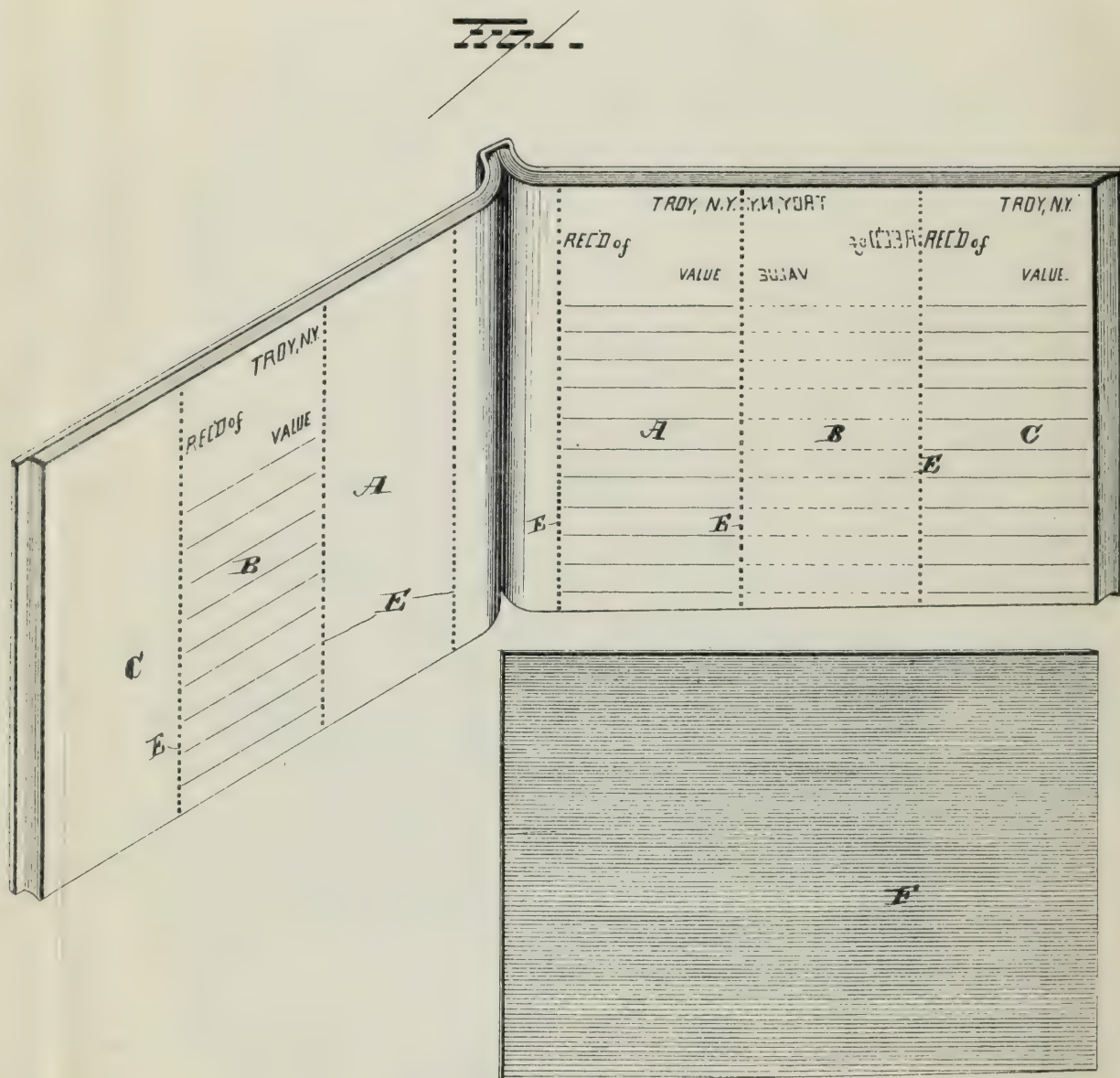
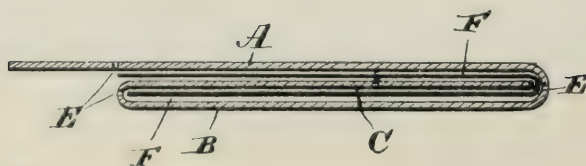


FIG. 2.



WITNESSES

S. G. Nottingham
 Geo. P. Downing

INVENTOR

H. G. Barlow
 J. B. Barlow.
 B. H. S. Sumner, Attorney

UNITED STATES PATENT OFFICE.

HEMAN G. BARLOW AND JOHN B. BARLOW, OF GRAND RAPIDS, MICH.

DEVICE FOR MANIFOLD COPYING.

SPECIFICATION forming part of Letters Patent No. 297,556, dated April 29, 1884.

Application filed September 20, 1883. (No model.)

To all whom it may concern:

Be it known that we, H. G. BARLOW and J. B. BARLOW, of Grand Rapids, in the county of Kent and State of Michigan, have
5 invented certain new and useful Improvements in Devices for Manifold Copying; and we do hereby declare the following to be a full, clear, and exact description of the invention, such as will enable others skilled in the art to
10 which it appertains to make and use the same.

Our invention relates to an improvement in devices for manifold copying, the object being to facilitate the preparation of duplicate copies of writing by reducing the number
15 of detached copying and blank sheets to the minimum.

With these objects in view our invention consists of blank sheets divided into three equal sections by lines of perforations, and
20 printed in the manner herein shown and described, whereby the sections may be folded upon each other with a single sheet of copying-paper in such manner that matter written upon one section will be reproduced upon the
25 other two.

In the accompanying drawings, Figure 1 is a view showing one side of one sheet and the opposite side of a similar sheet, and Fig. 2 is an end view of the blank as it appears when
30 folded with a sheet of copying-paper having both of its faces carbonized.

The blanks are divided into three equal sections, A, B, and C, by lines E of perforations, which adapt the sections to be folded upon
35 each other, and to be separated and distributed as required. The sections A and C are printed upon the same face of the blank, while the section B is printed upon the opposite face thereof.

The arrangement of the printing upon the sections is clearly shown in Fig. 1 of the drawings. It should be observed that the printing is arranged so that when the sections are folded upon each other the blank spaces be-
40 tween the printed lines will register. The copying-sheet F (shown in Fig. 2 of the drawings) is supposed to be carbonized on both sides; but paper carbonized on one side will

do as well, though perhaps not quite as convenient to handle. 50

In using the paper having both faces carbonized, a sheet of sufficient size to cover two of the three sections of each blank is employed. Such a sheet is laid over the printed side of section A and the unprinted side of
55 section B. The section C is now folded to the left and laid upon the copying-paper covering the unprinted side of the section B. Then the two sections B and C, with the interposed copying-paper, are folded to the left and
60 laid upon the copying-paper covering the section A. The printed surface of the section B becomes the uppermost, as the result of folding the blank in the manner described, and this section is accordingly written upon
65 with a pencil, and the matter written is duplicated upon each of the sections A and C. When copying-paper having only one side carbonized is employed, a sheet sufficiently large to cover the entire blank is laid, with
70 its carbonized face down, upon that surface of the blank exposing the printed side of the sections A and C. The outer end of the copying-paper, is then folded to the left to the width of one section of the blank, to ex-
75 pose its carbonized face to the printed side of the section C, which is now folded upon it. The sections B and C, with the interposed copying-paper are then folded upon the section A, and the printed surface of the section
80 B, being uppermost, is written upon with a pencil, with the effect before described.

It will be seen that with one blank sheet, and with a single sheet of carbon-paper, two duplicates of the written matter are produced,
85 whereas two detached sheets of copying-paper have heretofore been necessary to get the same number of copies. The old method is objectionable on account of the number of sheets to be adjusted and cared for, and to the
90 shipping-clerk, who carries the sheets from place to place, the handling and care of the sheets is a source of great annoyance.

Having fully described our invention, what we claim as new, and desire to secure by Letters
95 Patent, is—

An improved blank for manifold copying, consisting of a sheet of paper divided into three equal sections by lines of perforations, and printed in the same manner herein shown and
5 described, whereby the sections may be folded upon each other with a single sheet of copying-paper, in such manner that matter written upon one section will be reproduced upon the other two, substantially as set forth.

In testimony whereof we have signed this specification in the presence of two subscribing witnesses.

HEMAN G. BARLOW.
JOHN B. BARLOW.

Witnesses:-

CHAS. M. WILSON,
JOHN E. MORE.

Defendant's Exhibit No. 2.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Defts. Exhibit No. 2. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 2. Received Sep. 8, 1910. F. D. Monckton, Clerk.

No. 612,197.

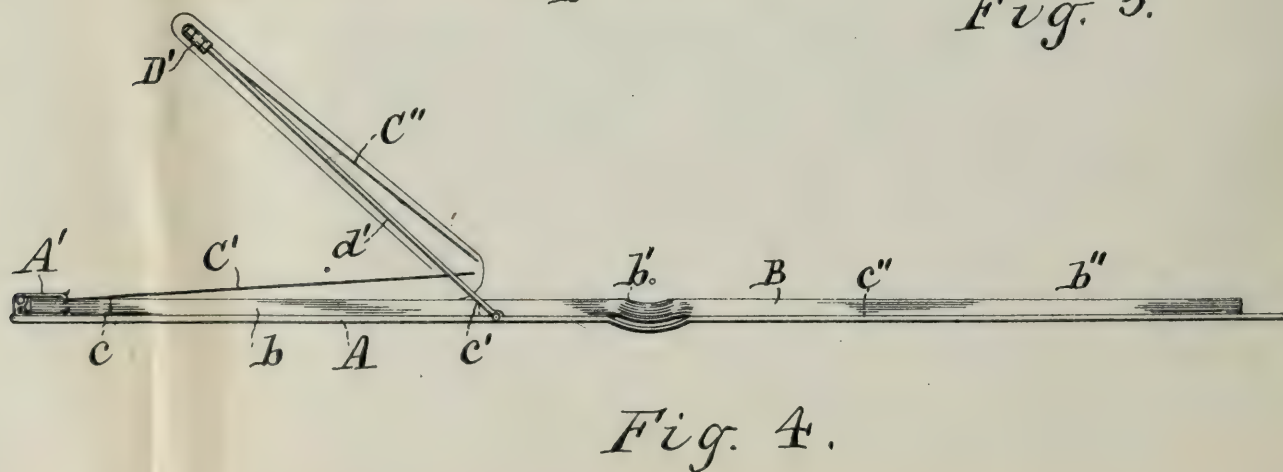
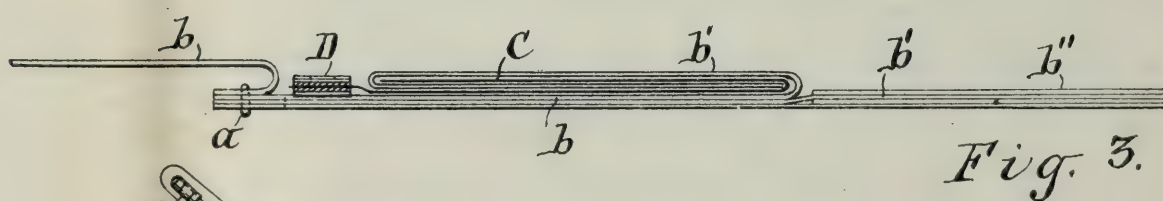
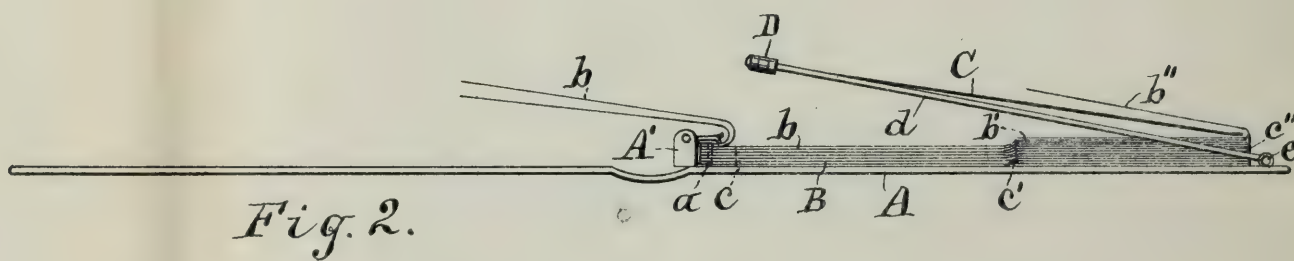
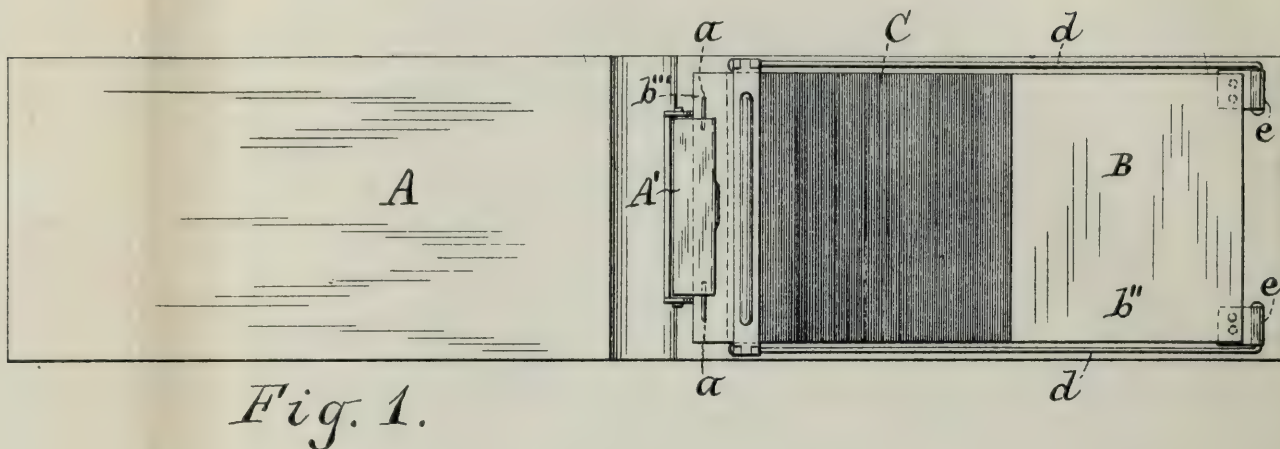
Patented Oct. 11, 1898.

G. E. DOUGHTY.

MANIFOLD BOOK.

(Application filed Sept. 17, 1897.)

(No Model.)



Witnesses.

Mark W. Dewey
Alvin D. Allen

Inventor.

George E. Doughty
By C. H. Duell
his Attorney.

UNITED STATES PATENT OFFICE.

GEORGE E. DOUGHTY, OF NEW YORK, N. Y., ASSIGNOR TO THE CARTER-CRUME COMPANY, OF NIAGARA FALLS, NEW YORK.

MANIFOLD-BOOK.

SPECIFICATION forming part of Letters Patent No. 612,197, dated October 11, 1898.

Application filed September 17, 1897. Serial No. 652,002. (No model.)

To all whom it may concern:

Be it known that I, GEORGE E. DOUGHTY, of New York, (Jamaica,) in the county of Queens, in the State of New York, have invented new and useful Improvements in Manifold-Books, of which the following, taken in connection with the accompanying drawings, is a full, clear, and exact description.

My invention relates to improvements in manifold sales-books; and the object is to provide a triplicate book that will be simple and convenient.

To this end my invention consists in the combination, with the back or cover, of full leaves divided into three sections, or leaves adapted to be folded upon each other and separated when desired, bound together at one end and secured to the cover, a carbon-sheet, arms pivoted to the cover, and a clamp on the free ends of the arms attached to the carbon-sheet; and my invention consists in certain other combinations of parts herein-after described, and specifically set forth in the claims.

In the drawings hereto annexed and forming a part of this specification, Figure 1 is a plan view of a complete book when open embodying my invention. Fig. 2 shows an edge view of the same after several of the leaves have been used and sections detached therefrom. Fig. 3 shows an enlarged edge view of the same book without the cover and with the carbon-sheet clamp in section, and Fig. 4 is an edge view of a modification wherein the carbon-sheet is divided into two parts and one of said parts is held by the clamp that secures the leaves to the cover.

Any suitable printed matter or ruling may be placed on the leaves.

Referring specifically to the drawings, A is the back or cover of the book, having a hinge in the middle and a suitable clamp A' for holding the leaves in the cover, either at one side of the hinge or at a free end of the cover, as shown in Fig. 4 of the drawings.

B indicates the pile of full leaves, secured together by staples *a a* at one end and by the same end secured to the cover by the clamp A'. In the first two figures of the drawings the clamp A' is secured to the inner side of

The bound ends of the leaves are held in this clamp with their free ends extending to the right, but with their end sections *b''* turned inward and lying on their respective central sections *b'*.

The full leaves B are each divided into three sections *b*, *b'*, and *b''* and a stub *b'''* by perforated lines *c*, *c'*, and *c''*, and these sections, when folded on the said lines with the carbon-sheet inclosed, form at one writing three distinct copies, *b'* being the original, *b''* the duplicate, and *b* the triplicate, which latter can be retained in the book or removed, as desired.

The carbon-sheet C is as wide as the leaves, as long as two of the sections, and is carbonized on both sides. Said carbon-sheet is held by a clamp D at one end, the clamp being mounted on the free ends of arms *d d*, turning in eyes *e e*, secured to the inner side of the cover, near its right-hand edge.

In using the form of book shown in the first three figures of the drawings the end section *b''* of the uppermost leaf is raised to allow the end of the carbon-sheet C to drop onto the underlying section, as shown in Figs. 1 and 2, and then the sections *b''* and *b'*, together with the end of the carbon-sheet, is folded on the perforated line *c'* over upon the other section *b*, as indicated in Fig. 3 of the drawings. Any writing that is made upon the central section *b'* will be copied on the other two sections of the leaf. After the writing one or all of the sections written upon may be torn out, leaving the next full leaf in position for a like manipulation.

The leaves B in Fig. 4 are provided with the same perforated lines, or lines that are broken to allow the leaves to be separated easily, and the same number of sections as the leaves in the other figures; but the end sections are not turned in before they are used, and the bound edges of the leaves are secured to the cover A by the clamp A', located at the left-hand edge of the cover. The carbon-sheet is divided into two parts C' and C'' in this book, one part, C', being held by the clamp A' on the top of the section *b* and the other part, C'', being held by a swinging clamp D' to lie between the sections *b'* and *b''* when folded. The clamp A' being secured at the

eyes for the arms *d' d'* to turn in are secured to the left-hand side of the cover.

It will be noticed that although the carbon-sheet is divided in the modified form of book the leaves are folded in exactly the same manner before the writing is done and also that the central section is the original.

When the sections *b b*, &c., are retained in the book for further reference, they are turned over to the left, so that entries are turned face downward and are not exposed to view.

Having described my invention, what I claim as new, and desire to secure by Letters Patent, is—

1. In a manifold-book, the combination of a pile of leaves of equal size secured together at one end, lines of perforations extending across the leaves dividing each into three sections and a stub at the bound end, the end section of each leaf folded over upon its central section, said central section with the end section being adapted to be folded over together upon the bound-end section, a carbon-sheet extending from the fold of the end section to the stub, a cover secured to the stubs, arms pivoted to the cover, and a clamp on the free ends of the arms attached to the carbon-sheet, as set forth.

2. In a manifold-book, the combination with the cover, of leaves divided into three sections of substantially equal size by parallel perforated lines, said leaves being adapted to be folded and separated on said lines, a clamp secured to the cover to hold one end of the

leaves, a carbon-sheet, and a swinging clamp pivoted to the cover and secured to one end of the carbon-sheet, substantially as described and shown.

3. In a manifold-book, the combination with the cover provided with a hinge in its center, of a pile of leaves each leaf divided into three sections of substantially the same length, stubs at one end bound together, a clamp secured to the cover near the hinge for holding the stubs, a carbon-sheet adapted to be folded between the sections, arms pivoted to the inner side of the cover a distance from said clamp, and a clamp on the free ends of the arms attached to the carbon-sheet and adapted to lie near the first-mentioned clamp, substantially as described and shown.

4. In a manifold-book, the combination with the cover provided with a hinge in its center, of a pile of leaves divided into three sections, stubs at one end of the pile bound together, a clamp secured to the cover near the hinge for holding the stubs, a carbon-sheet double the length of one section of a leaf, arms pivoted to the inner side of the cover at one end, and a clamp on the free ends of the arms attached to one side of the carbon-sheet, substantially as described and shown.

In testimony whereof I have hereunto signed my name.

GEORGE E. DOUGHTY. [L. S.]

Witnesses:

W. A. WARNOCK,
JOHN L. GWYDIN.

Defendant's Exhibit No. 3.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Defts. Exhibit No. 3. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 3. Received Sep. 8, 1910. F. D. Monckton, Clerk.

No. 634,438.

Patented Oct. 10, 1899.

A. ABRAHAM.
MANIFOLDING SALES BOOK.

(Application filed May 4, 1899.)

(No Model.)

Fig. 1.

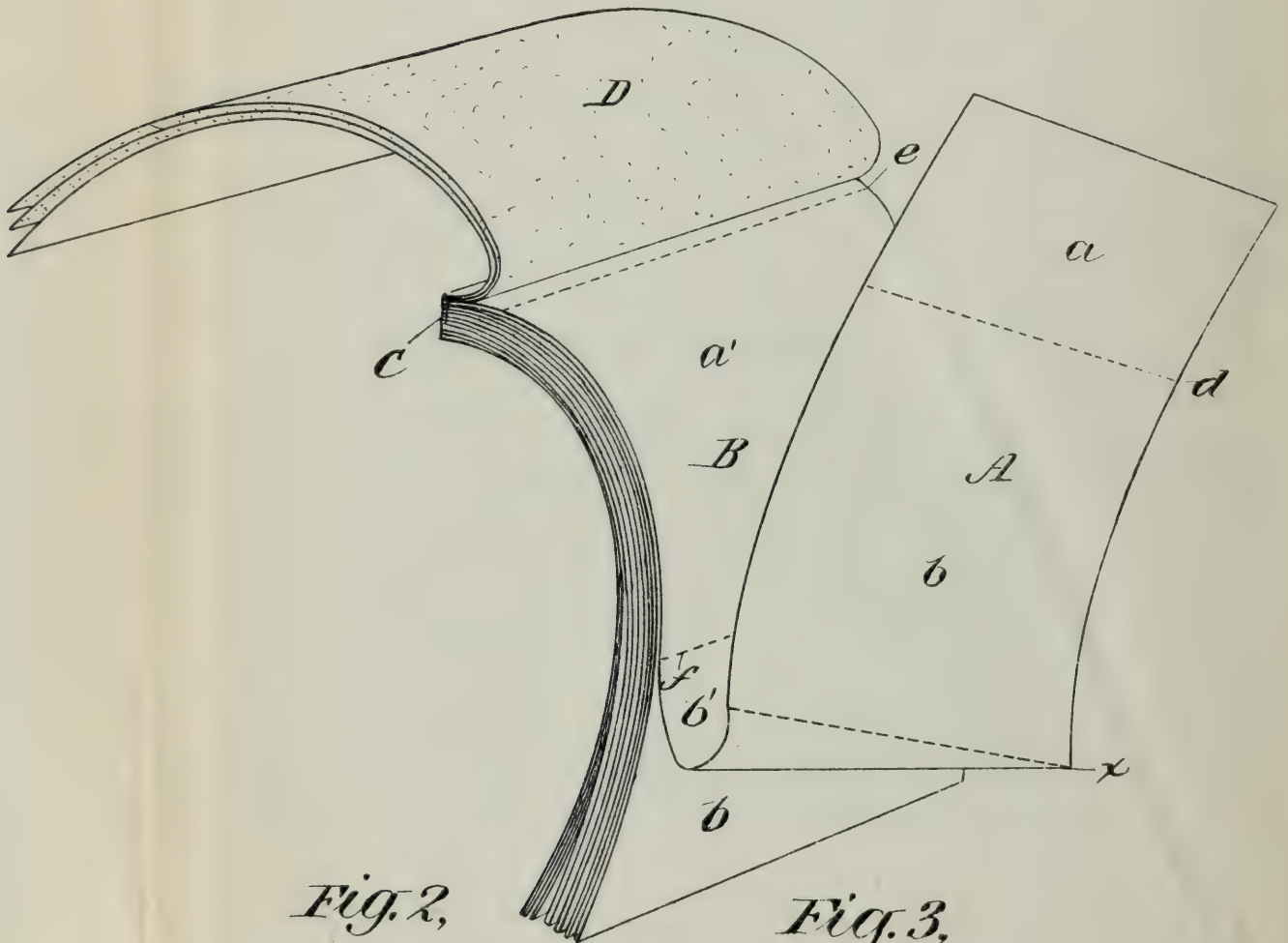


Fig. 2.

Fig. 3.

a	Name		h
d	A—B—No New York		h
b			h
A			h
c			h
WITNESSES:			9
NAME			
ADDRESS			

a'	Name		h'
d'	A—B—No New York		h'
b'			h'
A'			h'
c'			h'
INVENTOR			9'
Abraham Abraham			
BY			9'
Kenyon Kenyon			
ATTORNEYS			

Edwin Seger

Kenyon Kenyon
ATTORNEYS

ABRAHAM ABRAHAM, OF NEW YORK, N. Y., ASSIGNOR TO ABRAHAM & STRAUSS, OF SAME PLACE.

MANIFOLDING SALES-BOOK.

SPECIFICATION forming part of Letters Patent No. 634,438, dated October 10, 1899.

Application filed May 4, 1899. Serial No. 715,561. (No model.)

To all whom it may concern:

Be it known that I, ABRAHAM ABRAHAM, a citizen of the United States, and a resident of New York, (Brooklyn,) in the county of Kings and State of New York, have invented certain new and useful Improvements in Sales-Books, of which the following is a specification.

My invention relates to that class of sales-book in which a leaf of carbon-paper is adapted to be inserted between two adjacent leaves, whereby an original and a carbon copy of the sales-memorandum can be produced and the sheets be detached from the book and from each other, so that the customer may receive one record and another be retained at the store.

My improvements consist generally in dividing each half of a folded sheet of a manifold sales-book into three sections, the top and bottom sections having provision for the name and address of the purchaser and the intermediate section having provision for memorandum of sale and amount of same and the bottom section also having provision for the amount of sale and said sheet having lines of detachment between the top and intermediate sections of the upper half and between the bottom and intermediate sections of the lower half.

My improvements also consist in certain other features and details, as more particularly hereinafter described.

In the accompanying drawings, Figure 1 illustrates in perspective a sales-book embodying my invention and showing the two parts of the duplicate sheet and with the carbon-paper thrown back. Figs. 2 and 3 illustrate plan views of the upper and lower parts, respectively, of the duplicate sheet and each figure showing such part detached from the other part.

Similar letters represent like parts in all figures.

The sales-book, as shown in the above figures, is composed of folded sheets composed of the upper part A and the lower part B. The lower part B is secured to the back C or binding, the part A is separated from said back, and the two parts A and B are united at their lower ends, but at said ends are joined

by perforations *x* or otherwise, so that they may be readily separated from each other. The lower part B is also similarly arranged near its upper end, so that it may be readily separated from the back C.

D is the carbon-leaf which is secured to the back C and which is adapted to be inserted under the part A and between the two parts A and B of the double sheet when the book is to be used.

The part A is divided into three sections *a*, *b*, and *c*. Section *a* has provision for the name and address of the purchaser, section *b* has provision for the items of sale or sales, the amounts of same, and the total amount of sales to the customer, and the section *c* has provision for the name and address of the purchaser and the total amount of sales to same. The section *a* is at the top of the part A, the section *c* at the bottom, and the section *b* in the middle or between *a* and *c*. The part B is divided into three sections *a'*, *b'*, and *c'* and occupying similar positions on said part. On part A sections *a* and *b* are separated by a line *d* of perforations or other similar provision, by which section *a* may be readily and instantly detached from sections *b* and *c*. Part B has also a detaching-line *e*, similar to line *d*, between section *a'* and the back C, and *f* is another detaching-line separating sections *a'* and *b'* from section *c'*.

The entire sheet A B is adapted to be used in the following manner: The salesman or saleswoman upon making a sale of goods that are to be sent to the purchaser's home first inserts the carbon-leaf D under the part A and between the parts A and B, and then writes the purchaser's name and address upon the parts *a* and *c*, the item or items of sale, the amount or amounts in money of each sale, and the total amount in money of all the sales to said purchaser on the part *b*. The total amount in money of all the sales is also written on the part *c*. The writing, as above stated, will be duplicated by the carbon-leaf upon the three sections *a'*, *b'*, *c'* of the under part B of the duplicate sheet, the writing on the sections *a'*, *b'*, and *c'* corresponding with the writing on the sections *a*, *b*, and *c*, respectively. The sheet A B is then torn from

the back C and separated at the detaching-lines *d*, *f*, and *x*. The section *a* is pasted on the package containing the purchases, the two united sections *c* and *b* both turned in to the bookkeeper, the two united sections *a'* and *b'* are turned over to the purchaser or put in the package, and the section *c'* is turned over to the auditor. The purchaser will thus have a bill or voucher for his purchase or purchases, with the amount or amounts of same, the bookkeeper will also have a similar voucher, and the auditor will also have a voucher containing the name and address of the purchaser and the total amount of his purchase. It will therefore be seen that whenever a sale or sales is or are made to every customer the salesman or saleswoman, by the proper entries on sections *a*, *b*, and *c*, makes out three sets of checks against each other—one to the customer, one to the bookkeeper, and one to the auditor.

Provision is made at *g* and *g'* on sections *c* and *c'*, respectively, for a number of a purchaser's shopping-card, so that if a customer has such a card and does not pay cash for his purchases the number of his card may be written on *g* and duplicated on *g'* on the auditor's voucher *c'*. The two sections *a* and *a'* also have provision at *h* and *h'*, respectively, for the name of the mercantile establishment selling the goods, so that there will be an advertisement of said establishment both on the section which is pasted on the package and on the purchaser's bill or voucher.

What I claim as new, and desire to secure by Letters Patent, is—

1. In a manifold-book, the combination with a folded sheet, the upper half of which is disconnected from the binding and each half being divided into three sections, the top and bottom sections having provision for the name and address of the purchaser, and the intermediate section having provision for memorandum of sale and amount of

same, and the bottom section also having provision for the amount of sale, and said sheet having lines of detachment between the top and intermediate sections of the upper half and between the bottom and intermediate sections of the lower half, all as set forth.

2. In a manifold-book, the combination of a folded sheet the upper half of which is disconnected from the binding, a carbon-leaf bound into the book and adapted for insertion under the upper half of the folded sheet, each half of said sheet being divided into three sections, the top and bottom sections having provision for the name and address of the purchaser, and the intermediate section having provision for memorandum of sale and amount of same, and the bottom section also having provision for the amount of sale, and said sheet having lines of detachment between the top and intermediate sections of the upper half and between the bottom and intermediate sections of the lower half, all as set forth.

3. A manifold-book composed of folded sheets, the upper half of each of which sheets is disconnected from the binding, and each half being divided into three sections, the top and bottom sections having provision for the name and address of the purchaser, and the intermediate section having provision for memorandum of sale and amount of same, and the bottom section also having provision for the amount of sale, and said sheet having lines of detachment between the top and intermediate sections of the upper half and between the bottom and intermediate sections of the lower half, all as set forth.

In testimony whereof I have signed my name to this specification in the presence of two subscribing witnesses.

ABRAHAM ABRAHAM.

Witnesses:

HENRY WILHELM,
ARTHUR HENRY BEEDLE.

Defendant's Exhibit No. 4.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Lefts. Exhibit No. 4. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

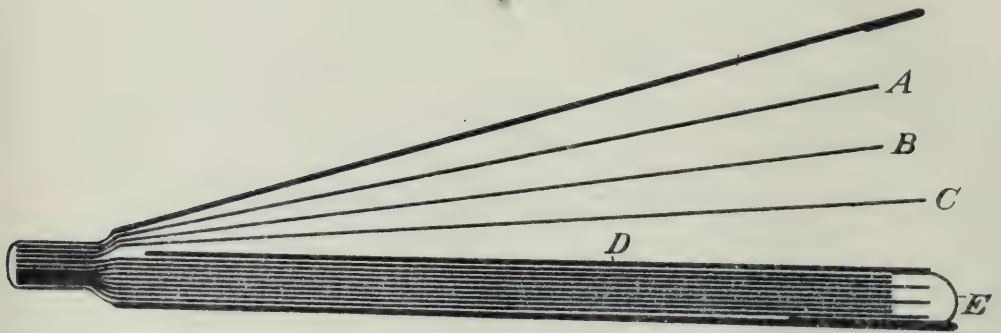
Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 4. Received Sep. 8, 1910. F. D. Monckton, Clerk.

(No Model.)

H. P. BROWN.
DUPLICATING PAD OR SHEET.

No. 589,372.

Patented Aug. 31, 1897.



Witnesses,
J. H. Morse
C. A. Brandau

Inventor,
Horace P. Brown
By Dewey & Co.
attys

UNITED STATES PATENT OFFICE.

HORACE P. BROWN, OF SAN FRANCISCO, CALIFORNIA.

DUPLICATING PAD OR SHEET.

SPECIFICATION forming part of Letters Patent No. 589,372, dated August 31, 1897.

Application filed December 23, 1896. Serial No. 616,796. (No specimens.)

To all whom it may concern:

Be it known that I, HORACE P. BROWN, a citizen of the United States, residing in the city and county of San Francisco, State of California, have invented an Improvement in Duplicating Pads or Sheets; and I hereby declare the following to be a full, clear, and exact description of the same.

My invention relates to an improvement in the duplication or manifolding of marks or entries upon separate sheets, such as shipping-receipts, cash memoranda, pads, and sheets generally where any repetition of the mark or entry is required.

It consists, essentially, of the application by printing or other means to one surface of a sheet of a non-drying transparent ink or other suitable material, which serves to duplicate upon a following sheet any entry or mark made upon the face of the first-named sheet or of sheets anterior thereto, and in certain details of construction and mounting, which will be more fully explained by reference to the accompanying drawing, in which the figure illustrates my invention as applied to a receipt-book.

In the method now generally employed for making duplicate or triplicate receipts, cash or memorandum tags, where more than one copy is desired, it is customary to employ independent sheets of carbon-paper, which are laid between the upper and lower sheets, so that when a mark or entry is made upon the upper sheet it will be transferred by means of the carbon surface of the next sheet below and this again to a third sheet by the use of a second sheet of carbon. These carbon-sheets are necessarily loose and changeable from one part to another of the book, pad, or other record for the purpose of each new entry and are somewhat expensive to produce.

In my invention I print or apply upon the back of a sheet by means of any printing-press or other suitable means a surface of non-drying and transparent ink, which when superposed over another sheet will transfer any entries or marks made upon the front side of said sheet or upon any sheet anterior thereto to a subsequent sheet, which may be placed below the one having the above-described surface. This surface may be a uniform tint or made in "half-tone," so called, or

in any other suitable manner. This ink being transparent will not in any way interfere with any printed matter which it may be desired to have upon the back of the sheet, as in the case of conditions, &c., which are printed upon shipping-receipts and other like documents.

The word "ink" is here employed to designate any suitable substance or preparation which may be applied and used, as herein described, and is to be so considered throughout this specification.

This invention is especially valuable because of the rapidity and cheapness with which the sheets can be prepared, the expense being very much less than that of preparing the ordinary carbon-sheets or other similar means used to make manifold work.

In the accompanying drawing I have illustrated my invention as applied to a system of shipping-receipts which is usually employed in duplicate or triplicate. In this case the sheets A, B, and C are respectively the shipping-order, the duplicate shipping-receipt, and the original shipping-receipt. These are bound in series of three into a book of any suitable shape or size, the sheets A and C having lines of perforation along the back edge close to the binding, so that they can be easily removed. The first sheet consists of the shipping-order and the second the duplicate shipping-receipt. Upon the back of each of these sheets is imprinted a surface of a transparent ink, which may be made of any suitable or desired color. In the present case I have used an ink of such a color and character that the conditions which are usually printed upon the backs of such receipts can be printed in black ink thereon and can easily be read through the transparent surface which has been applied thereto. These first two sheets having this imprinted or prepared surface are slightly shorter than the sheet C, as shown, so that each series of three is easily separated and identified by reason of the front edge of the sheet C projecting a short distance beyond the edges of the other two.

The entry being made upon the first sheet A with pencil or other marking implement the marks will be transferred, respectively, to sheets B and C. The first, constituting the shipping-order, may then be removed and

delivered to the shipper and the third, which is the original shipping-receipt, is also removed in the same manner, leaving the second or duplicate shipping-receipt in the book.

5 The next series is used in the same manner, and so on through the book.

In order to prevent the marks being transmitted beyond the desired number of sheets, the third sheet C will have no transferring-surface printed upon it. Consequently the transfer is limited to the sheet subsequent to the last one having this surface upon it.

For convenience in writing and to provide a properly hard surface to insure the clear marking through the various sheets I employ a flap D, of hard pasteboard or other suitable material, which is loosely hinged to the front edge of the rearmost cover of the book, as shown at E, so that it may be folded over the leaves of the book which are behind the ones to be written on, and these latter leaves, as A, B, and C, are then laid down upon this surface, so that the marking or writing is readily transferred as far as desired. This flap will also serve to prevent a transfer of the mark beyond itself if introduced behind sheets which have the transferring-surface upon them.

It will be manifest that this transfer-surface may be imprinted or prepared directly upon the sheets, either bound or unbound, which form the shipping receipts and orders, or cash or memorandum tags or pads of any description, or it may be imprinted or applied upon intermediate sheets which are secured in rotation with those upon which the marks are to be placed, the essential feature of the invention consisting in applying the duplicating or manifolding surface by printing upon one side of a sheet.

Having thus described my invention, what I claim as new, and desire to secure by Letters Patent, is—

1. The improvement in manifolding consisting of sheets having applied upon the

printed backs thereof a surface of non-drying transparent transferable ink.

2. The improvement in manifolding for sheets, pads, or books consisting of sheets arranged in series having applied upon the printed backs thereof a surface of non-drying transparent transferable ink and a device for separating said sheets into groups of as many as the number of copies desired and preventing a further imprinting upon subsequent sheets.

3. The improvement in manifolding consisting of sheets bound together in series of as many as there are desired copies having imprinted upon the printed backs of those sheets from which copies are to be transferred, a non-drying transferable ink, perforations or means for separating the sheets from the binding being formed upon those sheets which are to be removed, and the final sheet of each group having its edge projecting beyond the previous one so as to separate the groups.

4. The improvement in manifolding-sheets bound into books consisting of a surface of non-drying transferable and transparent ink imprinted upon the printed backs of sheets through which the transfer is to be made, said sheets being bound in series of as many as there are copies required and with the front edge of the final sheet projecting slightly beyond the anterior ones to separate the groups, lines of perforations formed adjacent to the binding along those sheets which are to be removed from the book, and an impenetrable flap or surface loosely hinged to the front edge of the book and adapted to be folded between the series of sheets to prevent a transfer beyond the particular series required.

In witness whereof I have hereunto set my hand.

HORACE P. BROWN.

Witnesses:

S. H. NOURSE,
GEO. H. STRONG.

Defendant's Exhibit No. 5.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Defts. Exhibit No. 5. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 5. Received Sep. 8, 1910. F. D. Monckton, Clerk.

No. 694,103.

Patented Feb. 25, 1902.

A. LEVISON.
MANIFOLD BOOK.

(Application filed Dec. 4, 1901.)

(No Model.)

Fig. 1.

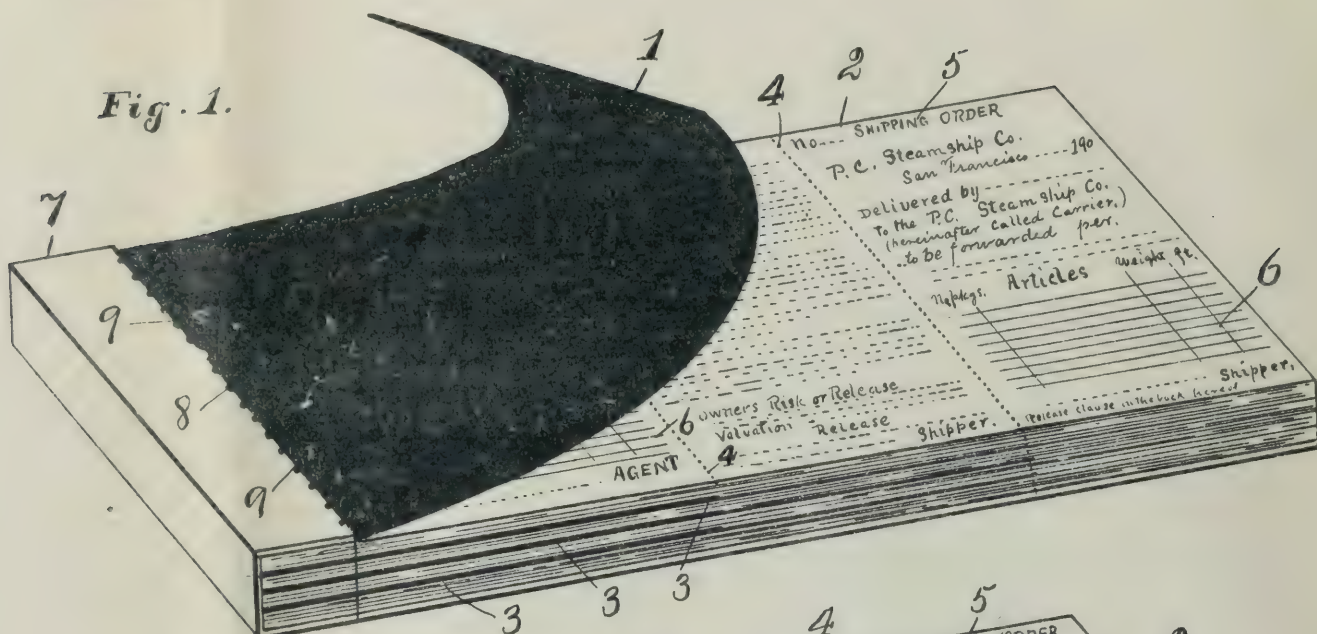


Fig. 2.

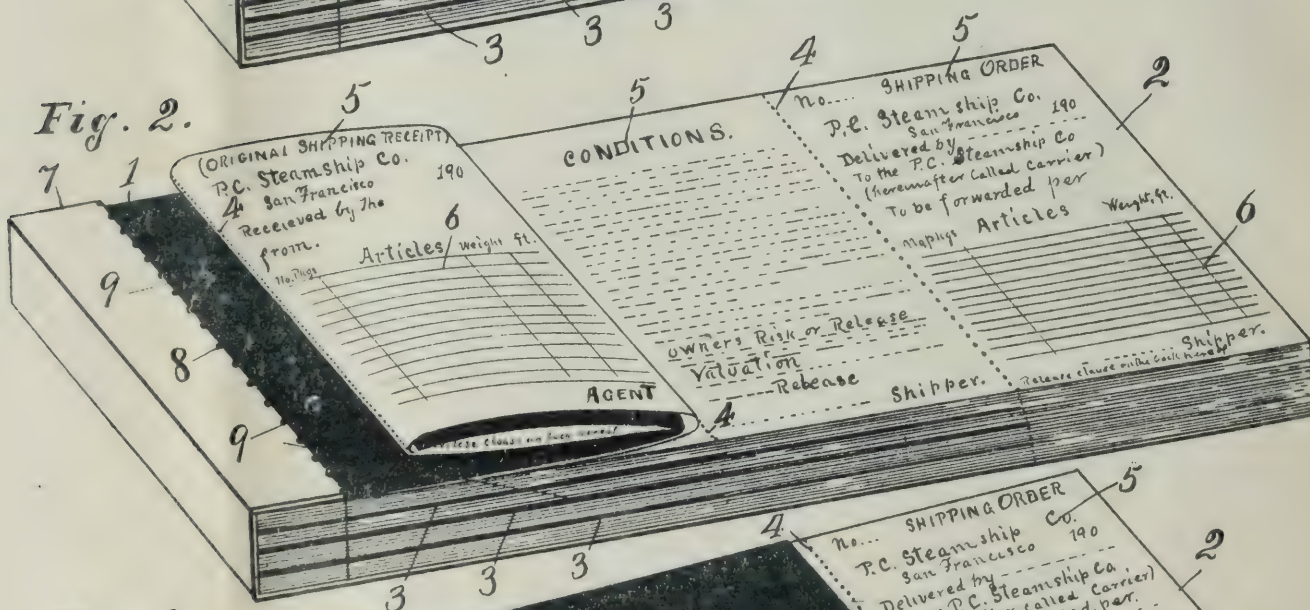
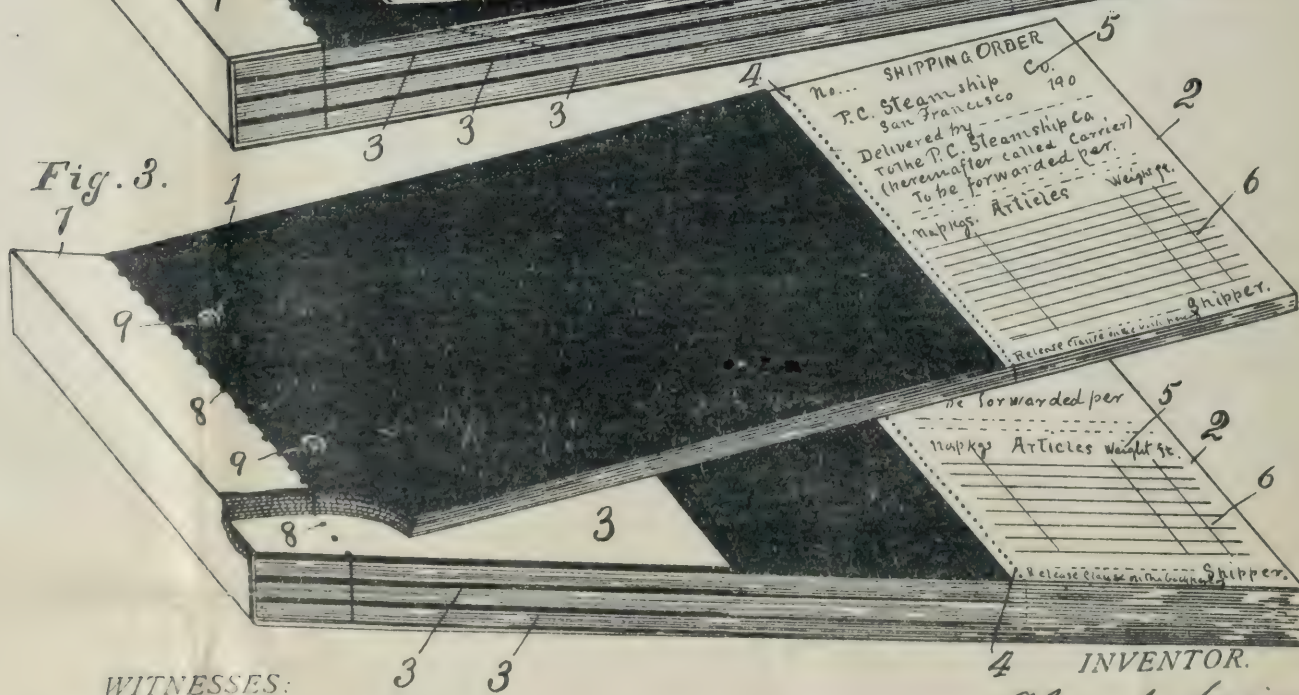


Fig. 3.



WITNESSES:

K. Lockwood Nevins
Cecilia Downing

INVENTOR.
Alexander Levison

BY *Francis W. Wright.*
ATTORNEY.

UNITED STATES PATENT OFFICE.

ALEXANDER LEVISON, OF SAN FRANCISCO, CALIFORNIA.

MANIFOLD-BOOK.

SPECIFICATION forming part of **Letters Patent No. 694,103**, dated February 25, 1902.

Application filed December 4, 1901. Serial No. 84,682. (No model.)

To all whom it may concern:

Be it known that I, ALEXANDER LEVISON, a citizen of the United States, residing at San Francisco, in the county of San Francisco and State of California, have invented certain new and useful Improvements in Manifold-Books, of which the following is a specification.

My invention relates to an improved manifold receipt and record book for mercantile, railway, express, or other business uses.

The object of my invention is to provide a book of this character which shall be convenient in use, economical in the number of carbons required, which shall give secure protection against alterations and forgeries, and the sheets of which can be readily and conveniently placed on record after the impression has been taken.

My invention therefore resides in the novel construction, combination, and arrangement of parts for the above ends, hereinafter fully specified, and particularly pointed out in the claims.

In the accompanying drawings, Figure 1 is a perspective view of one of my improved manifold-books before use. Fig. 2 is a similar view showing the position when folded for use; and Fig. 3 is a perspective view of the book, a number of sheets being turned up and the book being broken away to show a card backing and carbon-paper.

Referring to the drawings, it will be seen that my improved manifold-book is formed in sections, each section comprising in order, first, a carbon-sheet 1, of about two-thirds the width of the book, then, below said carbon-sheet 1, a number of sheets 2, of ordinary paper, the full width of the book, then a sheet 3 of hard thick cardboard. Each record-sheet is divided into three parts by vertical lines of perforations 4, said parts having suitable printed matter 5 and blank lines 6, whereon to inscribe the desired record. The carbon-sheets 1 are of sufficient width to extend over two of said parts, while the cardboard backing 3 occupies the width of the inner parts only of the sheets above it. The record-sheets and the cardboard backings are attached to stubs 7 along lines of perforations 8, so that they can be readily detached

from said stubs, and said stubs and the edges of the carbon-sheets are all bound together to form a book.

In use the record-sheet is first folded on the outer line of perforations 4, so as to cover about one-half of the carbon-sheet, and it is then folded in the same direction on the second line of perforations, so that the carbon is now folded inside of the record-sheet, as shown in Fig. 2. The record will now be written upon what was the back of the middle portion of the sheet when it was flat and unfolded, which will now, however, have come to the top. The carbon-sheet is double or carbonized on both sides, so that a copy of the record will be made upon each of the two terminal parts of the sheet. Also an inverted or backhanded copy of the writing will be formed upon the back of each part, except the inner one. This latter feature gives additional security against subsequent alteration of the record, since it is difficult to erase and rewrite both the original and the reverse copy.

The use of the cardboard backing is to provide a hard substance to form a smooth writing-surface and also to protect the carbon paper and sheets below it from receiving an impression written upon a sheet above said backing. The inner edge of the inner part of the record-sheet is punched with two holes 9 to facilitate the filing of said part.

The advantages of the above construction are that any kind of paper can be used for the record-sheets, and the construction does not require any transparent paper. The carbon naturally falls into the position for use for the next record-sheet when one record-sheet has been removed, and the record-sheet is very readily folded in the desired manner, the fold being twice in the same direction. The device is economical of carbon-paper.

The cardboard backings are an important feature of my invention, since they permit a large number of sheets to be bound into a book with a small number of carbons without any danger of transmitting an impression from one sheet to another sheet. They are readily removable by means of the lines of perforations when all the sheets above them have been used.

I claim—

5 A manifold-book composed of sections, each section comprising in order a double carbon-sheet, a plurality of recording-sheets, and a
10 cardboard backing, the record-sheets being divided into three separable parts, the carbon-sheets extending the width of two of said parts, and the cardboard backing extending the width of one of said parts, said recording-sheets and backings having stubs to which they are attached along lines of perforations,

said stubs and the edges of the carbon-sheets being all bound together to form a book, substantially as described.

In witness whereof I have hereunto set my hand in the presence of two subscribing witnesses.

A. LEVISON.

Witnesses:

FRANCIS M. WRIGHT,
CECELIA POWNING.

Defendant's Exhibit No. 6.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Defts. Exhibit No. 6. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 6. Received Sep. 8, 1910. F. D. Monckton, Clerk.

E. J. PERRY.

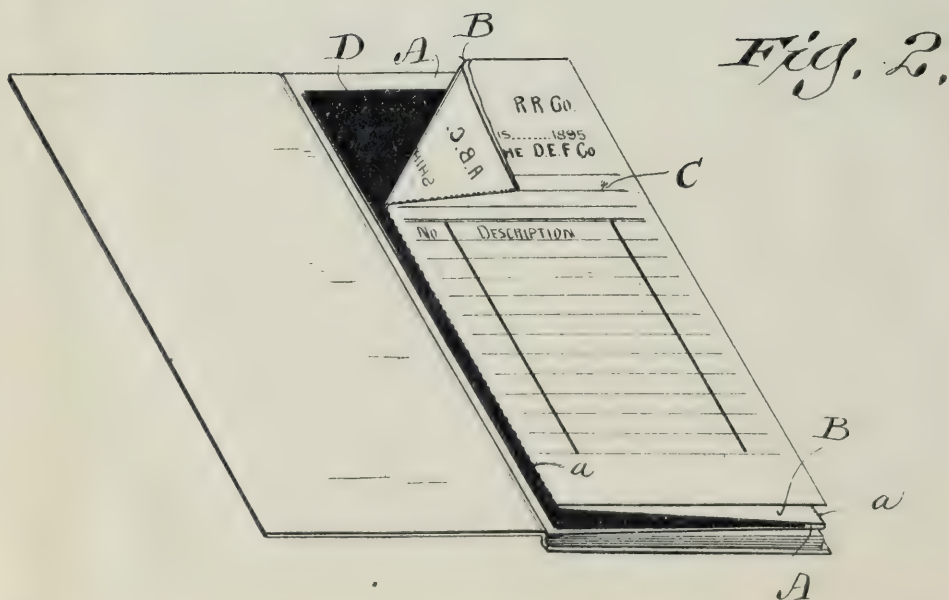
CARBON COPYING MANIFOLD SHEET OR BOOK.

No. 11,547.

Reissued June 9, 1896.

Fig. 1.

A.B.C. R.R.CO.		O.O.A.A. O.B.A		A.B.C. R.R.CO.	
WIS..... 1895		2881..... 21W		WIS..... 1895	
SHIPPED BY The D.E.F. Co.		O.O.A.A. SHIPPED BY The D.E.F. Co.		SHIPPED BY The D.E.F. Co.	
No	DESCRIPTION	No	DESCRIPTION	No	DESCRIPTION
A		a B a		C	



Witnesses:
 Geo W. Loring
 N. E. Oliphant

Inventor
 Ernest J. Perry
 By H. G. Underwood
 Attorney

UNITED STATES PATENT OFFICE.

ERNEST J. PERRY, OF FOND DU LAC, WISCONSIN.

CARBON COPYING MANIFOLD SHEET OR BOOK.

SPECIFICATION forming part of Reissued Letters Patent No. 11,547, dated June 9, 1896.

Original No. 541,498, dated June 25, 1895. Application for reissue filed August 3, 1895. Serial No. 558,164.

To all whom it may concern:

Be it known that I, ERNEST J. PERRY, a citizen of the United States, and a resident of Fond du Lac, in the county of Fond du Lac and State of Wisconsin, have invented certain new and useful Improvements in Carbon Copying Manifold Sheets or Books; and I do hereby declare that the following is a full, clear, and exact description thereof.

My invention relates especially to manifold receipt and record books for mercantile, railway, express, and other business uses; and it consists in certain peculiar and novel features of construction and arrangement, as hereinafter fully set forth, and subsequently claimed.

In the drawings, Figure 1 is a plan view of a single sheet embodying one form of my present invention. Fig. 2 is a perspective view of a book formed of a number of said sheets bound together and illustrating the manner of use.

The object of my present invention is the production of a manifold-copying sheet or book of such sheets, so constructed that by the use of a single sheet of carbon-paper interposed between the folds of said sheet a plurality of impressions may be obtained from a single writing, one of which will be upon the portion of said sheet designed to be retained as a permanent record and the balance upon the detachable remainder of said sheet; and a further object of my said invention is to cheapen the cost of manufacturing books and sheets of this general nature.

Referring to the drawings, in Fig. 1 I show the triplicate form of one of my improved sheets, composed of thin transparent paper, divided by rows of perforations or indentations *a a* into three practically equal portions A B C, the parts B and C being of exactly the same width and the part A only differing therefrom by the added width at the left necessary for binding the same into a book of such sheets when desired. These sheets are all printed on the same side, parts A and C being exact duplicates and part B differing therefrom only in that the impression is the reverse from that on the other parts. This is accomplished in this manner: The matter that appears on part A, for example, is set up in the ordinary manner, and from an im-

pression of this matter a "process-block" is obtained (the details of this process forming no part of my present invention) which will print the same matter in an exactly reversed condition. One or more electroblocks of the said original matter are then made in the ordinary manner, it being preferable to make two such blocks, so as not to use the type itself in printing the sheets. The three blocks are then put in a suitable chase with the one that is to make the negative impression between the two that make the positive impressions and spaced an exactly equal distance apart, and then the sheets can be printed in the ordinary manner, a single impression to each sheet being all that is required. These sheets may be used separately or bound into a book, either in the pad or block form or by stitching, as preferred.

In using this form of my device a sheet of carbon D (carbonized on both sides) is placed above the impression on the part A and then the part B is folded down over the same, so that each face of the prepared carbon-sheet is next the printed side of the said parts A and B, and the part C is folded down upon the part B, so that the unprinted surfaces of the parts B C are in contact, and then, with a sharp hard lead-pencil or pen, the date, address, and description of goods, or whatever the desired inscription may be, are written upon the printed surface of the part C and immediately marked thereby upon the printed surfaces of the parts A and B, appearing backward upon the part B and in proper order upon the part A. The parts B and C are then separately detached, as is common in manifold shipping-books and the like, the part A remaining as a permanent record. By reason of the thin transparent paper of which the sheets are made the entire inscription both printed and written will show clearly through the part B from the plain side thereof.

By the use of my invention I avoid the necessity of printing the sheets upon opposite sides thereof, thereby effecting a great saving in the cost of manufacture and am enabled to obtain perfect triplicate copies with the use of a single sheet of carbon-paper.

It is obvious that if desired the described central part B may be printed from specially-

made reversed type, and that all the parts of my sheets may be printed directly from type, though, as stated, it is usually preferred to print from electro or process blocks.

5 Having thus described my invention, what I claim as new, and desire to secure by Letters Patent, is—

10 1. A carbon copying manifold sheet consisting of a strip of thin transparent paper divided by transverse perforations or inden-
tations into a plurality of parts, all printed upon the same side and all of said parts bearing the same inscription, but said inscription upon one of said parts appearing in a re-
15 versed condition, substantially as set forth.

20 2. A carbon copying manifold sheet consisting of a strip of thin transparent paper, divided into three practically equal parts divided by transverse rows of perforations or
identations and all printed upon the same side, the central part of said sheet bearing the same inscription as that upon the outer parts, but appearing in reversed condition, substantially as set forth.

3. A carbon copying manifold book con- 25
sisting of a series of sheets of thin transparent paper secured together, and each sheet separable by transverse rows of perforations or indentations into three practically equal parts, all printed upon the same side, the 30
central part of each sheet bearing the same inscription as that upon the outer parts thereof, but appearing in reversed condition, and each sheet folded together with the printed surface of the central part next the printed 35
surface of the part secured to the book, and with the unprinted surface of the central part next the unprinted surface of the free outer or end part of the said sheet, substantially as set forth. 40

In testimony that I claim the foregoing I have hereunto set my hand, at Fond du Lac, in the county of Fond du Lac and State of Wisconsin, in the presence of two witnesses.

ERNEST J. PERRY.

Witnesses:

C. J. BREITZMAN,
CHARLES HOTALING.

Defendant's Exhibit No. 7.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. Kitchen Jr. Co. Defts. Exhibit No. 7. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 7. Received Sep. 8, 1910. F. D. Monckton, Clerk.

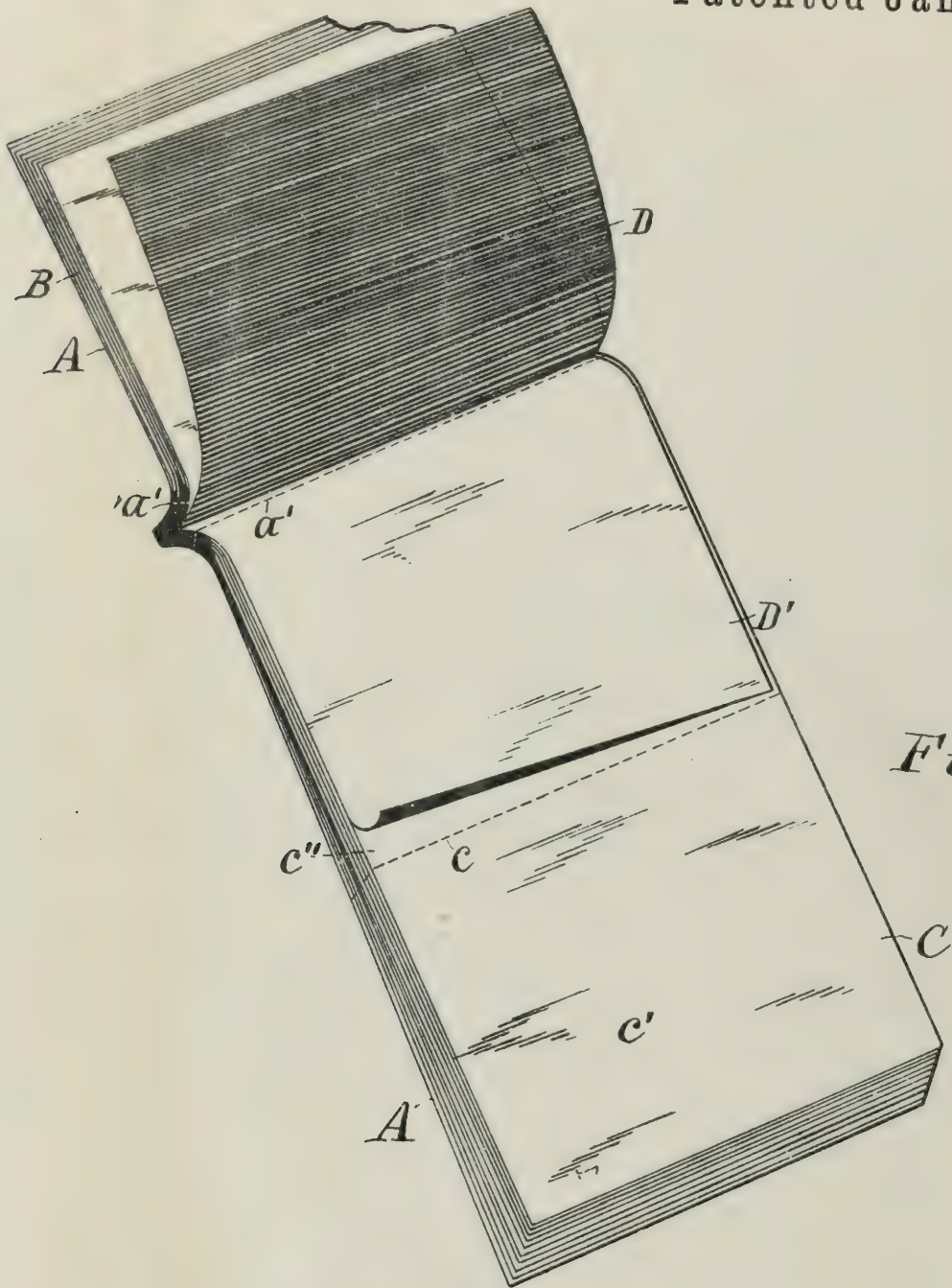


Fig. 1.

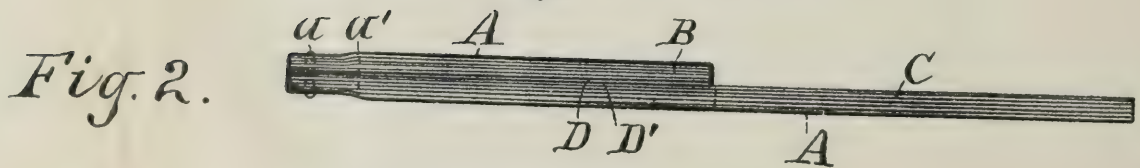


Fig. 2.

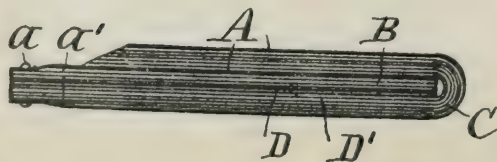


Fig. 3.

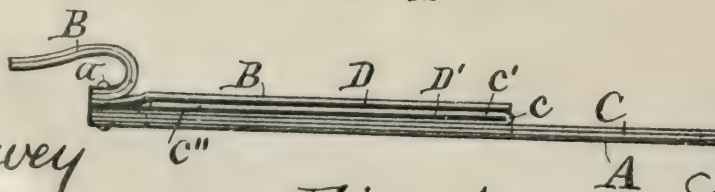


Fig. 4.

Witnesses.

Mark W. Dewey
O. L. Leroy.

Inventor.

James Bengough
By C. H. Duell
his Attorney.

UNITED STATES PATENT OFFICE.

JAMES BENGOUGH, OF NIAGARA FALLS, NEW YORK, ASSIGNOR TO THE
CARTER-CRUME COMPANY, OF SAME PLACE.

MANIFOLD SALES-BOOK.

SPECIFICATION forming part of Letters Patent No. 553,503, dated January 28, 1896.

Application filed October 26, 1895. Serial No. 566,941. (No model.)

To all whom it may concern:

Be it known that I, JAMES BENGOUGH, of Niagara Falls, in the county of Niagara, in the State of New York, have invented new and useful Improvements in Manifold Sales-Books, of which the following, taken in connection with the accompanying drawings, is a full, clear, and exact description.

My invention relates to improvements in manifold sales-books, and the object is to provide a more simple and inexpensive book that will be both serviceable and convenient.

To this end my invention consists in the combination, with the back or cover, of a series of single leaves bound together at one edge, a series of double leaves, one half of which are bound together, while the other half are adapted to fold in as fly-leaves, both series of leaves being bound together at the same edge, and a pair of black leaves bound between the said series of leaves, said black leaves being of substantially the same shape and size as the single leaves; and my invention consists in certain other combinations of parts herein-after described, and specifically set forth in the claims.

In the drawings hereto annexed and forming a part of this specification, Figure 1 is a perspective view of the book when open. Fig. 2 shows an edge view of the book when closed, but not folded. Fig. 3 shows the book closed and folded in a position which allows it to be easily inserted and carried in the pocket; and Fig. 4 shows an edge view of a portion of the book with the leaves in a position to be written upon to make an original, a duplicate, and a triplicate.

I have not shown in any of the figures printed matter or a form of ruling on any of the leaves, as that may be made and arranged to suit the customers or sales-people who use the book. I will say, however, although it forms no part of my invention, that I prefer to print and rule only the original or single leaves, having the others blank, with the exception of the numbers, which correspond as usual with the number on the original.

Referring specifically to the drawings, A is the back or cover of the book, which is preferably formed of thicker paper than that of

the leaves and made long enough to extend the entire length of the book on its lower side and half the length on its upper side. The cover folds over the bound edges of the leaves, and all are secured together by several rivets or staples *a*. 55

B indicates a series of narrow or single leaves, which are called the "originals" and which are written upon with the pencil.

C indicates the series of wide or double leaves which constitute the duplicate and triplicate. There are as many double leaves, of course, as there are single leaves. The double leaves are each provided with a line of perforations *c*, extending across their center, which divides them into two parts—viz., the duplicate *c'* and triplicate *c''*. The double leaves are bound together along one side edge of the triplicate *c''*, thus making the duplicate the end portion of the leaf. One side edge of the originals B is bound by the same staples *a* to the double leaves, the two black or carbon leaves D and D' being bound between the two series of leaves. The black leaves are of substantially the same size as the originals, or, in other words, extend to the perforated line *c* in the double leaf. The perforated line *c* allows the duplicate to be easily detached or separated from the triplicate. Another perforated line *a'*, extending across each leaf near the bound edge, allows these leaves to be separated from the book when desired. 60 65 70 75 80

In using the book it is opened first to the position shown in Fig. 2, then to the position shown in Fig. 1—that is, with the originals B and black leaf D thrown back. Then the duplicate *c'* of the double leaf C is folded in over the black leaf D', as shown in Fig. 4, the black leaf D' serving to impress the copy on the triplicate *c''* below it. Then the black leaf D is turned down over the duplicate *c'* to impress it with the characters written upon the original B after the latter is turned down upon the black leaf D, as indicated also in Fig. 4 of the drawings. 85 90 95

It will be obvious that the triplicate, as well as the original, must be detached from the book before the next leaves can be used.

Having described my invention, what I 100

claim as new, and desire to secure by Letters Patent, is—

1. In a manifold salesbook, the combination with the back, of a series of single leaves bound together at one edge, a series of double leaves bound together at one edge, one-half of which are adapted to fold in as fly-leaves, both series of leaves being bound together at the same edge, and a pair of black leaves bound between the said series of leaves, said black leaves being of substantially the same shape and size as the single leaves, substantially as described and shown.

2. In a manifold salesbook, the combination with the back, of a series of single leaves bound together at one side edge, a series of double leaves corresponding in number with the single leaves, and bound together at one edge, one-half of which are adapted to fold in as fly-leaves, both series of leaves being bound together at the same edge, and a pair of black leaves bound together between the two series of leaves, said black leaves being

of the same shape and size as the single leaves, substantially as described and shown.

3. In a manifold salesbook, the combination with the cover, of a series of single leaves bound together at one side edge, a series of double leaves, corresponding in number but double the size of the single leaves, and bound together at one edge, one-half of said double leaves being adapted to fold in as fly-leaves, a perforated line at the fold, both series of leaves being bound together at the same edge, a pair of black leaves bound together and between the two series of leaves, said black leaves being of the same shape and size as the single leaves, and perforated lines extending across all of said leaves near the bound edge, substantially as described and shown.

In testimony whereof I have hereunto signed my name.

JAMES BENGOUGH. [L. S.]

Witnesses:

WALTER GREIG,
JOHN P. GARBUTT.

Defendant's Exhibit No. 12.

[Endorsed]: No. 14,772. In U. S. Circuit Court, Northern District of California. Levison vs. J. Kitchen Jr. Co. Defendant's Exhibit No. 12. E. H. H., Examiner. Filed Nov. 23, 1909. Southard Hoffman, Clerk. By W. B. Maling, Deputy Clerk.

Case No. 1900. U. S. Circuit Court of Appeals for the Ninth Circuit. Defendant's Exhibit No. 12. Received Sep. 8, 1910. F. D. Monckton, Clerk.

911,597.

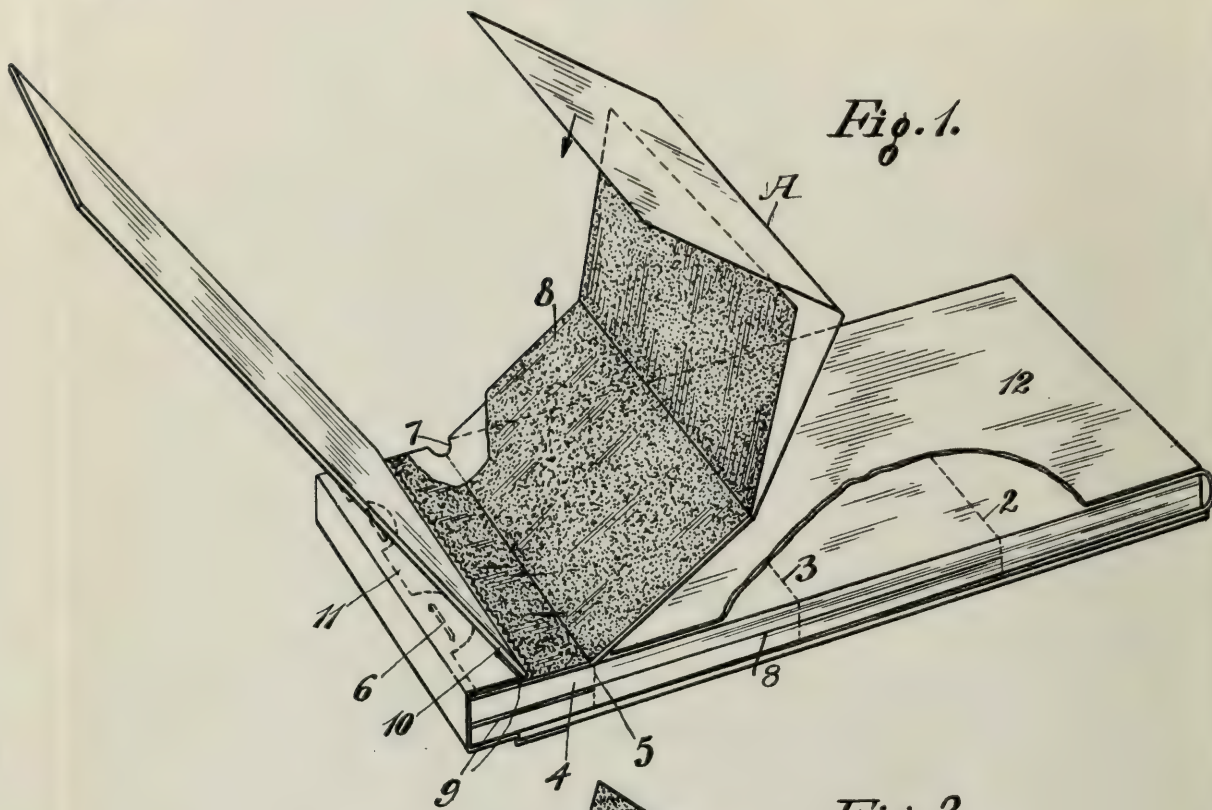
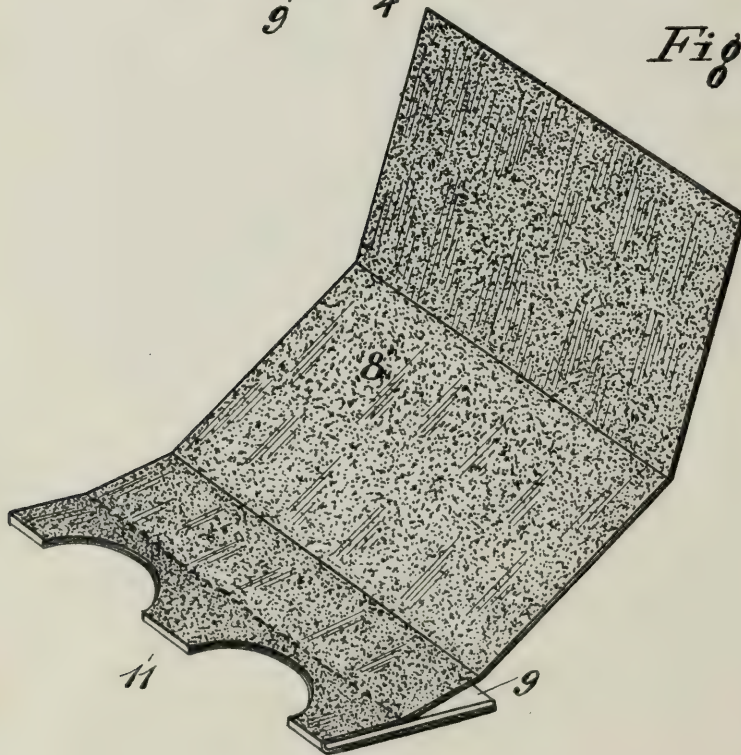


Fig. 2.



WITNESSES

E. H. Petersen
W. R. Penfield

INVENTOR
John Kitchen, Jr.

BY *Geo. H. Strong*
ATTORNEY

UNITED STATES PATENT OFFICE.

JOHN KITCHEN, JR., OF SAN FRANCISCO, CALIFORNIA.

MANIFOLDING-BOOK.

No. 911,597.

Specification of Letters Patent.

Patented Feb. 9, 1909.

Application filed July 20, 1908. Serial No. 444,350.

To all whom it may concern:

Be it known that I, JOHN KITCHEN, Jr., citizen of the United States, residing at the city and county of San Francisco and State of California, have invented new and useful Improvements in Manifolding-Books, of which the following is a specification.

My invention relates to manifolding books, and pertains especially to a shipping receipt book.

Shipping receipt books are made up either in duplicate or triplicate form, the leaves being foldable one or more times upon themselves, and interfoldable with a carbon-sheet; there being two or more of these carbon-sheets disposed at intervals through the book. Usually one carbon will serve for the several sheets of a section of the book. By that time the carbon is worn out, and the next carbon being exposed will in turn serve for the succeeding section of sheets; each underneath carbon being protected by a stiff backing-sheet.

Where the carbons are bound into the book, objection is often made that the carbons become worn out before the section for which this carbon is designed to serve are used up; and if a loose carbon is used considerable difficulty is experienced in keeping it in place, and furthermore, it smudges up the leaves by frequent insertions and removals.

I have devised a book in which the carbons are made up separately from the book and are readily insertible into the book after the latter is bound up, and, moreover, they are held firmly in place just as though they had been bound in the book originally. In my book, also, I provide a form of stop-card, in which a single stop-card serves for all the carbons in the book.

The invention consists of the parts and the construction and combination of parts as hereinafter more fully described and claimed, having reference to the accompanying drawings, in which—

Figure 1 is a perspective of the book. Fig. 2 is a perspective of the carbon.

A represents a record-sheet of any suitable size, and foldable one or more times upon itself, according to whether a duplicate, triplicate, or other multiple record is to be made. As here shown, the sheet is made for triplicate purposes and is transversely perforated along lines 2—3, and is connected to its stub 4 along the line of perforations 5.

Any appropriate form of printing or notation may be put upon the several sections of the record-sheet A. These record-sheets are all bound together at the stubs by suitable means, as the staples 6, and if desired, the pad is notched at one side, as shown at 7, in line with the stub perforations 5, so as to enable the sheets to be easily torn off. In conjunction with this pad I use a carbon 8 which is made up entirely separate from the pad and is afterwards inserted therein, as will shortly be explained. The length of this carbon is only a part of the total length of the record-sheet, so as to enable the record-sheet to be folded one or more times upon itself, and interfolded with the carbon, so as to produce a duplicate or triplicate record, according to whether the record-sheet A is a duplicate or triplicate sheet. In a triplicate system, as here shown, the carbon, which is double-faced, is two-thirds the length of the record-sheet, so that the outer section of the record-sheet may be folded first over the carbon, and then this folded end of the record-sheet will be overfolded with the carbon, in a manner well known in the art. The novelty of this part of my invention resides in the manner of inserting the carbon into and attaching it to the pad, whereby I am enabled to insert any number of carbons anywhere in the pad after the latter is made up. One end of the carbon is secured to a strip of stiff cardboard 9, or equivalent material, which is so fashioned that it can be pushed in underneath the cover 10 and between or on either side of the staples 6. I prefer to use a thin stiff cardboard because it is cheap and serves the purpose and can easily be slipped into place, and holds its position in the pad. The carbon may be attached to the strip 9 in any suitable way. As here shown, it is folded over the strip 9 and is then stitched through the strip about half way between the back and front edges of the latter, so as to give a suitable fingerhold underneath the carbon to enable the strip to be pushed into the stub of the book and between the staples. This strip is notched along its back edge to form one or more points 11 which engage between or straddle the staples 6, or equivalent securing means by which the stub 4 is bound together. The way these books are made up there is always room enough between the staples to allow the strip 9 to be pushed in, and the pressure on the points 11 of the stub strip

after the latter has been thus inserted will hold the carbon permanently in position. Whenever the carbon is worn out it is torn off and thrown away, and its strip removed and thrown away and a fresh one inserted.

In order to give a firm backing for the hand in writing and support the pencil point, so as to make a clear carbon copy, and prevent copying by the underneath carbons, I employ a stop-card 12 which is flexibly connected to the back of the cover 10. This stop-card is at the end of the pad opposite to the stub end 4, and is foldable over on to the pad towards the stub and adapted to lie on the pad and beneath an interfolded record-sheet and its carbon and form a writing support when the record is to be made. It will be observed that this stop-card 12 is not bound into the pad, but is entirely independent thereof, being carried by the cover; and a single stop-card serves for the entire pad. It is also practically the same length as the record-sheet.

Having thus described my invention, what

I claim and desire to secure by Letters Patent is—

A manifolding book comprising a pad of leaves each leaf having a stub all the stubs bound together, the leaves being detachably connected to their stubs along weakened lines, a carbon sheet, a relatively stiff strip to which said sheet is secured, which strip is insertible between the stubs of adjacent leaves, said strip having the carbon sheet secured to it between its front and back edges with the free front edge of said strip forming a finger hold to enable the strip to be grasped without contact with the sheet in inserting and removing the strip and sheet into and from the book.

In testimony whereof I have hereunto set my hand in presence of two subscribing witnesses.

JOHN KITCHEN, JR.

Witnesses:

CHARLES A. PENFIELD,
HARRY J. LASK.

NO. 1900
MARCH TERM, 1911

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

JOHN KITCHEN JR. CO.
(A CORPORATION)

Appellant

VS.

ALEXANDER LEVISON,

Appellee

BRIEF FOR APPELLANT

CHAS. E. TOWNSEND,
Solicitor for Appellant.

United States Circuit Court of Appeals

FOR THE NINTH CIRCUIT

No. 1900

JOHN KITCHEN JR. CO.,
(A CORPORATION),

Appellant,

VS.

ALEXANDER LEVISON,

Appellee.

BRIEF FOR APPELLANT.

(The reference to the pages refers to the printed Record).

STATEMENT OF THE CASE.

This cause comes before this Court from the Circuit Court of the United States for the Northern District of California, based on a suit for alleged infringement of United States Letters Patent, Re-issue No. 12005, granted July 1, 1902, to Alexander Levison appellee and complainant below for an improvement in Manifold Books.

This appeal is taken by respondent below from a decree sustaining the patent and holding infringement. An injunction was granted and an order for accounting made. The opinion appears in the printed record.

Both appellant and appellee are in the printing business in San Francisco.

The subject matter involved in the litigation pertains to manifold books, such as are employed for shipping receipts, and other forms of receipts, accounts of sales, etc., where a multiple number of receipts are made at one time; and the controversy particularly concerns a manifold book in which a number of record sheets are bound at the stubs, each record sheet being divided into three separable parts; and a double faced carbon being adapted to be interfolded with the three parts of a record sheet so that three receipts will be simultaneously made on the several parts of the sheets at a single writing. After writing the record the sheet is opened out and torn off and the different parts of the sheet separated and distributed.

The reissue patent sued on contains five claims, whilst the original patent contained but one limited claim, not here involved. The suit however is being based only on reissue claims 3-4-5, and those are the claims which were held by the lower Court to be infringed.

Those claims segregated into their several elements, are as follows:

Claim 3—A manifold book comprising in order:

1—a double carbon sheet,

2—and a plurality of recording sheets,

3—the recording sheets outside the stubs being divided into three substantially equal separable parts,

4—and the carbon sheet extending the width of two of said parts,

5—said recording sheets having stubs to which they are attached along lines of perforations,

6—said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described.

Claim 4—A manifold book, comprising in order:

1—a double carbon sheet,

2—and a plurality of recording sheets,

3—each of said sheets outside the stubs being divided into a plurality, not less than three, of substantially equal separable parts,

4—and the carbon sheet extending the width of said parts, except the outermost,

5—said recording sheets having stubs to which they are attached along lines of perforations,

6—said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described.

Claim 5—A manifold book, comprising in order:

1—a double carbon sheets,

2—and a plurality of recording sheets,

3—each recording sheet outside the stub being divided into a plurality, not less than three of separable are attached along lines of perfortaions,

4—Each part being not greater than the part nearest it at the side toward the stub,

5—and the carbon sheet extending the width of the whole of said parts, except the outermost,

6—said recording sheets having stubs to which they are attached along lines of perforations.

7—said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described.

The fine distinctions of patentable differences between these three claims are hard to see. By analysis it will be seen that they differ in phraseology only, in this that claim 3 calls for a 3-part sheet (element 3), and claims 4 and 5 call for a sheet of *not less* than three parts (element 4).

Levison, the patentee, the only expert called for the complainant, testifies himself, page 54, that claims 3-4-5 are substantially alike. Under the law all of these claims cannot be valid.

Two claims alike in scope, only one can be valid:

Hentschel vs. Carthage Co., 169 Fed. 114;

Shepler, 102 O. G. 468;

Nat. Automatic Weighing Machine Co. vs. N. Y. Scale Co., 145 Fed. 951;

Computing Scale Co. vs. Automatic Scale Co.,
204 U. S. 609; 51 L. Ed. 645;

American Can Co. vs. McGinnis, 156 Fed. 784,
6.

The original patent described and covered as built up of *series of sections* or piles, each section or pile comprising in order a cardboard backing, or stop

card, a plurality of record sheets divided into three separable parts and a double faced carbon of two-thirds the length of a record sheet; the *several sections* or piles being all bound together to form one book. The stop cards and carbons are thus disposed at intervals in the completed book so that there are several carbons for one book and a stop card for each carbon; the number of record sheets for each carbon being estimated and determined according to the life of the carbon and the number of sheets in a section or pile. The purpose of the stop card is to form a firm support to write on and to protect the underneath carbons. The carbons and stop cards are all *permanently bound* into the book.

The single claim of the original patent was as follows:

A manifold book:

1—composed of sections, each section comprising in order,

a—a double carbon sheet,

b—a plurality of recording sheets,

c—and a cardboard backing,

2—the recording sheets being divided into three separable parts,

3—the carbon sheets extending the width of two of said parts,

4—and the cardboard backing extending the width of one of said parts,

5—said recording sheets and backings having stubs to which they are attached along lines of perforations,

6—said stubs and the edges of the carbon sheets being all bound together to form a book, substantially as described.

While Levison shows and described several of these sections or piles made up as stated and all bound together under one cover, yet *each section, with its pile of leaves, carbon and stop card*, may be considered, as far as claims 3-4-5 are concerned, *as a book in itself* as will be seen later. The *multiplying* of the number of sections or piles in one book is mere duplication. Although this built up duplicated structure constituted the original invention and the subject matter of the single original claim, or claim one of the reissue as modified, it has nothing to do with the present issues. This distinction is to be borne in mind by the Court, in dealing with the questions of anticipation and infringement. There is no contention that this built up structure of *multiplied sections or piles* is infringed.

The re-issue claims 3-4-5 sued on attempt to cover simply a book made up of a *single section* or pile, comprising one double faced carbon only and a number of record sheets divided into three or more separable parts, the carbon and record sheets being bound together. These claims do not involve in any way a *stop card or cardboard* backing.

The respondent appellant justified under a later patent No. 911597, dated Feb., 1909, (applied

for July 20, 1908), in which the record sheets alone were bound into a book *without* any carbon or stop card; the carbon being a *loose* carbon later inserted among the leaves of the book at any desired point and being freely removable therefrom, and re-inserted at any other point; the stop card being loose so as to be inserted at any point into the book and directly under the sheet to be written on. The *defendant's patent* is primarily on his *carbon*.

The whole issue of infringement hinges on the question, whether defendant's carbon-holding means is the equivalent of the *bound* carbon of Levison.

The grant of defendant's patent on his special carbon-holding means, subsequent to the Levison patent is proof positive that the two are not equivalents. This case is much stronger than the rule concerning "presumption of difference and non-infringement" arising from the grant of a subsequent patent on a *whole machine*. Here defendant's patent is practically based on the *single element* underlying the question of equivalency. Patentable difference presupposes lack of equivalency.

PLAINTIFF'S ORIGINAL PATENT.

(For drawing, see plate at back of this brief).

As far as the drawings are concerned, they are the same in both the original Levison patent and the re-issue patent, here sued on.

The drawings of this patent and also the drawings of the defendant's patent, together with the drawings of the anticipating prior patents relied on by defen-

dant are shown graphically on a single foldable sheet at the back of this brief, whereby at a single glance the Court may see and understand the constructions and issues involved.

From this graphic representation it will be seen that manifold books were old in the art at the time of the advent of the plaintiff into the field. Tripling books were old. Manifold books with *bound carbons* and record leaves made up of a plurality of separable parts were old; and *double-faced carbons* were old. All these manifold books operated on the principle of folding the record sheet one or more times on the carbon, according to the number of duplicate copies to be made at one writing.

Levison says in both his re-issue and in his original patent:

“My invention relates to an improved manifold receipt and record book for mercantile, railway, express or other business uses.

“The object of my invention is to provide a book of this character which shall be convenient in use, economical in the number of carbons required; which shall give secure protection against alterations and forgeries, and the sheets of which can be readily and conveniently placed on record after the impression has been taken.

“My invention therefore resides in the novel construction, combination and arrangement of parts for the above ends, hereinafter fully specified and particularly pointed out in the claims. *

* * Referring to my drawings it will be seen

that my improved manifold book is formed in sections, each section comprising in order, first, a carbon sheet 1, of about two-thirds the width of the book, then, below said carbon sheet 1 a number of sheets 2, the ordinary paper, the full width of the book, then a sheet 3 of hard, thick cardboard."

The description in the re-issue from thereon is different from that in the original patent. In the original patent Levison says:

"Each recording sheet is divided into *three parts* by vertical lines of perforations 4, said parts having suitable printed matter 5 and blank lines 6, whereon to transcribe the desired record."

He then states that the record sheets, stubs and carbons, "are all bound together to form a book."

The mode of operation in using one of these books is described by Levison in both the original and in the re-issue patent, as follows, lines 55-75:

"In use the record-sheet is first folded on the outer line of perforations 4, so as to cover about one-half of the carbon-sheet, and it is then folded in the same direction on the second line of perforations, so that the carbon is now folded inside of the record-sheet, as shown in Fig. 2. The record will now be written upon what was the back of the middle portion of the sheet when it was flat and unfolded, which will now, however, have come to the top. The carbon-sheet is double or carbonized on both sides, so that a copy of the record will be made upon each of the two terminal parts of the sheet. Also an inverted or backhanded copy of the writing will be formed upon

the back of each part, except the inner one. This latter feature gives additional security against subsequent alteration of the record, since it is difficult to erase and rewrite both the original and the reverse copy.”

Levison emphasizes in the succeeding paragraphs of his original patent especially the feature of the use of his backing to form a smooth writing surface, and also to protect the carbon paper and says in conclusion, lines 94-102:

“The cardboard backings are an important feature of my invention, since they permit a large number of sheets to be bound into a book with a small number of carbons without any danger of transmitting an impression from one sheet to another sheet. They are readily removable by means of the lines of perforations when all the sheets above them have been used.”

PLAINTIFF'S RE-ISSUE PATENT SUED ON.

(For drawing see plate at back of this brief).

The re-issue patent, in addition to embodying the matter of the first patent, the essential portions of which are quoted above, has without warrant, as we shall point out later, particularized that each record sheet, “outside the stub 7 is divided into three *substantially equal* parts”; (See lines 40-42, page 1, Levison re-issue patent), and in the second column of the patent there has been inserted the following paragraph bodily:

“It has been already stated that the three separable parts of each recording-sheet are substantially

equal. They are not exactly equal, since it is preferable to provide the innermost part with an unprinted additional space or margin next the stub through which are punched the holes 9 to facilitate the filing of said part. Moreover, it is better to leave a small space between the edge of the sheet when folded and the line of perforations 8, as this renders it easier to fold the parts. With this exception the separable parts of each recording-sheet are of the same size and in general will contain identical printed matter thereon."

The only basis for claims 3-4-5 sued on depends entirely on these insertions. Consideration of their import and their effect on the re-issue will be deferred until we take up that phase of the matter in the argument.

THE PRIOR ART.

THE BARLOW PATENT.

(For drawing see plate at back of this brief).

This patent is defendant Exhibit 1, and appears on page 306 and following, of the Record. It was issued April 29, 1884, and expired 17 years thereafter or 7 months before Levison filed his original application on December 4, 1901.

The Barlow book is a triplicate book with record sheets divided into the three separable parts exactly as in Levison and using a double-faced carbon two-third the length of the record sheet, just as in Levison. The one difference is that the Barlow carbon is a loose carbon and Levison is a bound carbon.

(With reference to the Barlow drawings, it is to be born in mind that the book of Fig. 1 in Barlow and the illustration of the carbon "F" are not on the same scale. The carbon is of sufficient size to cover section A and B of Barlow's record sheet.)

The Barlow patent is for "A device for Manifold Copying". The patentees say:

"Our invention relates to an improvement in devices for manifold copying, the object being to facilitate the preparation of duplicate copies of writing by reducing the number of detached copying and blank sheets to the minimum.

"With these objects in view our invention consists of blank sheets divided into three equal sections by lines of perforations, and printed in the manner herein shown and described, whereby the sections may be folded upon each other with a single sheet of copying-paper in such manner that matter written upon one section will be reproduced upon the other two."

Their invention is described, as follows:

"The blanks are divided into *three equal sections*, A, B, and C, by lines E of perforations, which adapt the sections to be folded upon each other, and to be separated and distributed as required. The sections A and C are printed upon the same face of the blank, while the section B is printed upon the opposite face thereof."

This printing of the record sheet of Barlow and the illustration of the manner of printing coincide exactly with the Levison drawing and book, as will be

seen by comparing the two adjacent plates at the back of this brief. Barlow's carbon or copying sheet "F" is "carbonized on both sides", but Barlow says:

"Paper carbonized on one side will do as well, though perhaps not quite as convenient to handle."

The manner of manipulating the Barlow book is described by the patentees as follows:

"In using the paper having both faces carbonized, a *sheet of sufficient size to cover two of the three sections* of each blank is employed. Such a sheet is laid over the printed side of section A and the unprinted side of section B. *The section C is now folded to the left and laid upon the copying-paper covering the unprinted side of the section B. Then the two sections B and C, with the interposed copying-paper, are folded to the left and laid upon the copying-paper covering the section A. The printed surface of the section B becomes the uppermost, as the result of folding the blank in the manner described, and this section is accordingly written upon with a pencil, and the matter written is duplicated upon each of the sections A and C.*"

The patentees then point out the advantage of the use of a single sheet of carbon paper producing triplicate copies in the following language:

"*It will be seen that with one blank sheet, and with a single sheet of carbon-paper, two duplicates of the written matter are produced, whereas two detached sheets of copying-paper have heretofore been necessary to get the same number of copies.* The old method is objectionable on account of the number of sheets

to be adjusted and cared for, and to the shipping-clerk, who carries the sheets from place to place, the handling and care of the sheets is a source of great annoyance.”

The marked similarity between the construction, mode of operation and results to be accomplished by Barlow and Levison is manifest on the face of the two patents.

Mere inspection of the Barlow patent at once discloses all the features of Levison in so far as the claims here sued on are concerned, except that the limitation is imposed upon Levison that his carbon and record sheets must be “bound”. The single claim of Barlow is as follows:

“An improved blank for manifold copying, consisting:

“1—of a sheet of paper,

“2—divided into *three equal sections*,

“3—by lines of perforation,

“4—and printed in the same manner herein shown and described,

“5—whereby the sections may be folded upon each other with a *single sheet of copying paper*,

“6—in such manner that matter written upon one section will be reproduced upon the other two, substantially as set forth.”

Obviously, the above exactly describes the Levison device.

It is elementary that, “That which infringes if later would anticipate, if earlier”.

Muller vs. Eagle Mfg. Co., 151 U. S. 186;

Eames vs. Worcest Polytechnic Institute, 123 Fed. 67.

THE DOUGHTY PATENT.

Drawings of this Doughty patent are shown on the plate at the back of this Brief and is represented by defendant's model Exhibit 10.

The Doughty invention is for "a manifold book".

He says in his specifications:

"My invention relates to improvements in manifold sales-books; and the object is to provide a triplicate book that will be simple and convenient."

He shows two styles of book, one style in Figs. 1 and 2 which corresponds to our model exhibit 10, and Fig. 4 shows a modification, with which we are nowise concerned. However, the plaintiff, with what purpose we cannot understand, unless it was to befog the issue and mislead the Court, has introduced in evidence a model marked "Exhibit Q", which shows the two single carbon arrangement of Doughty's Fig. 4. It seems apparent to me from reading the Opinion of the Lower Court that the Trial Judge did mistake this Exhibit Q, Fig. 4 as being the Doughty device, relied on by the respondent. Fig. 3 is to be read with Figs. 1 and 2 on an enlarged scale, with the cover A and clamp A, lacking. The difference between the preferred form of Doughty shown in Figs. 1 and 2 and the modification of Fig. 4 is pointed out by the patentee, as follows:

“In the first two figures of the drawings the clamp A' is secured to the inner side of the cover on the right-hand side of the hinge. The *bound* ends of the leaves are held in this clamp with their free ends extending to the right, but with their end sections *b''* turned inward and lying on their respective central sections *b'.*”

In Fig. 4 the clamp A' is on one end of one leaf, 2 carbons are used instead of one, as in Figs. 1 and 2, and the arms *d'* are hinged to one cover between the clamp A and the middle of the book, while in *Fig. 1* these arms which carry the double carbon are hinged to the cover at a distance from the center of the book equal to the length of two of the leaf sections. The construction and mode of operation of the Doughty structure shown in Figs. 1 and 2, *and that is the only structure that is pertinent to this consideration*, is given by the patentee as follows:

“The full leaves B are each divided into three sections *b, b', and b''* and a stub *b'''* by perforated lines *c, c' and c''* and these sections, when folded on the said lines with the carbon-sheet inclosed, form at one writing three distinct copies, *b'* being the original, *b''* the duplicate, and *b* the triplicate, which latter can be retained in the book or removed, as desired.

“The *carbon sheet C* is as wide as the leaves, as long as two of the sections, and is carbonized on both sides. Said carbon-sheet is held by a clamp D at one end, the clamp being mounted on the free ends of arms *d d*, turning in eyes, *e e*, secured to the inner side of the cover, near its right-hand edge.

“In using the form of book shown in the first three figures of the drawings the end section *b*” of the uppermost leaf is raised to allow the end of the carbon-sheet *C* to drop onto the underlying section, as shown in Figs. 1 and 2, and then the sections *b*” and *b*’ together with the end of the carbon-sheet, is folded on the perforated line *c*’ over upon the other section *b*, as indicated in Fig. 3 of the drawings. Any writing that is made upon the central section *b*’ will be copied on the other two sections of the leaf. After the writing one or all of the sections written upon may be torn out, leaving the next full leaf in position for a like manipulation.”

Harry Levison, one of the officers of the plaintiff’s company, testified that the Doughty carbon was a “bound” carbon. Page 251-254:

“XQ. 28. And they are *all bound together with stubs and carbons to form a book?*

“A. Yes, it *all forms a book; yes*. I will say for your benefit that the patentee of that book is trying to get at the proposition of binding a carbon to a book so that it could be easily handled, but that he has got a very awkward maner of binding the carbon to the book, and a very awkward manner of handling the carbon.”

So the best excuse Levison can offer to Doughty is that it is “awkward.” Otherwise it is admitted to be a complete anticipation. In legal contemplation mere “awkwardness” does not militate against a patent being a good reference for a later one; nor does the law recognize as invention mere change in “form, pro-

portion or degree" which may make the later structure somewhat more convenient. *Galvin vs. City of Grand Rapids*, 115 Fed. 511 C. C. A.; *Babcock & Wilcox Co. vs. Toledo etc. Co.*, 170 Fed. 81 C. C. A. "Convenience" anyhow is a good deal a matter of personal opinion.

Levison also testified, page 255:

"A. When you lay your carbon down, when you place your carbon in position, it extends the width of two, except the outermost.

"XQ. 30. And we also have in this Doughty Exhibit 'P' a plurality of recording sheets, each recording sheet outside of the stub being divided into a plurality of not less than three of separable parts joined along lines of perforations? You have stated that; each part being not greater than the part next it on the side toward the stub; is that not true?

"A. Yes."

From the foregoing it appears that every element of the Levison claims sued on, is apparent in Doughty.

"That which infringes if later, would anticipate if earlier."

ABRAHAM PATENT.

This patent is defendant's Exhibit 3, and is shown on the plate at the back of this brief.

This Abraham book is a manifolding book, and the patent was issued more than two years prior to the date of the application of Levison. While in style it is somewhat different from that of the patents previously referred to, it is nevertheless a manifolding

book and is mainly pertinent as showing record leaves divided into three sections, and using a “bound” carbon adapted to be interfolded with the sections.

The patentee says:

“My invention relates to that class of sales-book in which a leaf of carbon-paper is adapted to be inserted between two adjacent leaves, whereby an original and a carbon copy of the sales-memorandum can be produced and the sheets be detached from the book and from each other, so that the customer may receive one record and another be retained at the store.

“My improvements consist generally in dividing each half of a folded sheet of a manifold sales-book into *three sections*, the top and bottom sections having provision for the name and address of the purchaser and the intermediate section having provision for memorandum of sale and amount of same and the bottom section also having provision for the amount of sale and said sheet having lines of detachment between the top and intermediate sections of the upper half and between the bottom and intermediate sections of the lower half.”

This patent clearly shows that “bound” carbons were old and well-known before Levison’s invention.

In his claim 2 Abraham includes as an element, “a carbon leaf *bound* into the book and adapted for insertion under the upper half of the folded sheet, each half of said sheet being divided into *three sections*.”

BENGOUGH PATENT.

This patent is shown in defendant's Exhibit 7, and a drawing of it is shown on the plate at the back of this Brief.

This patent was introduced to show the state of the art as relating to bound carbons. The patentee says:

"My invention relates to improvements in manifold sales-books; and the object is to provide a more simple and inexpensive book that will be both serviceable and convenient."

Again lines 70 to 75, he says:

"One side edge of the originals *B* is *bound* by the same staples *a* to the double leaves, the two black or carbon leaves *D-D'* being *bound* between the two series of leaves."

The claims of Bengough refer to *bound* carbons and *bound* leaves "substantially as described and shown."

PERRY PATENT.

This patent is defendant's Exhibit 6, and is illustrated on the plate at the back of this Brief and shows another form of manifold, triplicate sheet using a *single* double-faced carbon.

Perry says:

"My invention relates to manifold receipt and record books for mercantile, railway, express and other business uses."

Perry further says that the object of his invention is the "production of a manifold-copying sheet or book of such sheets, so constructed that by the use

of a single sheet of carbon-paper interposed between the folds of said sheet a plurality of impressions may be obtained from a single writing, one of which will be upon the portion of said sheet designed to be retained as a permanent record and the balance upon the detachable remainder of said sheet; and a further object of my said invention is to cheapen the cost of manufacturing books and sheets of this general nature."

In conclusion he says:

"By the use of my invention I avoid the necessity of printing the sheets upon opposite sides thereof, thereby effecting a great saving in the cost of manufacture and am enabled to obtain perfect triplicate copies with the use of a single sheet of carbon-paper."

It seems to be quite common for all of these patentees to claim the advantage of economy and simplicity, and the use of a single carbon, and they evidently filled the "want" which called their invention into being. Some preferred bound carbons, some unbound carbons; some double carbons and some single carbons.

DEFENDANT'S BOOK AND PATENT.

Defendant's book is represented by complainant's Exhibit A, and is built under and in accordance with patent No. 911,597, dated February 9, 1909, and issued to Mr. Kitchen, President of the defendant company. The drawings of the patent are illustrated on the plate at the back of this Brief.

Defendant's book is made up of a series of sheets divided into three parts, just as in Barlow, Doughty and Levison. Defendant uses a double-faced carbon, two-thirds the length of these record sheets, just as in Barlow, Doughty and Levison.

Defendant's carbon however, is attached to a separate piece of cardboard 9, which is notched out so that it may be inserted anywhere into a book after the latter is bound up and by the frictional engagement of the stubs is held temporarily in place. It is readily removable just as Doughty or Barlow, and as far as being "secured in the book," it would stand midway between Barlow and Doughty; Barlow typifying a (loose) carbon in its general sense, and Levison typifying a *bound* carbon, with the Doughty patent intermediate of the scale between Levison and Kitchen; that is to say, the Barlow, Kitchen, Doughty and Levison patents are all in the *genus*, or general class of manifolding books; this genus being divided into *two species*, one of "loose carbon books", and the other of "bound carbon books".

Barlow, Perry and defendant belong to the class of "loose" or "unbound" carbons; and Doughty, Abraham, Bengough and complainant belong to the class of "bound" carbon books. This is a distinction that we have heretofore maintained prevails in the art, and it is the proposition that we purpose to maintain on this Appeal.

The Court should not be misled as to the purpose and character of many of the exhibits in the case because the complaintant has placed great reliance on a

lot of manifolding books and devices, (particularly exhibits D, E, F, G, I, K, O, S, T, U, V, W, X, Y, Z, AA, BB), introduced by him.

These exhibits were all introduced by the complainant over the objections of defendant. Levison would have the Court believe that these devices constitute the real prior art. They do not represent the prior art in any true sense and represent nothing that this defendant relies upon. Of course they are generally as far from the complaint's device as they well could be imagined to be, and if these "transparent sheet books" and "two-piece single carbons" and "torsion binders" were all there was antecedent to the Levison patent it would be a simple matter to hold that Levison had possibly invented something. These exhibits of complainant were lugged in on rebuttal by complainant apparently for the simple purpose of befogging the issue. Their presence in the case would make it appear that they constituted the basis of the defense of anticipation. Complainant would even have this Court believe that Exhibit O represents the Brown patent, defendant's Exhibit 4. As a matter of fact Brown was introduced by defendant solely for the purpose of showing Brown's *stop card* D which is the same as that used by defendant (but on which stop card Brown has no special claim). Brown however became of no importance as a defense as soon as the complainant abandoned his claim to infringement of claims 1 and 2 of the Levison patent. It was with respect to these two claims and those only wherein a "stop card" formed an element, that

Brown was introduced. Claims 3-4-5 on which the complainant elected to rest its case have nothing what so ever to do with any “stop card” or “cardboard backing”, but one simply limited to a *pad of leaves in which the leaves are divided into three sections, with a carbon bound into the pad.*

Therefore in considering the *prior art* the Court will please bear in mind, that it is not the defendant who has sought by this heterogenous mass of exhibits above mentioned, of complainant, to show anticipation; but that this defense is embodied in the Barlow Doughty, Abraham, Bengough and Perry patents above mentioned. These five patents (and in fact most any of them singly) culled from hundreds of other patents in this overcrowded art (overcrowded at the time of Levison’s debut into the field) we claim are sufficient to show that so far as claims 3-4-5 are concerned Levison invented nothing.

These patents are sufficient to indicate the evolution and development of the means for reproducing duplicate and triplicate tags by a single writing on an original, and go to show that years before the date of the patent in suit it was notoriously common to reproduce three carbon copies in exactly the same way, for the same purpose and by the same means as complainant appellee does in his patent sued on. The art was already crowded with patents for manifolding books generally and triplicating books especially having *bound* carbons at the time of the complainant’s alleged invention. Notwithstanding this condition of affairs which rendered the Levison pat-

ent of most marginal character and the further fact that the complainant himself admitted that he did not claim a *duplicate* book with a bound carbon, but only claimed a book for *triplicating* or quadruplicating purposes using a *bound* carbon, pages 50-51, the Court below gave the patent in suit a broad and liberal construction and enjoined the defendant as an infringer and ordered an accounting.

The defenses are:

- 1—want of invention,
- 2—anticipation,
- 3—that the Levison patent is void as a re-issue,
- 4—non-infringement.

ASSIGNMENT OF ERRORS.

The errors assigned on which this appeal is based are set out on pages 271-3 of the Record and are as follows:

“1. That the Circuit Court of the United States for the Northern District of California erred in holding that the claims of complainant’s patent, and especially Claims 3, 4 and 5 sued on, were, or any of them, valid.

“2. That the Circuit Court of the United States for the Northern District of California erred in holding that the claims of complainant’s patent, and especially the claims sued on, were not each and all anticipated by the prior art.

“3. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant’s patent, with especial refer-

ence to the claims sued on, presented patentable novelty in view of the Barlow, or Doughty, or Abraham patents.

“4. That the Circuit Court of the United States for the Northern District of California erred in holding that the claims of complainant’s patent sued on, or either of them, represented a patentable invention.

“5. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant’s patent was not void as a reissue.

“6. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant’s patent, and especially the claims sued on, and each of them, or any of them, were entitled to a liberal construction and application of the doctrine of mechanical equivalents.

“7. That the Circuit Court of the United States for the Northern District of California erred in holding, in view of the prior art, that the defendant’s device did not represent a distinct, different and independent invention from complainant’s.

“8. That the Circuit Court of the United States for the Northern District of California erred in holding that the loose carbon of appellant was the equivalent of the bound carbon of complainant appellee.

“9. That the Circuit Court of the United States for the Northern District of California erred in holding that complainant’s patent was infringed.

“10. That the Circuit Court of the United States for the Northern District of California erred in enjoining the respondent.

“11. That the Circuit Court of the United States for the Northern District of California erred in sustaining the bill of complaint.”

BRIEF

BRIEF

MEMORANDA.

The Levison book with respect to the claims sued on (3-4-5) does not represent a patentable invention.

INVENTION.

It is not enough that the thing shall be new in sense of form or shape and be useful, but it must amount to an invention.

Hill vs. Wooster, 132 U. S. 693, 701.

In Slote & Co. vs. Stratton Co., 159 Fed. 485, 481 (a case involving a blank book), it was said:

“Not all improvements are invention. There must be something more. *Loom Co. vs. Higgins*, 105 U. S. 591, 26 L. Ed. 1177; *Pearce vs. Mulford*, 102 U. S. 112, 26 L. Ed. 93; *Burt vs. Ecory*, 133 U. S. 349, 10 Sup. Ct. 394, 33 L. Ed. 647; *Dodge Coal Storage Co. vs. N. Y. C. & H. I. R. Co.*, 150 Fed. 738, 80 C. C. A. 404. It is not necessary to find the precise process or structure in the prior art. It is all-sufficient if we find the path open, made so clear that the ordinary mechanic skilled in the art would see and construct and apply.”

PRIOR ART.

Barlow, 1884: shows triplicate book and single double-faced carbon. Everything that Levison has except that Barlow's carbon is *loose* and not *bound*.

Doughty, 1898: shows a triplicate book with single double-carbon attached to the book and “*restrained*” so it can not fall out. This is admitted by Harry Levison to be a *bound* carbon and in the sense contended for by complainant it absolutely meets the claims sued on.

Perry, 1896: shows a triplicate book with double-faced loose carbon, but folded somewhat differently from any of the other patents.

Abraham, 1899: shows a bound carbon with leaves divided into three or more separable parts. It exactly fits the Levison claims, except as to the *proportional size of the divisible parts* of the leaves.

Bengough, 1896: shows a duplicate book with bound leaves.

ALL THAT LEVISON DID WAS TO BIND THE ABRAHAM CARBON IN THE BARLOW BOOK.

HIS SO-CALLED INVENTION WAS MERE DOUBLE USE.

The transfer of a device from one “art” to another where it performs the same functions as before is not invention:

Standard Caster Wheel Co. vs. Caster Socket Co., 113 Fed. 162, C. C. A.

Ransome vs. Toledo etc. Co., 172 Fed. 371
165 Fed. 914.

NEITHER THE BARLOW PATENT NOR DOUGHTY WERE CITED BY THE EXAMINER DURING THE PENDENCY OF THE LEVISON RE-ISSUE APPLICATION.

This weakens rather than strengthens the patent:

Cleveland Foundry Co. vs. Kauffman;
C. C. A.;

Cleveland Foundry Co. vs. Kauffman;

Amer. Soda Fountain Case vs. Sample, 130
Fed. 145, C. C. A.;

Elliott Co. vs. Youngstown Car Co. 181 Fed.
145, C. C. A.;

Pope Mfg. Co. vs. Arnold Schwinn Co., 177
Fed. 419.

**CLAIMS 3, 4, 5, SUED ON ARE IDENTICAL AND ALL
CAN NOT BE VALID.**

“Mere change in form, proportion or degree is
not invention”:

Smith vs. Nichols, 21 Wall 112; 22 L. Ed. 566;

Neureuther vs. Ceneral Paint Zinc Co., 179
Fed. 851, C. C. A.

**MERE COMMERCIAL SUCCESS OF COMPLAINANT'S
BOOK (AND ITS SUCCESS IS SHOWN NOT TO BE NEAR
AS GREAT AS HE CLAIMS IT TO BE) IS NO CRITERION
OF INVENTION WHEN THE PATENT IS VOID OR WHERE
THE SUCCESS MAY BE ATTRIBUTED TO OTHER
CAUSES.**

As was said by Judge Hawley, in this circuit,
speaking for the Circuit Court of Appeals, in the

case of *American Sales Book Co. et al. vs. Bullivant*, 117 Fed. 255, 259:

“The mere fact that a patented device or article meets with increasing sales and is popular, is wholly unimportant when it clearly appears that the invention is without patentable novelty.” (Citing cases.)

“Much stress has been laid upon the commercial success of the Grant tire. Aside from the fact already mentioned, that much of the durability of the tire is due to the better quality of rubber used, *there is much evidence that this success is largely attributed to the power of great capital in buying or crushing out rivals, and to great business push and advertising.* . . . The general use of a patented article is only evidence of value when the novelty or utility of the article is a matter of great doubt, and *its evidential value in even such cases is nothing when it can be attributed to something other than novelty. Watch Case Co. vs. Robbins*, 21 C. C. A. 199, 75 Fed. 17; *Lane vs. Welds*, 39 C. C. A. 528, 99 Fed. 286; *McClain vs. Ortmyer*, 141 U. S. 419, 12 Supt. Ct. 76, 35 L. Ed. 800.”

Goodyear Tire & Rubber Co. vs. Rubber Tire Wheel Co., 116 Fed. 363, 377, C. C. A.;

See also *Boss Mfg. Co. vs. Thomas*, 182 Fed. 811, C. C. A.

THE RE-ISSUE IS VOID BECAUSE:

1—it is not for the “same invention” as the original,

2—it introduced new matter into the specification,
 3—the amendments adding the new matter were not substantiated by an oath of the inventor as required by law.

Acetylene Burner Case, 215 U. S.—reported in U. S. Sup. Ct. advanced sheets No. 3 for Jan. 1, 1910.

THE LEVISON PATENTED DEVICE IS A CLEAR INFRINGEMENT OF THE BARLOW CLAIM.

Therefore in so far as Barlow does not actually anticipate Levison, it limits Barlow to his exact structure and therefore respondent whose carbon is separately patented, does not infringe.

Holt Mfg. Co. vs. Best Mfg. Co., 172 Fed. 409, C. C. A., 9th Cir. opinion by Judge Ross.

IF THE CLAIMS OF LEVISON ARE TO BE SUSTAINED AT ALL, THE SPECIFIC CONSTRUCTION SHOWN IN HIS DRAWINGS AND DESCRIBED IN HIS PATENT MUST BE IMPORTED INTO THE CLAIMS, AND THEREFORE LEVISON IS LIMITED NARROWLY TO HIS EXACT DEVICE.

Consolidated Roller Mill Co. vs. Walker, 138 U. S., 34 L. Ed. 920-923;

McCarty vs. Lehigh Valley R. R. Co., 160 U. S. 116;

Lewis Construction Co. vs. Semple, 177 Fed. 407, C. C. A. (this circuit).

THE ISSUANCE OF RESPONDENT'S PATENT RAISES A PRESUMPTION IN HIS FAVOR, NOT ONLY OF PATENT-

**ABLE DIFFERENCE, BUT IN VIEW OF THE PRIOR ART,
OF NON-INFRINGEMENT.**

Corning vs. Burden, 15 How. 252, 14 L. Ed. 683-691;

Royd vs. Janesville Hay Tool Co., 158 U. S. 261, 39 L. Ed. 973-975;

Kokomo Fence Co. vs. Kitselman, 189 U. S. 8, 49 L. Ed. 689;

Taber vs. Marceau, 87 Fed. 871 (opinion of Judge Morrow).

INFRINGEMENT.

Under no view of the case should the respondent be held to infringe. Levison claims a "bound" carbon and respondent uses a loose or unbound carbon.

When an invention is not a pioneer invention, the inventor is held to a rigid construction of his claims, (*Wright vs. Yuengling*, 155 U. S. 47, 15 Sup. Ct. 1, 39 L. Ed. 64), and is not entitled to any considerable range of equivalents (*Kokomo Fence Machine Case*, 189 U. S. 8, Sup. Ct. 521, 47 L. Ed. 689; *Cimiotti, etc. vs. American F. R. Co.*, 198 U. S. 399, 25 Sup. Ct. 697, 49 L. Ed. 1110; *Computing Scale Co. vs. Automatic etc.*, 204 U. S. 609, 27 Sup. Ct. 307, 51 L. Ed. 645), but still the range of equivalents depends upon the extent and nature of the invention (*Paper Bag Patent Cast*, 210 U. S. 405, 28 Sup. Ct. 748, 52 L. Ed. 1122; *Miller vs. Eagle M. Co.*, 151 U. S. 207, 14 Sup. Ct., 310, 38 L. Ed. 121.) And when, in a patent for a mere

improvement, which, in view of the prior art, is extremely narrow, the patentee has limited his claims by specific words to a specific form of device or element, he is bound thereby. *Coupe vs. Royer*, 155 U. S. 565, 15 Sup. Ct., 199, 39 L. Ed. 263; *McClain vs. Ortmyer*, 141 U. S. 419, 425, 12 Sup. Ct. 76, 35 L. Ed. 800; *Burns vs. Meyer*, 100 U. S. 671, 672, 25 L. Ed. 738; *Keystone Bridge Co. vs. Phoenix, etc.*, 95 U. S. 274, 278, 24 L. Ed. 344.

“**BIND**: To *sew* or *fasten* together and inclose in a cover; as to *bind* a book.”—*Webster’s International Dictionary*.

“**BINDING**: The cover of a book with the *sewing* and accompanying work.”—*Century Dictionary*.

“**BOOK**: A collection of paper leaves *sewed* or *bound*, used for any kind of writing.”—*Worcester*.



ARGUMENT

ARGUMENT.

His Honor, Judge Van Fleet, in sustaining the Levison patent necessarily held that it involved invention.

Invention, as found by him, appears to have been predicated mainly on the simplicity and practicability of the Levison device, and on an imperfect and apparently incorrect conception of the prior art, and of the law governing patentable invention. This criticism is made with all due respect to this Honorable Court and to the Court below.

In approaching this question, we think it proper to define, "What is Invention"?

INVENTION.

Walker says, Sec. 23, on the topic of Invention:

"Novelty and utility must indeed characterize the subject of a patent, but they alone are not enough to make anything patentable; for the statute provides that things to be patented must be invented things, as well as new and useful things. The courts have therefore declared that not all improvement is invention, and entitled to protection as such, but that to be thus entitled, a thing must be the product of some exercise of the inventive faculties."

Justice Matthews for the Supreme Court in *Hollister vs. Benedict Mfg. Co.*, 113 U. S. 72, in speaking of a simple device which the Court held not to be an invention, said:

"It seems to us not to spring from that intuitive faculty of the mind put forth in search for new re-

sults or new methods, creating what had not before existed, or bringing to light what lay hidden from vision; but, on the other hand, to be the suggestion of that common experience which arose spontaneously, and by a necessity of human reasoning, in the minds of those who became acquainted with the circumstances with which they had to deal.

“It is not invention to produce a process, machine, manufacture composition of matter or design which any skillful mechanic, electrician, chemist, or other expert would produce whenever required.”

Walker, sec. 25.

In holding a patent to be void the Supreme Court, in *Atlantic Works vs. Brady*, 107 U. S. 199, speaking by Justice Bradley, said:

“The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant to a single party a monopoly of every slight advance made, except where the exercise of invention somewhat above ordinary mechanical or engineering skill is distinctly shown, is unjust in principle and injurious in its consequences. The design of the patent laws is to reward those who make some sub-

stantial discovery or invention which adds to our knowledge and makes a step in advance in the useful arts. Such inventors are worthy of all favor. It is never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufactures. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.”

After quoting the above, Walker says:

“This opinion of Justice Bradley is now a classic. Many federal judges, during twenty years, have administered it as law; and some have paraphrased it in sound and suggestive language of their own. For example, Judge Philips has said that: ‘In this day of increasing demand for new and enlarged mechanical appliances, the first natural result is the production of a large class of skillful and experienced mechanics and artisans, and, second, a more studious and constant development in applied mechanics.

And as such advance plainly points out, to the attentive and assiduous workman, the natural, larger, practical adaptation of existing, known mechanical devices; to invest each one of these developments with the immunity of a monopolizing patent, would not only be a perversion of the term ‘“invention”,’ but would utterly extinguish the doctrine of mechanical equivalents.’ And Judge Coxe has said that a chemical patent is addressed to accomplished chemists and ‘That which seems, to the ordinary layman, to involve the exercise of extraordinary mental power, is to these men nothing but the everyday work of laboratory routine.’ And Judge Townsend has said that an electrical patent should be stripped of the dazzling halo which conventionally adorns appliances designed to deal with that mysterious agent, electricity; when a court is called on to decide the question of the presence or absence of invention, in an electrical patent.

“Nearly a hundred other cases, involving the rule of this section, have now been adjudicated and reported.”

It does seem to even a casual observer that Levi-son has claimed “a shadow of a shade of an idea” in his re-issue by even attempting to get a patent on a “bound” carbon over Barlow.

“Invention” is often defined negatively. The present case illustrates the oft-repeated rule of the courts “that mere change in form, proportion or degree or the carrying forward of an old idea is not invention. As recently said by Judge Seaman in

Neureuther vs. Mineral Paint Zinc Co., 179 Fed. 851, C. C. A.:

“Through the above-recited evolution of furnace building and trial, in the plant of the Illinois Zinc Company, Neureuther achieved superior results in the three-port form of furnace, as an improvement both on the original Siemens device and on his own two-port furnaces, after the latter had continued in practical operation for about seven years. The outcome of his efforts was an improved zinc-smelting furnace of the Siemens type, and its superiority over other forms of furnace, at least in economy of fuel and space, appears from the testimony. Were the new and useful qualities of the three-port furnace, therefore, the test of patentality, no difficulty would appear in upholding the patent; but invention is the test which must be applied, and for solution of that inquiry under the facts stated, we believe one rule to be well settled and applicable, namely: That ‘a mere carrying forward or new or more extended application of the original thought, a change only in form, proportions, or degree, the substitution of equivalents doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.’

“*Smith vs. Nichols*, 21 Wall. 112, 119, 22 L. Ed. 566;

“8 Notes U. S. Rep. 389;

“*Wilce vs. Bush Temple Music Co.*, 134 Fed. 389, 391, 67 C. C. A. 371.”

It would not involve invention to bind the double-folded single carbon of Barlow into the stubs (particularly in view of Abraham or Doughty or Bengough), on the general principle of patent law that it is not invention *to make in one piece and article which has formerly been made in two pieces*; considering Abraham a “one-piece” book and Barlow a “two-piece” book.

Howard vs. Detroit Stove Works, 150 U. S. 164.

“Moreover, it has been held that invention is not disclosed by merely making in a single piece a device or connection which previously had been made of separate parts. *General Electric Co. vs. Yost Electric Co.* (C. C.) 131 Fed. 874, affirmed 139 Fed. 568, 71 C. C. A. 552.”

Keepers vs. Amer. Elec. Fuse Co., 177 Fed. 442.

We respectfully urge upon the Court that the patent of Levison in so far at least as the claims here sued upon are involved, does not and never did at any time subsequent to the Barlow patent, present a patentable invention. As before pointed out, it is to be clearly kept in mind that the issue involved on the point of invention, is whether it was invention at the time of Levison’s invention to bind a carbon in with the leaves; the leaves being divided into three

sections and the carbon to be double-faced and two-thirds the length of the leaves; remembering that Barlow used the same leaves and carbons without binding; that Doughty used the same leaves and carbons and permanently held the carbon and book together and that the various other patents showed bound carbons with the leaves divided into various sections, three, four, or more, according to the desire or whim of the patentee.

His Honor in the Court below, said:

“As to the defense of want of invention by reason of anticipation, it appears that the prior history of the art is made up of a large number of devices theretofore patented wherein it is disclosed that it has been the aim, object and desire of those interested for a great many years, a quarter of a century perhaps, to attain some simple device by which in manifold books of this character the use of carbon paper may be had under conditions which would avoid the necessity of handling it and having it in loose sheets, as it had existed for a great many years, because of its unpleasant nature and the inconvenience.”

His Honor Judge Van Fleet has no doubt been misled as to the true prior art by the vast mass of books presented on rebuttal, the introduction of which was objected to at the time by defendant's counsel.

In reply we would say, that Abraham and Bengough had both discovered the simple device of binding the carbon; that Doughty had a bound carbon

according to Levison's own testimony and the testimony of defendant's expert, Mr. Maynard, p. 105:

"Q. 116. State whether or not the stubs in the Doughty and one side of the carbon sheet and backing are bound together to form a book.

"A. Yes, the carbon in this case is bound with the leaves and backing to form a book."

But the testimony also shows that fixed carbons or bound carbons were not an unmixed blessing nor an ever-existing desire; not only as shown by the Barlow and Perry patents, but by the evidence of Mr. E. F. Crandall and Mr. John Kitchen, Jr.

Mr. Crandall has had many years' experience with the well known house of Cunningham, Curtis & Welch, the largest dealers in and manufacturers of stationary supplies on the Pacific Coast.

Mr. Crandall, p. 78:

"RDQ. 8. Will you state what proportion of your customers ask for fixed carbons with triplicate sheets, and what proportion ask for loose carbons in triplicate sheets."

"Ans. Q. 8. *Probably 1% want the carbons bound in the book.*"

Again on page 66, Mr. Crandall was asked on cross-examination:

"XQ. 27. Do you know whether in the use of these triplicate books and duplicate books parties using the same object to the carbons being loose and not bound in the book?

"A. Oh, some of them prefer it bound, and some loose. We make it both ways.

“XQ. 28. Why do they prefer it bound in a book?

“A. It is a little easier to handle.

“XQ. 29. In what way are they easier to handle?

“A. Well, they don't handle the carbon every time. They turn the leaf over, you know. Of course, in a book like that, where the carbon is bound in, to work on the next leaf you must tear out the first leaf, you understand. Now, in a great many books where the original sheet would stay in the book you can't bind the carbon in because it would interfere with the next carbon copy. It is only once in a great while that we have to bind the carbon in the book.”

Again on page 70, Mr. Crandall was asked on cross-examination:

“XQ. 44. Would you consider it an advantage to have the carbon held in place in these triplicate books rather than to have them loose as they are in some forms of this book?

“A. Well, as I said before, the only advantage would be to keep the man from holding the carbon, to have them exempt from soiling their hands with the carbon. There is no advantage in it. I don't see any advantage in it myself.

“XQ. 45. But of course you realize that a great many people differ with you as to certain advantages?

“A. Oh, yes, certainly. We make books in any way that a man wants without any question as to the whys or wherefores.”

Mr. Kitchen, who has been in the printing business for over 20 years, states that even when he was an

apprentice he bound up thousands of the Barlow books with loose double-faced single carbons, and he was asked on page 159:

“Q. 26. Have you ceased to manufacture those books?”

“Ans. No, we have not. We make those books today; many of the Barlow books today.”

He went on to testify how only recently he had filled an order for Barlow books for the firm of A. Schilling & Co., the well known merchants of this city, and a specimen of this Barlow book, such as actually in use today by A. Schilling & Co., was introduced as defendant's Exhibit 13, p. 160.

Mr. Kitchen further testified:

“Q. 34. Have you any idea how many of those books, the Barlow, you make?”

“A. Well, that would be impossible to tell. We have never kept any data, but hardly a week goes by unless we have some form of triplicate books in, similar to the Barlow.

“Q. 35. State whether or not the books such as exhibit 13, corresponding to the Barlow patent, are now in general use or not.

“A. They are.

“Q. 36. Are they used by more firms than A. Schilling & Co., in this city?”

“A. Oh, my! There are *numerous firms use them*.

“Q. 37. Are there more firms than yours? Are there other firms than yourself making these books today in this city?”

“A. *Yes, every bindery in San Francisco makes them, and every printing office.*”

Verily, it cannot be said that Levison was the first to achieve the “end long sought,” or to have taken “the last step that wins,” for we see from the record that it isn’t everyone that wants *bound* carbons even in a special triplicate book, and that the old loose carbon or Barlow is still in extensive use today and “every bindery in San Francisco makes them and every printing office.”

AGGREGATION.

Aggregation is not invention. “It is a commonly accepted rule of patent law that the inventive idea is not ordinarily present in the conception of a combination which merely brings together two or more functions to be availed of independently of each other. The mechanism which accomplishes such a result and no more is ordinarily styled a mere aggregation.” *Osgood Dredge Co. vs. Metropolitan Dredging Co.*, 75 Fed. 670.

“A combination, to be patentable, must produce a single new and useful result, or an old result in a better and cheaper manner, as the product of the combination; and where the combination produces an aggregate of two or more results, each the complete result of one of the combined elements, it does not constitute a patentable combination.” *Wellman vs. Midland Steel Co.*, 106 Fed. 221.

The law on this subject is well settled and the dividing line between combinations and aggregations is

well established. Every case must fall on one side or the other of that line, and no case can stand upon it.

It was not invention on Levison's part to bind the *Abraham* carbon in the Barlow book. It was mere unpatentable aggregation as distinguished from patentable combination. See *Brinkerhoff vs. Aloe*, 146 U. S. ,15, 516, 13 Sup. Ct. 221, 224 (36 L. Ed. 1068), where it is said:

“To sustain a patent on a combination of old devices it is well settled that a new result must be obtained which is due to the joint and co-operating action of all the old elements. Either this must be accomplished, or a new machine of distinct character and function must be constructed. *Pickering vs. McCullough*, 104 U. S.310, 26 L. Ed. 749; *Hailes vs. Van Wormer*, 20 Wall. 353, 22 L. Ed. 241; *Tack Co. vs. Manufacturing Co.* (C. C.) 3 Fed. 26, 9 Biss. 258; *Wringling Machine Co. vs. Young*, 14 Blatchf. 46, Fed. Cas. No. 9,508. *If several old devices are so put together as to produce even a better machine or instrument than was formerly in use, but each of the old devices does what it had formerly done in the instrument or machine from which it was borrowed and in the old way, without uniting with other old devices to perform any joint function, it seems that the combination is not patentable.*”

Safety Car H. & L. Co. vs. Consolidated Car H. Co., 160 Fed. 476, 490.

Query: What function did the binding means for the carbon in Levison perform different from the function performed by the binding means in Abra-

ham or Bengough? None; for in both cases it simply held the carbon in place with the leaves.

LEVISON'S SO-CALLED INVENTIVE ACT IS A CLEAR INSTANCE OF DOUBLE USE.

As to the obviousness of the use of bound carbon by Levison and its being a mere case of double use, the words of Judge Ray in the recent case of *Fellows vs. Borden Milk Co.*, 180 Fed. 421, 438, are apt:

“It seems to me clear that the new use (so far as there is a new use) of the devices of the prior art—this very industry of making cans—which includes every step and purpose of the Fellows patents, were so nearly analogous to the former uses in the same art, so closely allied, that the applicability of the devices to the new use would necessarily occur to a person of ordinary mechanical skill, and that this is a case of double use. The necessary changes and modifications of the old devices were so simple, so patent and obvious, and the results obtained, especially by the use of centrifugal force for throwing off solder which has been practically abandoned, of so little importance, that they would occur to any mechanic of ordinary skill in this art. In *Brown et al. vs. Piper*, 91 U. S., 37, 23 L. Ed. 200, the Supreme Court of the United States held that:

“ ‘The court can take judicial notice of a thing in the common knowledge and use of the people throughout the country.’ ”

The application of the bound carbon of Abraham's to the specific triplicate book of Barlow is at the ut-

most only a double use, not involving invention. It is rather a case of changing the particular leaves of Abraham's for the particular leaves of Barlow; or conversely changing the loose carbon of Barlow for the bound carbon of Abraham, this change not affecting the method of operation. As was said by the Circuit Court of Appeals of the Second Circuit by Judge Noyes in the recent case of the *Ransome Concrete Machinery Co. vs. United Concrete Machinery Co.*, 177 Fed. 413:

"For these reasons we think the use of the Burns apparatus for the purpose of mixing concrete at the utmost only a double use, not involving invention. It is rather a case of changing the materials to be operated upon than of changing the method of operation. Indeed, it seems about as clear a case of double use as is shown in the well-known illustrations given by the Supreme Court in *Potts vs. Creager*, 155 U. S. 597, 15 Sup. Ct. 194, 198, 39 L. Ed. 275:

" 'If, for example, a person were to take a coffee mill and patent it as a mill for grinding spices, the double use would be too manifest for serious argument. So, too, this Court has denied invention to one who applied the principles of the ice cream freezer to the preservation of fish. *Brown vs. Piper*, 91 U. S. 37 (23 L. Ed. 200.)'

"See, also, *Mast vs. Stover*, 177 U. S. 485, 20 Sup. Ct. 708, 44 L. Ed. 856."

The double use here is adapted the multi-part bound carbon book of Abraham's to the specific use designed by Levison, which *adaptation were involved*

changing the relative size of all the parts of the Abraham leaves so as to make them all equal.

We fail to see in the present case where there is any invention in applying the principle of the bound carbon of the duplicate or manifolding book of Abraham to the *triplicate* book like Barlow, other than the adoption to the mere double use; just as in the Ransome case, it required only mechanical skill. In the Ransome case the Court said in considering the differences between the patent and the prior art:

“We present, then, to a skilled mechanic the problem of increasing the rapidity of the operation of the Burns mixer, so as to mix concrete materials in the face of their tendency to solidify. He knows that old concrete mixers received the materials at one end and discharged at the opposite end. He appreciates the delay caused by adjusting a single chute to both receive and discharge materials. While we recognize the difficulty of drawing a line between mechanical skill and invention, we think that the former should have been sufficient to teach this person skilled in the art to eliminate the double use of the one chute and to duplicate it at the opposite end—to go back to the old method of having separate inlet and outlet.

“Therefore, while we appreciate the usefulness of that which the patentee has accomplished, we are constrained to hold that the difference between the apparatus of the patent in suit and that of the Burns patent do not involve invention, and, consequently, that the former patent is invalid.”

Where the patentee took the combination of an earlier patent, but instead of using the form of link there disclosed substituted another old form of link which had been commonly used for the same or analogous purposes, the character and function of which were well understood in the art, he may have secured better results, but the substitution involved no invention. *North Jersey St. Ry Co. vs. Brill*, 134 F. 580, (3rd Cir.)

The patent in this Brill case came before the Supreme Court in *Brill vs. Washington R. & E. Co.*, 215 U. S.—reported in U. S. Sup. Ct. advanced sheets, p. 177, Oct. term, 1909.

In this case Justice Holmes speaking for the Court said:

“The rule controlling a case like the present is very aptly stated in the recent case of *Warren Webster Co. vs. Dunham Co.*, 181 Fed. 836, (C. C. A.):

“But the application of an old device or combination to a new use is not in itself an invention, or capable of protection by a patent. If the relation between the two uses is remote, and the old device or combination produced a new result by virtue of its new application, that application may constitute invention. Where a machine or a combination is discovered in a remote art, where it is used to perform a different function, and where it was not designed and was not apparently suitable to accomplish the thing desired, the application of it with proper mechanical adaptation to a new use is often the result of the exercise of the inventive faculty and may be protected by pat-

ent. But the thought that an existing machine or combination, discovered in the same art or one nearly analogous to it, designed and suitable to perform a similar function, may be used or adopted to accomplish the desideratum, is not the product of inventive genius, but the result of the application of the skill of the mechanic to the subject under consideration. *It is only when the new use is so recondite and remote from that to which the old device and combination has been applied, or for which it was conceived, that its application would not occur to the mind of the ordinary mechanic skilled in the art, seeking to devise means to perform the desired function, with the old machine or combination before him, that its conception may rise to the dignity of invention.* *Potts vs. Creager*, 155 U. S. 597, 608, 15 Sup. Ct. 194, 39 L. Ed. 275; *Hobbs vs. Beach*, 180 U. S. 383, 390, 21 Sup. Ct. 409, 45 L. Ed. 586; *Adams Electric Ry. Co. vs. Lindell Ry. Co.*, 77 Fed. 432, 447, 23 C. C. A. 223, 237; *National Hollow Brake-Beam Co. vs. Interchangeable Brake-Beam Co.*, 106 Fed. 393, 702, 45 C. C. A. 544, 533.”

On the question of invention the query of the Court in the recent case of *Jacobs Mfg. Co. vs. Almond Mfg. Co.*, 177 Fed. 935, 6 C. C. A., 2nd Circuit, is interesting:

“Is it invention entitling a person to the monopoly of a patent to add teeth and a key with cogs to effect motion to the operating sleeve of a drill-chuck—when such device for imparting motion is well known in many arts, and in this very art had been applied to

move the operating parts of chucks of another type (as in Whiton and Washburn)? We are clearly of the opinion that it is not and do not find the circumstance that the improvement has had large sales persuasive to the contrary. The toothed key is, no doubt, bought because it is more useful and convenient than the fingers or a spanner; but utility alone is not enough to establish invention."

Query: Was it invention for Levison to bind in the Barlow double face, single carbon when *bound* carbons were notoriously old in the art? The answer must be in the negative.

Furthermore the circumstance that Levison's structures may have "had large sales is not persuasive to the contrary."

ANTICIPATION.

Anticipation is so closely allied with lack of invention and patentable novelty in the light of the prior art that the two subjects may in many respects be considered together. We refer to it here principally with respect to the prior art, and the comments of the Court below in considering the prior art and finding that there was no anticipation of the Levison claims here in issue.

Judge Van Fleet says further in his opinion: "It appears from an examination of the prior art that this is not the first time that a device has been invented whereby the carbon paper is *bound* in the book, but it does disclose very clearly to my mind, and without any conflict of a substantial character in the evidence,

that this is the first instance in which a practicable device of this character has been invented; and of course it is well established that a device that is of a practical and successful character cannot be anticipated by one that is not, although it *may include all of the elements that may appear in the successful device.*”

We have failed to find in the Record anything to substantiate the fact that the Levison patent “is the first instance in which a *practicable* device of this character has been invented.”

One thing which is to be remarked upon in regard to the Opinion of the lower Court is the lack of any reference whatsoever to the patent of Barlow, by Judge Van Fleet. It cannot be questioned but what Barlow is a part of the prior art, nor can there be any question as to its being “a practicable device.” That is proven by Exhibit 13, the book of the Schilling Co. and the testimony on behalf of defendant. It is not even denied. Likewise there is nothing but the self-serving statement of the plaintiff’s officer, Harry Levison, and the misleading model *Q*, to prove that the Doughty patent does not represent a practical device. As far as anticipation is concerned, the practicability of the Doughty device is of minor importance if it shows enough so that anyone skilled in the art and using only mechanical skill can translate the bound carbon of Doughty into the bound carbon of Levison.

The commercial success of Doughty has nothing

whatsoever to do with its pertinency in showing anticipation of or lack of invention in Levison.

“The scope of a machine alleged to be an anticipation of a later patented machine is coextensive with the range of adjustment of parts which its construction intelligently provides for.”—*Hillard vs. Remington Typewriter Co.* (C. C. A.) 170 Fed. 73.

As was said in *Universal Winding Co. vs. Willimantic Linen Co.*, 82 Fed. 228, 233, affirmed 92 Fed. 391, speaking of a so-called “paper patent” which was relied on by the defendant as a part of the prior art:

“It is a *paper patent*. If it does not anticipate complainant’s machine, it bears directly, if not decisively, upon the question of infringement. The grant of a patent raises a presumption of operative-ness, and of some utility, and, if prior, even though it be a mere paper patent, it may anticipate, provided it sufficiently discloses the principle of the alleged invention. Such prior patent may be relevant also to show that another device is not an infringement of such alleged invention, but is merely an improvement upon the prior patent, of an application thereof to a new purpose. *Pickering vs. McCullough*, 104 U. S. 319; *Dashiell vs. Grosvenor*, 162 U. S. 432, 16 Sup. Ct. 805. In this case the conclusion reached upon all the evidence is that the defendant’s device is such an improvement or adaptation of the art existing at the date of the invention in suit.”

“That the device of a patent never came into commercial use does not prevent such patent from being

an anticipation of a later one, if it sufficiently embodies the elements and discloses the principle of operation of the latter; or from narrowing its scope; nor is it material that the earlier patentee did not claim the particular device of the later patent as a part of his invention.—*E. L. Watrous Mfg. Co. vs. American Hardware Mfg. Co.* (C. C.) 161 Fed. 362.”

Consequently, we see that his Honor’s conclusion, “that a device that is of a practicable and successful character cannot be anticipated by one that is not, although it may include all of the elements that may appear in the successful device”, is not a true expression of the law.

The only two patents which his Honor in the Court below appears to have considered at all are the Doughty and Bengough patents, but if we read his decision rightly it would seem that he has misunderstood or misinterpreted these two patents. Judge Van Fleet says:

“The history of this art shows that, although there had been at least two previous devices patented wherein the *carbon was bound into the book*, neither one of those was a *practicable* device. That is particularly true of the Doughty patent, where there was a device by which the carbon was bound in the middle of the book and by a cumbersome and complicated arrangement the carbon could be used by folding over the sheets first on one side and then on the other; but that was proven and shown very clearly to my mind to be entirely impracticable and was not a *success and has practically gone out of existence*. The other de-

vice, the Bengough patent, is not to my mind in any sense an anticipation of the present one. It was a very cumbersome arrangement, whereby the carbon was attached to the book by a *wire frame*, was not bound into the book in any proper sense at all; it was merely attached to it, and when the book was opened to be prepared for use, by throwing this framework over it would put this carbon in a position where the recording sheets could be folded upon it, and thereby a manifold register made. An inspection of these two devices, that is the Doughty device and the Bengough device, tends to satisfy me as much perhaps as any other thing in the case that the idea of the complainant in creating his device was not obvious; that it was merely one of those happy thoughts which came to him by some sort of inspiration and brought about success out of what had been previously comparative failure; and this, as heretofore indicated, is always potent evidence of invention."

Now of course, if his Honor admits that in the Doughty patent, as he must admit in the light of all the testimony, and the patent itself, that the carbon is *bound* into the book, then of course it is an end to the matter, and the Levison patent is void. With that view we coincide exactly. The part in his Honor's Opinion where he says of Doughty that "the carbon could be used by folding over the sheets first on one side and then on the other," is not understood, unless he has been misled by the plaintiff's bogus model Q.

Furthermore, there has been no evidence to show that even this form of the Doughty device "to be en-

tirely and practical and was not a success and has practically gone out of existence," save for the haphazard statement of plaintiff's witness, Harry Levison who said that he had never seen any of these devices on the market. We introduced the patent to show a manifold triplicate receipt book with a bound double-faced single carbon, and that is all that the Levison patent is when we consider it with respect to claims 3, 4 and 5. The differences between Levison and Doughty at best, are mere changes in form, proportion and degree, not amounting to invention on the part of Levison.

Smith vs. Nicholls, supra.

From his Honor's description of the Bengough patent it is not possible to recognize any exhibit here in the case.

It is quite apparent that Judge Van Fleet was impressed by the evident commercial success of the Levison book, but laid undue stress on that feature since he made this feature of commercial success the basis of his conclusions going even much further in that respect than the Courts have done in other cases.

"The argument made by counsel for appellants in favor of patentability based on the *utility, public acceptance, or magnitude of sales* of the patented article is appropriate in cases of doubtful invention, and sometimes is sufficient to turn the scale; but as we are unable, in view of the *prior art*, to consider the question of invention doubtful, but, on the contrary, hold that the inventive faculty was not exercised by

Voightmann, the argument avails nothing to applicants. *McClain vs. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. Ed. 800; *Adams vs. Bellaire Stamping Co.*, 141 U. S. 539, 12 Sup. Ct. 66, 35 L. Ed. 849; *Grant vs. Walter*, 148 U. S. 37, L. Ed. 552; *Duer vs. Corbin Cab. Lock Co.*, 149 U. S. 216, 37 L. Ed. 707; *Union Biscuit Co. vs. Peters*, 125 Fed. 601 (C. C. A.); *Mast, Foos & Co. vs. Stover Mfg. Co.*, supra." *Voightmann vs. Weis & Ridge Cornice Co.*, 148 Fed. 854 (C. C. A.).

"In view of the foregoing, the asserted extensive use into which the device has gone and large amounts in royalties that have been paid to complainant cannot be considered as giving the device patentable novelty. *Upon this point, the adjudications uniformly hold that, where there is no invention, the extent of the sales and use of the patented article is immaterial. McClain vs. Ortmyer*, 141 U. S. 419, 12 Sup. Ct. 76, 35 L. Ed. 800; *Adams vs. Bellaire Stamping Co.*, 141 U. S. 539, 12 Sup. Ct. 66, 35 L. Ed. 849; *Peoria Target Co. vs. Cleveland Target Co.* (C. C.) 47 Fed. 725; *Olin vs. Timken*, 155 U. S. 155, 15 Sup. Ct. 49, 39 L. Ed. 100."

Hotel Security Checking Co. vs. Lorraine Co.,
155 Fed. 298-301.

See also

Crompton vs. Knowles, 7 Fed. 199;

Goodyear Tire etc. Co. vs. Rubber Tire Wheel Co., 116 Fed. 363, 377 C. C. A.;

American Sales Book Co. vs. Bullivant, 117
Fed. 255, C. C. A. 9th Cir.;

Boss Mfg. Co. vs. Thomas, C. C. A., (8th Cir.)
182 Fed. 811, 814.

In the last case it was said:

“The complainant urges upon us the extensive use of the husker of the patent as claimed by him, as evidence of the patentability of that husker. In doubtful cases the fact that a patented article has gone into extensive or general use is evidence of its utility; but that is by no means conclusive of its patentability. When there is no invention, the extent of the use is a matter of no importance. *McClain vs. Ortmyer*, 141 U. S. 419—429, 12 Sup. Ct. 76, 35 L. Ed. 800; *Adams vs. Bellaire Stamping Co.*, 141 U. S. 539—542, 12 Sup. Ct. 66, 35 L. Ed. 849; *Duer vs. Corbin Cabinet Lock Co.*, 149 U. S. 216—223, 224, 13 Sup. Ct. 850, 37 L. Ed. 707.”

These same judges in affirming the decision of the lower Court, adopted the opinion of the trial Judge which was in part as follows and bears both on the question, invention and infringement:

“The late Circuit Judge, William K. Townsend, a most profound patent-law jurist, has well stated at page 396 of ‘Two Centuries Growth of American Law’: ‘Accordingly, it is now settled that the production of improvements reasonably certain to have been adopted in the development of a new branch of industry opened up by invention does not entitle the producer to a monopoly. The Patent Office, however,

has generally issued a patent to any one who produced a device not before known, unless it was considered reasonably clear that such device did not involve invention. Therefore, in finding a remedy for the evils above stated, the courts have held invalid a large percentage of litigated patents. This doctrine of the necessity of patentable invention as well as novelty has changed the whole face of patent litigation. The question is no longer, "Is it new?" alone; but "Is it such as would have occurred to a skilled mechanic without the exercise of inventive genius?" The changes in the law on this subject make the history of patent law in the United States.' Although the foregoing is an excerpt from one of a series of lectures by the faculty of the Yale Law School, and not from an authoritative decision by an appellate court, yet it can be stated to be the practice, and likewise the holdings of courts which do speak with authority.

* * * *

"The husking point of complainant's is adjustable and changeable by reason of slots; defendant's by reason of holes. If complainant has valid patents, such patents not being pioneer, but for a mere convenience or improvement, they must be given validity by the most rigid construction only; and the fact the complainant adjusts the heel to its point, as well as the center, by means of slots, while the defendant does the same thing by means of perforations, or holes, does not make a case of infringement, by reason of supposed equivalents. *Ross vs. Dowden* (8th Circuit) 157 Fed. 681, 85 C. C. A. 449.

“There will be a decree for the defendant.”

But as to the so-called *commercial success* of the Levison, both Mr. Crandall and Mr. Kitchen flatly contradict Mr. Levison as to any such degree of popularity claimed for the Levison book. That with his small plant it seemed improbable for him to have such a trade in the first place. Also that such popularity as he may lay claim to is his specializing on this line, advertising and going after the business aggressively. Mr. Crandall, pages 58-60; Mr. Kitchen, pages 173-4. Complainant's business acumen is well illustrated by his charging the City and County of San Francisco *between 50 and 60 per cent more than he would charge an ordinary customer* for the same kind of book, pages 156-7. Aside from the ethics or patriotism of such action, the fact that Mr. Kitchen was able to underbid Mr. Levison on this city job may offer the main cause for this suit.

We believe it is giving too much importance to the Levison alleged invention to give it a niche in the “happy thought class”; nor does the evidence justify the conclusion that he “brought about success out of what had been previously comparative failure.”

What Levison seems to have done was to have had the temerity to go before the Patent Office and was fortunate (or unfortunate) enough to strike a lax or incompetent official, as we will see from the file wrapper; consequently by the negligence of the Patent Office, he was able to secure a patent to what he had no right to and which was public property.

THE FILE WRAPPER.

In every patent case the file wrapper and contents of the patent involved are capable of shedding more or less light on the degree of favor to be accorded the patent, and in all cases the file wrapper is referred to, to discover any material limitations in the claims, and learn if the actions in the Patent Office have been such as to indicate the oversight of some important reference. The file wrapper of the re-issue patent has been introduced in evidence as defendant's Exhibit 8, page 86.

In the original patent there was but one claim which has hereinbefore been set out. The re-issue application when filed contained three claims. These claims are set out below and the amendments which were made to these claims after the re-issue application was filed, are indicated in italics, while the words which are crossed out in these claims show those words to have been erased by amendment.

ORIGINAL CLAIMS.

Claim 1. A manifold book composed of sections, each section comprising in order a double carbon sheet, a plurality of recording sheets, and a card board backing, the record sheets *outside the stubs* being divided into three *substantially equal* separable parts, the carbon sheets extending the width of two of said parts, and the cardboard backing extending the width of one of said parts, said recording sheets and backings having stubs to which they are attached along

lines of perforations, said stubs and the edge of the *one side of each* carbon sheets being all bound together to form a book, substantially as described.

Claim 2. A manifold book comprising in order a double carbon sheet, a plurality of recording sheets, and a card board backing, the record sheets *outside the stubs* being divided into three *substantially equal* separable parts, and the carbon sheet, extending the width of two of said parts, said recording sheets having stubs to which they are attached along lines of perforations, said stubs and *one side* the edges of the carbon sheet and backing being all bound together to form a book, substantially as described.

Claim 3. A manifold book comprising in order a double carbon sheet, and a plurality of recording sheets, the record sheets *outside the stubs* being divided into three *substantially equal* separable parts, and the carbon sheet extending the width of two of said parts, said recording sheets having stubs to which they are attached along lines of perforations, said stubs and *one side* the edges of the carbon sheet being all bound together to form a book, substantially as described.

The first official action on these claims was on April 4, 1902, when the Examiner rejected claims 2 and 3 on the prior art and objected to all the claims; this official letter of rejection being as follows:

REJECTION.

“April 4, 1902.

“This action is in response to applicant’s communication filed.

“All the claims are inaccurate near the end, since the carbons are not bound at their edges, but *one side of each carbon is bound, &c.*

“In claims 2 and 3 the relative sizes of the parts of the sheets are not defined, and so the size of the carbon is also indefinite except that it is smaller than the record sheet. At present these claims do not distinguish sufficiently from Clark, No. 429,366, June 3, 1890, (Book-Binding: Leaves); Bengough, No. 553,503, Jan. 28, 1896, or Abraham, No. 634,438, Oct. 10, 1899, (Book-Binding: Writing Tablets, Manifold-ing), and are therefore rejected.”

Thereupon, the applicant amended his application and by his attorney filed the following letter of amendment of April 12, 1902:

AMENDMENT OF APRIL 12, 1902.

“For reasons connected with the sale of this invention applicant will esteem it a favor if the Examiner will act upon this amendment at the earliest possible moment, giving the same precedence over other cases as set forth in regard to re-issue applications in the second clause of rule 63 of the Rules of Practice.

“I amend this application as follows:

“Page 2, 6th line from the bottom, after ‘sheet’ insert ‘outside the stub 7’; after ‘three’ insert ‘substantially equal’.

“Page 3, lines 4 and 5 for ‘the edges of the’ substitute ‘one side of each’; line 5 change ‘sheets’ to ‘sheet’; at the end of the 4th line from the bottom of the page insert ‘It has been already stated that the

three separable parts of each recording sheet are substantially equal. They are not exactly equal, since it is preferable to provide the innermost part with an unprinted additional space or margin next the stub through which are punched the holes 9 to facilitate the filing of said part. Moreover it is better to leave a small space between the edge of the sheet when folded and the line of perforations 8, as this renders it easier to fold the parts. With this exception the separable parts of each recording sheet are of the same size, and in general will contain identical printed matter thereon.

“Claim 1, line 4, after ‘sheets’ insert ‘outside the stubs’; after ‘three’ insert ‘substantially equal’; line 9, for ‘the edges of the’ substitute ‘one side of each’; line 10, change ‘sheet’ to ‘sheets’.

“Claim 2, line 3, after ‘sheets’ insert ‘outside the stubs’; line 4, after ‘three’ insert ‘substantially equal’; line 7 for ‘the edges’ substitute ‘one side’.

“Claim 3, line 3, after ‘sheets’ insert ‘outside the stubs’; after ‘three’ insert ‘substantially equal’; line 6 for ‘the edges’ substitute ‘one side’.

“Add the following claims:

“4. A manifold book comprising in order a double carbon sheet, and a plurality of recording sheets, each of said sheets outside the stubs being divided into a plurality, not less than ~~two~~ *three* of substantially equal separable parts, and the carbon sheet extending the width of said parts except the outermost, said recording sheets having stubs to which they are attached along lines of perforations, said stubs and

one side of the carbon sheet being all bound together to form a book, substantially as described.

“5. A manifold book comprising in order a double carbon sheet, and a plurality of recording sheets, each recording sheet outside the stub being divided into a plurality not less than ~~two~~ three of separable parts joined along lines of perforations, each part being not greater than the part next it on the side towards the stub, and the carbon sheet extending the width of the whole of said parts except the outermost, said recording sheet having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described.”

By this amendment two new claims were added which were rejected on the prior art, the letter of rejection of May 6, 1902, being as follows:

REJECTION, MAY 6, 1902.

“This case has been reconsidered as amended April 19, 1902. Claims 1, 2 and 3 are now allowable.

“New claims 4 and 5 are so broad as to be met not only by Clark, Bengough or Abrahams, of record, but by many other patents, as Wende, No. 556,484, March 17, 1896; or Cooke, No. 558,637, April 21, 1896, (Book-Binding: Writing Tablets, Manifolded). These claims are rejected.”

The final amendment of May 26, 1902, which put the case in condition for final allowance, was as follows:

AMENDMENT, MAY 26, 1902.

“I amend this application as follows:

“Claims 4 and 5, line 4, change ‘two’ to ‘three’.

“The word ‘two’ in these claims was an error, and it was intended to write ‘three’ therefor.

“The combination of these sheets with the double carbon sheet appears to be patentable and an allowance is respectfully requested.”

There are several remarkable things in connection with this final allowance:

First: *the Examiner never once referred to the Barlow patent nor the Doughty patent.* Naturally to an efficient, conscientious, and diligent Examiner it will seem that those patents would have been the very first patents that he would have referred to;

Second: and this point is not the less remarkable, the mere change of the word “two” to “three” sufficiently differentiated in the opinion of the Examiner, the re-issue claims 4 and 5 from the patents of Bengough and Abraham; and the defining of the parts of the record sheets as being “substantially equal” satisfied him that claims 2 and 3 were novel.

And in the face of such actions as these amounting to gross carelessness by the Patent Office, and such immaterial changes as were made in the claims to confer patentability upon them, the lower Court found that Levison was practically a pioneer in the art, and that his claims were entitled to a broad and liberal construction. Nothing more unjust to defendant could be conceived and counsel knows of no adjudicated case where on such a showing of the record

in the Patent Office, such a conclusion has ever been arrived at.

It is a well recognized principle of patent law that the presumption of the validity of a patent arising from its issuance is weakened by the fact that certain prior patents, claimed to anticipate, were not cited nor considered by the Examiner.

Westinghouse vs. Toledo etc. Co., 172 Fed. 371, C. C. A. 6th Cir.;

Cleveland Foundry Co. vs. Kauffman, 126 Fed. 658;

American Soda Fountain Co. vs Sample, 130 Fed. 145, 64 C. C. A. 497.

In the last case the court said:

“We do not agree with the contention, that the fact that the file wrapper discloses the patent to have been granted as first applied for, without any references, adds any force to the presumption of novelty arising from the grant. On the contrary, *we think the force of that presumption is much diminished, if not destroyed, by the lack of any reference by the Examiner to, or consideration of, the “Clark” patents.* It does not seem likely that an expert examiner would pass them by without notice or consideration, if they had been called to his attention. We fell compelled, therefore, to the conclusion, that the first and fifth claims of the patent in suit are invalid for want of patentable novelty.”

Nothing could show the application of the doctrine of *Smith vs. Nichols*, 21 Wall 112; 22 L. Ed. 566, more forcibly than the extraordinary action of the Examiner in holding that Levinson could patent a sheet which is divisible into “not less than *three* parts” but could not patent one which was divisible into “not less than *two* parts.” In that case the court held:

“A mere carrying forward, or new or more extended application of the original thought, a change only in form, proportions or degree, the substitution of equivalents, doing substantially the same thing in the same way by substantially the same means with better results, is not such invention as will sustain a patent.”

This opinion has been followed repeatedly in numerous subsequent decisions.

The amendments made by Levison's attorney are strikingly in the direction of *mere degree*. The writing in of the words “three” instead of “two” in claims 4 and 5 by the amendment of May 26, 1902, indicate no change in principle nor any new result. Both principle and result and as far as the claims go the mode of operation remained the same. The change was a *mere enumeration* of a number higher than two: a more striking instance of simple change in degree could scarcely be imagined.

So it was with the amendment of April 12, 1902, when Levison's attorneys distinguished claims 2 and 3 from Bengough and Abraham by defining the sheet as divided into three “substantially equal”

parts. Now “substantially equal” relates merely to *relative size* or *proportion*, and consequently those changes whereby the claims were sought to be differentiated from the references, came directly within the inhibition of *Smith vs. Nichols*.

A quite recent expression of this same idea is found in *American Laundry M. Mfg. Co. vs. Troy Laundry M. Co.*, 171 Fed. 870, 877:

“Taken as a whole, I do not doubt that this Wendell mangle or ironing-machine is as good as any, if not the very best on the market. However, this superiority is not the result of mental conception amounting to patentable invention which found birth with Wendell, or any one man. It is an assemblage and union of different elements from various sources and a combining thereof in an ironing-machine, or mangle, to iron various articles in the old way arriving at the same result, and it may be an improved result; but this it not necessarily patentable invention. Not every improvement is invention. If ordinary mechanical skill is adequate to make the selection and union, or combination, and no new idea is involved in the process, there is no patentable invention, however great the improvement. See *Dodge Coal Storage Co. v. N. Y. C. & H. R. R. Co.*, 150 Fed. 738-741, 80 C. C. A. 404; *Dunbar v. Eastern Elevating Co.*, 81 Fed. 201, 26 C. C. A. 330; *Atlantic Works v. Brady*, 107 U. S. 192, 199, 200, 2 Supt. Ct. 225, 27 L. Ed. 438. In this last-cited case Mr. Justice Bradley, giving the opinion of the court, said:

“ ‘The process of development in manufactures creates a constant demand for new appliances, which the skill of ordinary head workmen and engineers is generally adequate to devise, and which, indeed, are the natural and proper outgrowth of such development. Each step forward prepares the way for the next, and each is usually taken by spontaneous trials and attempts in a hundred different places. To grant a single party a monopoly of every slight advance made, except where the exercise of invention, somewhat above ordinary mechanical or engineering skill, is distinctly shown, is unjust in principle, and injurious in its consequences.’ ”

We are not without precedent in the art of manifold books, where simple adaptations of prior devices to the individual taste of a later use has been held not to amount to invention. A leading case on this line is that of *American Sales Book Co. vs. Carter-Crume Co.*, 150 Fed. 333 C. C. A., 2nd Cir., before Justices Lacombe, Townsend and Coxe. In declaring the Beck patent for a “Manifold Sales Book” void, the Court said:

“In these circumstances, we are brought to the argument that these prior constructions do not negative invention because they were not designed to be used for the purpose stated in the patent in suit. In the consideration of this question we are not unmindful of the rule, as stated by this Court in *Wickelman vs. A. B. Dick Co.*, 88 Fed. 264, 266, 31 C. C. A. 530, 532:

“ ‘That novelty is not negated by a prior accidental production of the same thing, when the opera-

tor does not recognize the means by which the accidental result is accomplished, and no knowledge of them, or of the method of its employment, is derived from it by any one. *Pittsburg Reduction Co. vs. Cowles Electric Smelting & Aluminum Co.* (C. C.) 55 Fed. 307; *Chase vs. Fillebrown* (C. C.) 58 Fed. 377; *Topliff vs. Topliff*, 145 U. S. 161, 12 Sup. Ct. 825, 36 L. Ed. 658; *Tilghman vs. Proctor*, 102 U. S. 707, 711, 26 L. Ed. 279.'

"See, also, *Boyd vs. Cherry*, (C. C.) 50 Fed. 279, 283; *Clough vs. Barker*, 106 U. S. 166, 1 Sup. Ct. 188, 27 L. Ed. 134.

"But, in order to apply this doctrine to the case at bar, we must not only treat the Mooney book as an accidental construction, but we must ignore the evidence that it was used in the manner contemplated in the patent in suit, and must, further, disregard Oldfield's testimony that the object of his notched corner was to permit the removal of both sheets without soiling the fingers, and that substantially the method described in the patent in suit was recommended to purchasers in operating such books. But even if we accept all these assumptions, as contended for by complainants, it appears from an inspection of the books themselves that they are so constructed with carbons having notched corners as to enable any user to withdraw the leaves without soiling the fingers by taking hold of the leaf at the point exposed by the notch. And it seems too clear for argument that if users of these books did not actually 'lift the (carbon) sheet in order to withdraw the leaves from beneath it in

manipulating the pad,' it was not because these books were not manifestly designed or intended to be used in that manner, but because for reasons of their own the users preferred another and simpler form of withdrawal. In each case there was disclosed a construction capable of operation according to the method stated in the patent in suit; the manner of use was either a matter of the individual taste of the user, or the result of the exigencies of the particular use to which the book was to be devoted. In such a case the prior construction is in itself a demonstration that it is within the principle of the patent; it is actually adapted to and capable of the use contemplated by the patent—in the Mooney book without alteration, in the Oldfield book either without alteration or by a mere change in the location of the notch in order to secure the identical operation and result accomplished by the patent in suit.

“As these conclusions have been reached upon a discussion of the opinion of the Court below and of the evidence of complainants’ witnesses, it does not seem necessary to consider the evidence of defendants’ witnesses or the arguments based thereon.

“The decree is reversed, and the cause is remanded to the Court below, with instructions to dismiss the bill, with costs.”

The law of this Circuit for a patent of this character is fully and plainly laid down by your Honors in the recent case of *Lewis Construction Co. vs. Semple, et al.*, decided February 7, 1910, reported in

177 Fed. 407, opinion by Judge Gilbert and concurred in by Judges Morrow and Hunt.

In that case the patent sued on was for an improvement in *pipes* for use in carrying sand, gravel and other material from dredgers, hydraulic or other excavating devices, the pipe having a lining composed of blocks of wood arranged in circular series presenting the grain of the wood endwise at the inner surface of the blocks for a wearing surface, such series of blocks being inclosed in a casing of longitudinal wooden strips, the series of blocks being bound with hoops, and the outer casing wound with wire. Of the claims therein alleged to be infringed the following is a sample:

“A pipe having a lining composed of a series of blocks of wood, presenting the grain of the wood endwise at the inner faces of the blocks, and a casing, substantially as set forth.”

The defendant in that case operated under a subsequent patent, and his dredger pipe was made with a wire wound stave casing with the bottom of the interior of the casing having a wearing surface of wood blocks cut across the grain. In that case just as in the present one, the complainant patentee contended for liberal construction of his claim and that, “the patent is not limited to the exact mechanism described but is entitled to the benefit of the doctrine of equivalents.”

Your Honors upon examination of the prior art found in a prior patent to one Jacob Boyers of 1881, a *pump* with a hard wood lining having the end of

the grain presented to the action of the piston and fluid; and also found in a patent to one J. H. Morton, 1883, for a rectangular pipe, "lined on the sides and bottom with blocks of wood which are sawed out across the grain so that when placed in position the wear will come on the end grain."

Your Honors also found by reference to the file wrappers in that case that the Examiners-in-Chief in the Patent Office in allowing the Semple claims *made no reference to the Martin patent or the Boyer patent...* (Note in the present case where the Patent Office made no reference to the Barlow or Doughty patent while Levison's application was pending.)

Your Honors also found, as set forth in the opinion on page 410, that there was a demand for just such a pipe as the Semple invention and that, "Semple was the first to devise a claim for retaining the blocks in place; for that devise he obtained a patent and we hold that the invention was patentable, but in view of the prior art, etc."

The foregoing runs almost like a paraphrase of the facts in the present case. Levison was the first to permanently *bind* a carbon into the *stubs* of a special *triplicate*, three-part leaf book, and his book has been popular; but it is not the only triplicate book on the market by any means. The Examiners in the Patent Office and his Honor in the Court below have "considered the question of anticipation and patentability only as affected by the Doughty and Abrahams patent." (The Patent Office referring to certain other patents for features not involved

in the present case), “but made no reference to the Barlow patent nor the Doughty patent.”

Levison may have been the first to devise a scheme for building up a book in sections comprising stop cards of certain length, with *bound* carbons interspersed at intervals through the triplicating leaves. As your Honors said in the Semple case: “For that device he obtained his original patent with a single claim and that part of his so-called invention may or may not be patentable.”

But respondent-appellant is not sued for infringement of claim No. 1, nor for any infringement of claim No. 2, but it is sued on claims 3, 4 and 5 of the Re-issue. To paraphrase your Honor’s language; “The prior art shows the notorious use of triplicate books in which the three part leaves are interfolded with a carbon two-thirds the length of the leaves in exactly the same manner for exactly the same purpose as in Levison and particularly as such use is shown in the Barlow and Doughty patents.

“We think that the scope of the Levison patent (if valid) must be limited to the use of such books with a carbon bound in the stubs with a particular means for holding the carbon in place and that he cannot be allowed the broad claim of invention on the idea of a triplicate book with any kind of a ‘held or restrained’ carbon whether ‘bound’ or not. It does not follow that because he was the first to bind the carbon in between the stubs of a *triplicate* book he became entitled to a monopoly of the use of any

kind of a carbon and any kind of carbon holding means in a triplicate book. He had before him the Barlow patent in which the same device of triplicate leaves or single, double-face carbon was used for triplicating purposes. He had before him the Doughty patent in which the same device with a *single bound* double-faced carbon and three-part leaves, was used for triplicating purposes; he had before him the Perry patent in which there was a triplicate book with a single, double-face carbon used for triplicating purposes; he had before him the patents to Abraham and Bengough each, with a carbon *bound* into the stubs and the multiple copies obtained by appropriately inter-folding the carbon and sheets.

“It is true that the Barlow patent relates to exactly the same invention that the Levinson patent relates to, to-wit: a triplicate single, double-faced carbon receipt book. It is true also that the Barlow patent shows a loose carbon; but it is also true that the Abraham book while having a *bound* carbon is perhaps only designed for duplicating use; but the two ‘arts,’ (making for a moment the violent assumption that a *duplicate* book is in one ‘art’ and that a *triplicate* book is in a separate art) are not so remote, that the transfer of the *bound* carbon from one ‘art’ to the other, or the substitution of *triplicate* leaves for *duplicate* leaves would involve invention.

“*Stearns Co. vs. Russell*, 85 Fed. 218, 29 C. C. A. 121; *Standard Castor & Wheel Co. vs. Castor Socket*

Co. 113 Fed. 162, 51 C. C. A. 109; *W. F. Burn Co. vs. Mills*, 143 Fed. 325, 74 C. C. A. 525.

“Levison had before him also the patent to Doughty in which a single *bound* double-faced carbon was held contiguous to the stubs, which *required no handling*, and which carbon was two-thirds the length of the triplicating sheet and the leaves interfolded with this carbon in *precisely the same way as in Levison* and *for the same purpose*. There was no invention in binding the Doughty bound carbon into the boook by *staples or sewing* instead of the means employed by Doughty. It was but a change in form; nor can invention be predicated upon the *use* of such a *bound* carbon by means of staples. If the carbon is to be bound in permanently as contemplated by Levison, then perhaps no other form of binding was possible. If he is to use a *bound* carbon, and still have it be some other kind of a bound carbon from Doughty, it must of necessity be *bound* by *staples* or like permanent *securing* means “substantially as described.” In short, his invention (if any) was a mere improvement or adoption of what had gone before and it does not mark a distinct improvement in the development of the art. The novelty of his patent must rest on the means which he adopted to carry his idea into effect—the Levison invention being combined substantially to the precise construction which the invention describes, it is obvious that the Kitchen invention does not infringe in. Instead of using a *bound* carbon appellant uses a *loose* carbon, as stated by the witnesses and as ad-

mitted by his Honor in the Court below. In the Levison device it is evident that the carbon is held in position by staples or wire passed through the stubs and carbon. In the appellant's book the carbon is not bound into the stubs, but is an *unbound* carbon which can be easily removed or inserted into the book just like in Doughty, and the only means for holding the carbon temporarily in working position is by means of the stiff sheet of cardboard to which the Kitchen carbon is attached and which piece of cardboard is shoved into the stubs and retained in clamp fashion. These marked differences of construction are sufficient to avoid infringement."

That the law, as your Honors expressed it in the Semple case above, is the law of the land, is seen by a vast number of decisions including:

McMillan vs. Water Arch Furnace Co. 177 Fed. 401, C. C. A.

Acetylene Burner Case, 215 U. S., Advanced Sheets N. Y. Sup. Ct., No. 3, Jan. 1, 1910, page 47;

Brill Car Truck Case, 215 U. S. Advanced Sheets, Jan. 1, 1910, No. 3, page 177;

Computing Scale Co. vs. Automatic Scale Co. 204 U. S. 609.

Wright vs. Yuengling, 155 U. S. 47; 39 L. Ed. 64;

Milwaukee Co. vs. Brunswick etc. Co., 126 Fed. 171, C. C. A.

THE PATENT IS VOID AS A REISSUE AS BEING A DEPARTURE FROM THE ORIGINAL; AS NOT FOR THE SAME INVENTION; AND AS CONTAINING NEW MATTER NOT AUTHORIZED BY THE STATUTE.

Reissues are permitted under Section 4916 of the U. S. Revised Statutes:

“Whenever any patent is inoperative or invalid, by reason of a *defective or insufficient specification*, or by reason of the patentee claiming as his own invention or discovery *more* than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the *same invention* and in accordance with the corrected specification, to be issued to the patentee, or, in the case of his death or of an assignment of the whole or any undivided part of the original patent, then to his executors, administrators, or assigns, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the amended patent. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a re-issue for each of such re-issued letters patent. The specifications and claim in every case shall be subject to revision and restriction in the same manner as original applications are. Every patent so re-issued, together with the corrected speci-

fication, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but *no new matter shall be introduced into the specification*, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid. ((See prior patent statutes: Section 53, 1870; Sections 5 and 8, 1837; Section 13, 1836; Section 3, 1832.)”

The patent is void as a *re-issue*. This phase of the question was more or less lightly passed over by his Honor in the Court below.

The defense of invalidity through re-issue is not based on the lack of due diligence of the patentee in applying for the re-issue, nor on the principle that the re-issue broadened the claims. The defense is based on the more fundamental grounds that the re-issue application was not for the “same invention” as the original, and that it embraced “new matter;” the existence of either one of which conditions is fatal to the validity of the patent under the Statute.

It has already been pointed out how Levison in his re-issue expanded his specification to include the special feature that his sheets are divided into three “substantially equal” parts, and sets up in his re-

issue that this *equal* divisional idea with a *bound* carbon was his real invention; although in his original patent he had clearly set out the built up *piles* of sections and interspersed carbons and card board backings, and confined himself to such and took his patent on that combination.

By reference to the file wrapper from which we have already quoted at length it will be seen that the “equal division” idea is the invention of Levison’s *solicitor* and not the patentee at all; at least Levison did not show such “equal division” idea in either his original or re-issue application and *he never made oath* to the fact that it was (if it was), his invention.

The *whole basis of the re-issue claims is embodied in new matter added by the amendment of April 12th, 1902, filed a month after the re-issue application was filed.* This amendment was presented by Levison’s solicitor, Mr. Wright, and no oath was filed as required by law to show that this matter was a part of the original invention of Levison. It simply illustrates further the indifference, laxity and gross carelessness of the Patent Office Examiner in handling this case.

The case of *Parker & Whipple Co. vs. Yale Lock Co.* 123 U. S. 87; 31 L. Ed. 100, is a leading case on the questions of “new matter” and “same invention,” in reissue patents and the attention of your Honors is respectfully invited to that case:

Mr. Justice Blatchford in speaking for the Court said in part:

“The first statutory provision for the reissue of patents was made by the 3rd Section of the Act of July 3, 1832, Chap. 162, 4. Stat. at L. 559. It provided for the reissue in certain cases “for the same invention.” This provision of the Act of 1832 was superceded by Sec. 13 of the Act of July 4, 1836, Chap. 357, 5, Stat. at L. 122, which provided “that whenever any patent which has heretofore been granted, or which will hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification, as his own invention, more than he had or shall have, a right to claim as new; if the error has, or shall have, arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the commissioner upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor, for the same invention.

“This provision of the Act of 1836 was in turn superceded by Sec. 53 of the Act of July 8, 1870, chap. 230, 16 Stat. at L. 205, which provided, “that whenever any patent is inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of

such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specifications, to be issued to the patentee.” This provision of the Act of 1870 was enacted in the same language in section 4916 of the Revised Statutes, and was the provision of law in force when the reissue in the present case was granted.

“It is thus seen that in all the statutes on the subject of reissues, the only authority granted to the commissioner is one to issue a new patent “for the same invention.”

“The provision of the Statute of 1836 has been before this Court in numerous cases. In *Burr vs. Duryee*, 68 U. S. 1 Wall. 531, 577 (17:650, 660), at December term, 1863, this court speaking by Mr. Justice Grier, said: “The surrender of valid patents, and the granting of reissued patents thereon, with expanded or equivocal claims, where the original was clearly neither inoperative nor invalid, and whose specification is neither ‘defective or insufficient’ is a great abuse of the privilege granted by the statute, and productive of great injury to the public. This privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more ‘available’ for the suppression of all other inventions.”

He continues after quoting *Seymour vs. Osborne*:

“In what was thus said in *Seymour vs. Osborne* there is no warrant for the view, that *ex vi termini*,

what was suggested or indicated in the original specification, drawings or patent office model is to be considered as a part of the invention intended to have been covered as a part of the original patent, unless the court can see, from a comparison of the two patents, that the invention which the original patent was intended to cover fairly embraced the things thus suggested or indicated in the original specification, drawings, or patent office model, and unless the original specification indicated that those things were embraced in the invention intended to have been secured by the original patent. - - -

“ - - - The case of *McGill vs. Wells*, 89 U.S. 22 Wall. 1 (22:699) at October Term, 1874, arose under the Act of 1836. In that case, this court, speaking by Mr. Justice Clifford, said p. 19 (708): ‘invalid and inoperative patents may be surrendered and reissued for the same invention, but Congress never intended that a patent which was valid and operative should be reissued merely to afford the patentee an opportunity to expand the exclusive privileges which it secures, to enable him to suppress subsequent improvements which do not conflict with the invention described in the surrendered patent. - - -

“In the case of *Giant Powder Co. vs. California Powder Works*, 98 U. S. 126 (25:77) at October Term, 1878, this court, speaking by Mr. Justice Bradley, said p. 137 (81), in reference to the reissued patents in that case: ‘These reissues, being granted in 1872, were subject to the law as it then stood, being the Act of July 8, 1870, the fifty-third section

of which (reproduced in section 4916 of the Revised Statutes) relates to the matter in question. It seems to us impossible to read this section carefully without coming to the conclusion that a reissue can only be granted for the same invention which formed the subject of the original patent of which it is a reissue. - - -

“There is no evidence of any attempt to secure by the original patent the inventions covered by the first eight claims of the reissue, and those inventions must be regarded as having been abandoned or waived, so far as the reissue in question is concerned, subject, however, to the right to have made a new application for a patent to cover them; in other words those eight claims are not for the same invention which was originally patented. - - -

“As the rule is expressed in the recent case of *Mahn vs. Harwood* (supra), a patent ‘cannot be lawfully reissued for the mere purpose of enlarging the claim, unless there has been a clear mistake, inadvertently committed, in the wording of the claim and the application for a reissue is made within a reasonably short period after the original patent was granted.’ But a clear mistake, inadvertently committed in the wording of the claim is necessary, without reference to the length of time. *In the present case, there was no mistake in the wording of the claim of the original patent. The description warranted no other claim. It did not warrant any claim covering bands not short or sectional. The description had to be changed in the reissue, to warrant the*

new claims in the reissue. The description in the reissue is not a more clear and satisfactory statement of what is described in the original patent, but it a description of a different thing, so ingeniously worded as to cover collars with continuous long bands and which have no short or sectional bands.” (See also *Ives vs. Sargent*, 119 U. S. 652, 662, 663 (3-:554, 548).

So, with Levison’s original patent “*there was no mistake in the wording of the original patent. The description warranted no other claim. The description had to be changed in the reissue, to warrant the new claims in the reissue.* The description in the reissue is not a more clear and satisfactory statement of what is described in the original patent, but is a description of a different thing, so ingeniously worded as to cover a single sheet divided into three *substantially equal* part with a bound carbon.”

As well stated by Judge Coxe in *Carpenter Straw Sewing Machine Co. vs. Searle*, 52 Fed. 809, 814, and approved by the Court of Appeals in 60 Fed. 82, 8 C. C. A. 476, viz:

“ ‘That unless the Court can find that the invention of the re-issue is described as the invention in the original, and that the patentee intended to secure it as his invention in the original, the re-issue is invalid. It is not for the same invention.’ ”

Marvel Buckle Co. vs. Alma Mfg. Co., 180 Fed. 1002.

“If the fact be that much they have done is open to criticism in a forum of morals, this case in that,

as in other respects, much resembles *Parker & Whipple Co. vs. Yale Clock Co.*, 123 U. S. 87, 8 Sup. Ct. 38, 31 L. Ed. 100. There, as here, the drawings of the original patent showed the feature upon which were based the new claims first appearing in the re-issued patent. There the infringer was the very corporation which had been employed by the owner of the original patent to manufacture the patented clocks. No alleged infringer could well have put itself in a position less likely to appeal to the sympathies of the court. It was, however, held:

“ ‘That what was suggested or indicated in the original specifications, drawing, or Patent Office model is not to be considered as a part of the invention intended to have been covered by the original patent unless it can be seen from a comparison of the two patents that the invention which the original patent was intended to cover embraced the things thus suggested or indicated in the original specifications, drawings, or Patent Office model, and unless the original specifications indicated that those things were embraced in the invention intended to have been secured by the original patent.’ ”

“That case is decisive of this. The subsequent case of *Topliff vs. Topliff*, 145 U. S. 170, 12 Sup. Ct. 825, 36 L. Ed. 658, quite as distinctly declares that a re-issue must be for the same invention as the original patent, as such invention appears from the specifications and claims of such original.

“In this case each of the three claims in suit contain an element which from the specifications and

claims of the original patent cannot be said to have formed a part of the invention there described and claimed.”

Under the doctrine of the recent case of *Gen'l Electric Co. vs. Richmond Street & I. Ry. Co.*, 178 Fed. 84-88, C. C. A. 7th Cir., the Levison patent is void as a re-issue because neither the two conditions precedent existed whereby the Commissioner of Patents was authorized to grant the reissue. As there said, after quoting Sec. 4916 U. S. Revised Statutes:

“Either the original specification must be defective or insufficient, or the original claims must embrace more than the patentee had a right to claim as new. But neither condition is available unless the error arose from inadvertence, accident, or mistake, and without any fraudulent or deceptive intention.

“Findings by the Commissioner that a legal condition exists and is available are conclusive in so far as they depend upon credibility and weight of evidence; but, in so far as they depend upon the legal interpretation and effect of admittedly genuine documents or other undisputed evidence, they are reviewable in court.”

As was said by the Court in that case:

“The original does not suggest that any other action would be possible than that the arc would first be driven against the back wall. That such would be the action was a fact known to those skilled in the art prior to the time of the original application. So we find that the original specifications

neither contained erroneous statements of fact nor failed to give a description in such full and clear terms as would enable any person skilled in the art to construct and use the device.”

Like in that case Levison by his' reissue (and through his attorney subsequent to the filing of the reissue application and without filing a supplemental oath) revamped his specifications so as to bring out the idea that his real invention was not the building up in successive series in one book of interspersed stop-cards, leaves and carbons after the manner of his original claim one, but the use of “leaves divided into *three substantially equal* parts on lines of perforations with a carbon to extend over two sections,” entirely omitting the upbuilding of the book in sections with a separate carbon and a separate stop card for each section.

The “new matter” which Levison's solicitor added bodily by amendment and which does not appear in the original, is the following paragraph, lines 84-98:

“It has been carefully stated that the three separable parts of each recording sheet are substantially equal. They are not exactly equal, since it is preferable to provide the innermost part with an unprinted additional space or margin next the stub through which are punched the holes 9 to facilitate the filing of said part. Moreover, it is better to leave a small space between the edge of the sheet when folded and the line of perforations 8, as this renders it easier to fold the parts. With this exception the separable

parts of each recording-sheet are of the same size and in general will contain identical printed matter thereon.”

Certain other changes were made in the specifications at the same time by the solicitor. Notably the insertion of the words “substantially equal,” in lines 41-43, column 1 of the patent.

In the lexicography of the original specification (and also in the re-issue as signed by the applicant and *filed*) there is nothing to define that the proportional divisions of the record sheets should be *equal*.

A *supplemental oath* is essential to support any such amendments as were put in by Levison’s solicitor. See *American Lava Co. vs. Steward*, 155 Fed. 737, where the Court said:

“The changes made in the application were manifestly to develop the newly conceived theory of the mode of operation and to add claims for the process. If this was to be accomplished and the theory were to be embodied in practical means, the specifications should have been made to distinctly point out such means, as we have already pointed out. But in that regard the former specifications were retained. If the application as amended were to be construed as embodying such an invention as is now claimed, it was another and different invention from that for which the patent was originally sought, and, *if an amendment having that consequence was permissible it should have been verified by the oath of the inventor. Railway Co. vs. Sayles*, 97 U. S. 554, 24 L. Ed. 1053; *Eagleton Mfg. vs. West, etc. Mfg. Co.*,

111 U. S. 490, 4 Sup. Ct. 593, 28 L. Ed. 493; *Kennedy vs. Hazelton*, 128 U. S. 667, 9 Sup. Ct. 202, 32; L. Ed. 576; *Michigan Central R. Co. vs. Consolidated Car Heat Co.*, 67 Fed. 121, 31 U. S. App. Ct. 462, 14 C. C. A. 332; *Cleveland Foundry Co. vs. Detroit Vapor Stove Co.*, 131 Fed. 853, 68, C. C. A. 233, the last two cases being decided by this Court. The case of *Eagleton Mfg. Co. vs. West, etc. Mfg. Co.*, supra, was strikingly like the case at bar in all the material facts which were made the basis of decision. Eagleton, the patentee, died soon after making his application. It was prosecuted by his administrators by their attorneys. The amendment was made by them, *but was not sworn to.*”

The latest expression of the Supreme Court condemning the practice of solicitors boldly taking to themselves the right to change and add to specifications at will without the formality of a new or supplemental oath by the inventor is found in the *Acetylene Burner Case*, report in *Advanced Sheets* of the U. S. Sup. Ct. No. 3, Jan. 1, 1910, 215 U. S., opinion of Mr. Justice Holmes:

“It appears to us plain that Dolan’s attorney introduced not merely the theory, but the mode of applying it, for the first time, in the amended specifications; or, in other words, then for the first time pointed to an invention, the essence of which was to have so short a chamber or cylinder as to prevent the mixing of the air taken into it, and to emit the current of gas surrounded by the greater part of such air as an envelop or film. Of course, Dolan desired to

produce the result which the patented article is said to produce, but, beyond that desire, his specification did not give a hint of the means by which it now is said to be achieved. It spoke, it is true, as we have said, of producing a hollow-shaped funnel flame by reason of the gas being forced through contracted openings at very great pressure. But this did not disclose the invention, and was dropped in the amendment. He made no claim for a process and disclosed no invention of a device. *This being so, the amendment required an oath that Dolan might have found it difficult to take, and for want of it the patent is void.* Rev. Stat. Sec. 4892, U. S. Comp. Stat. 1901, p. 3384; *Chicago & N. W. R. Co. vs. Sayles*, 97 U. S. 554, 24 L. ed. 1053; *Eagleton Mfg. Co. vs. West B. & C. Mfg. Co.*, 111 U. S. 490, 28 L. Ed. 493, 4 Sup. Ct. Rep. 593; *Kennedy vs. Hazelton*, 128 U. S. 667, 32 L. ed. 576, 9 Sup. Ct. Rep. 202; *De La Vergne Refrigerating Mach. Co. vs. Featherstone*, 147 U. S. 209, 229, 37 L. ed. 138, 145, 13 Sup. Ct. Rep. 283.” (The italics are ours.)

This phase of the case may well conclude with the following extract from the recent case of *Morse Chain Co. vs. Link Belt Co.*, 182 Fed. 825:

“Morse’s papers upon reissue on their face show ground enough for the commissioner to hold that he had originally conceived his invention in broader terms than merely as a two-part pintle. The issue before the commissioner was what was, in fact, Morse’s actual intention when the papers were drawn, and upon the record there was some evidence

that his intention included a three-part pintle. Upon that issue the commissioner's decision became final and conclusive, and it is not now open to review by me. *Seymour vs. Osborne*, 11 Wall. 516, 20 L. Ed. 33; *Russell vs. Dodge*, 93 U. S. 460, 23 L. Ed. 973; *Topliff vs. Topliff*, 145 U. S. 156, 12 Sup. Ct. 825, 36 L. Ed. 658. Therefore I shall assume that Morse's first patent failed to set forth adequately the original invention as he conceived it, and that this mistake arose from such inadvertence, accident, or mistake in reducing his intention to writing as a court of equity will relieve. *Miller vs. Brass Co.*, 104 U. S. 350, 26 L. Ed. 783. This would be enough to justify the re-issue, provided that the invention actually described in the original patent was the same as that described in the reissue, but not otherwise. *Corbin Cabinet Lock Co. vs. Eagle Lock Co.*, 150 U. S. 38, 14 Sup. Ct. 28, 37 L. Ed. 989; *Durham vs. Denison Mfg. Co.*, 154 U. S. 103, 14 Sup. Ct. 986, 38 L. Ed. 924. The suit in the Seventh Circuit conclusively determined that the original patent did not describe an invention which included the defendant's structure. If, in fact, it did adequately describe some invention, there seems no escape from the conclusion that the invention which it did describe was not the same as the invention which Morse had in mind. No one can seriously urge that the original patent did not in fact completely describe a two-part pintle. That was the invention shown in the original patent, and that, it has been held, was not the invention which the defendant is using.

“The only possible question, therefore, is whether there is enough indication in the patent itself to show that Morse was trying, though unsuccessfully, to express the idea of a pintle of more than two parts. If so, then the invention thus partially and imperfectly described became fully described in the reissue and there was no departure. However, unless that idea is to be found somewhere in the original patent, I cannot say that the reissue, which is clearly broader, is for the same invention as the original. Now, the fact is that the original patent was singularly express in its limitation to pintles of two parts. At the very outset the patentee so characterizes his invention, when he says:

“ ‘This invention relates to an improvement in driving chains for general power transmission and particularly to chains of this class, wherein the pintle consists of two parts bearing upon one another throughout their length.’

“There is throughout the specification no indefiniteness of expression, but the pintle is referred to uniformly as a two-part pintle just as it is shown in the drawing. * * * It is true that, when the original claims are too broad, a reissue is good which narrows them. *Edison vs. Mutoscope Co.*, 151 Fed. 767, 81 C. C. A. 391. Strictly and literally speaking, that, of course also changes the invention so that it is not ‘the same,’ but there is a great practical difference between that and the precise inverse which was the effort here, because the narrowing of claims does not result in including any structures or processes

which the original claims left open. That result is the reason for the greater jealousy with which the law has always looked at broadened claims, even though there be no ground in logic for the distinction. If the claims may be broadened without any suggestion of it in the original, the only limit to the expansion which the claims may take is that they must not include elements not originally disclosed. By omitting as many of the disclosed elements as the inventor pleases, he may extend the scope of his patent, solely at the discretion of the commissioner, which certainly the statute never intended. I have found no cases in which the basis of such broadened claims was not found in the original patent itself, showing at least in some inadequate and fragmentary way that the invention there disclosed was that claimed in the reissue. *I do not believe that it is enough that the original be related to the reissue as species to genus, whatever may be law for the inverse relation.* Since here, as I have shown, the original had not the faintest suggestion of anything but a two-part pintle, I am very sorry to feel obliged to find the reissue void."

Moreover if Levison claims that the book covered by claims 3, 4, and 5 is not the book of original claim 1, then he is attempting to claim two *genera* in one patent, one of which was wholly absent from his original case and therefore his patent must fall. On the other hand he can not contend successfully that claims 3, 4, 5, are for a *species*, the *genus* of which is represented by the original claim one, because that would be manifestly untrue. This distinction of *genus* and *species*

shows more clearly than anything else the fatal departure in the reissue from the original patent.

INFRINGEMENT.

The present case presents none of the usual earmarks of wanton and deliberate infringement. Defendant sought the advice of his patent counsel before manufacturing his book or applying for a patent on it. He took more than the usual precautions to determine if his book was any infringement, not only on Levison but on any other patent before he began its use. As Judge Platt recently said in a somewhat similar case, one involving a patent on an account book and ledger:

Time-Saver Co. vs. Stamford Trust Co.;

Same vs. Pequonnock Nat. Bank, 165 Fed. 348;

The Court said:

“If the right of the patentee were as clear as counsel for the complainant claims them to be, if the defeat of the patent were a matter of serious doubt, it would have been better for the real defendants to pay tribute to the owner of the patent. In the case at bar, however, they have apparently undertaken to maintain what they conceived to be their manifest right. I cannot believe that they are wanton and malignant trespassers. To my mind, the gist of the case lies in the fact that the Patent Office ought not to have granted Rand his patent, in view of the disclosure contained in the Wever & Parmerter specifications. That grant loses its *prima facie* force, because, upon

careful scrutiny, the oversight on the part of the examiner who had the matter in charge is so obvious. I am of the positive opinion that the disclosure anticipates fully the principle which, it is insistently claimed, furnishes the novelty to Rand's claims of invention, and I cannot blame intelligent gentlemen for taking advantage of so plain a situation. * * * *

"These observations have been made with a running pen, and much more might be said, but the conclusion of the whole matter is that when Rand went to the Patent Office with his application, he took nothing there which was new, and but for the carelessness of a minor official, he would have come away empty-handed."

In affirming this case the upper Court said, *Time-Saver vs. Stamford Trust Co.*, 176 Fed. 358:

"It is unquestionable that account books with creased leaves were old. It is also certain that account columns with appropriate headings—and even marginal balance columns—had been used or described before the time of this patent. Indeed all the complainant contends for as novel is the combination with the other elements of the vertical crease in the middle of the pages."

Every device which is used to produce the same effect is not the equivalent for another:

Burr vs. Duryee, 68 U. S. 531; 17 L. Ed. 750.

For illustrations of equivalents and non-equivalents, see 107 Fed. 498.

"An infringer is not an outlaw. If convinced that the patent is invalid or that he is not infringing he

can go on and use the machine said to be covered by the claims subject to the risk of an injunction and an accounting", *Diamond Stone Saving Co. vs. Brown*, 166 Fed. 306, C. C. A.

As was said in the recent case of *General Electric Co. vs. Allis Chalmers* by Judge Lanning, speaking for the Circuit Court of Appeals for the 3rd Circuit, 178 Fed. 273, 275:

"While the complainant's patent is not limited to the particular device shown in its drawings, but purports to cover also 'other modifications or equivalent means for carrying out' the inventor's idea, the differences of construction and operation above mentioned are fundamental. The general language of the fourth element of the claim sued on, when read with the specification of the patent, as it must be, cannot be so broadly construed as to cover the defendant's device. *The mere fact that the defendant's device may be within the letter of the claim sued on is not conclusive proof of infringement.* This is shown in the opinion of Judge Cross in the Court below (171 Fed. 666). We concur in the conclusion expressed by him in that opinion."

Where the margin of invention is very narrow, the doctrine of equivalents cannot be invoked to make out infringement. *Doze vs. Smith*, 69 Fed. 1002; 16 C. C. A. 581.

That in case of a narrow improvement an attempt to invoke the doctrine of equivalents to make out infringement may result in defeating the claim of the

patent. *Hobbs vs. Gooding*, 111 Fed. 403; 49 C. C. A. 414.

We maintain that even if Levison's patent is valid, it must be so narrowly construed that under no view of the case can the defendant be held to the charge of infringement. The crux of this conclusion is the word "bound" as used in the claims and specifications of the Levison patent, and its meaning in the book-binding art.

In one case Levison says that the bound carbon is one that is "held or restrained" by any means whatsoever; and in another case he admits that Doughty is a bound carbon. P. 251-254.

Levison cannot claim that the term a "bound carbon" in his claims is the equivalent of a loose or "unbound" carbon, as otherwise the claim is immediately met by Barlow. Then again, if he wishes to take the middle course and claim any sort of a held or restrained carbon he is surely met in Doughty. Therefore, we see that he is absolutely committed to the proposition of a bound carbon, as the same is defined by all the defendant's witnesses, and as it is recognized in the book binding art.

And yet in order that Doughty may not anticipate absolutely the claim of Levison, plaintiff's attorney ingeniously argues that although Doughty is in truth a double-faced single carbon combined with a three-part record sheet and so "restrained" that it cannot fall out of the book, and that the defendant uses a single double-faced carbon and a three-part record sheet and that defendant's carbon is also "re-

strained” so it cannot fall out of the book, yet there can be infringement by defendant, but not anticipation by Doughty. For sooth, the plaintiff would blow both hot and cold. However, since words are used advisedly in a claim, and due importance must be given to their real meaning, the evidence and the dictionary leave no question as to what is meant by the word “bound” in the book binding art.

Turning to the testimony it is found that Mr. Crandall, a man of 20 years experience in the book binding art and having no interest in this suit one way or the other, and to whose testimony we have referred before, says in answer to Q. 28, p. 61:

“A bound book I should say that the sheets in the book must be bound *through*.”

Again on page 62, he identifies the defendant’s book, complainant’s Exhibit A, as a “loose leaf carbon book.”

“I would not call that carbon bound in the book. It looks to me as a loose leaf carbon, simply a separate piece of carbon.”

Q. 30 he was asked:

“In a contract to supply manifolding books, if that contract called for a bound book with carbon bound in, what would you from your experience in your line of business understand by that?”

“I would consider the carbon to be sewed in with the other sheets, the same as the other sheets are.”

Again on page 64 he distinguishes between “binding” and mere “holding”, as follows in referring to the defendant’s carbon:

“Well no, not bound in, not stitched in. It is simply held underneath there. The pressure of the book holds it in place.”

Again page 77:

“RDQ. 4. Is that distinction in bound and loose carbons recognized in the trade?”

“Ans. It is.”

Mr. Maynard, the defendant's expert in answer to XQ. 39, page 135:

“What is your definition of the word, ‘bound’?”

“Ans. The word ‘bound’ in my mind means that the things bound as so held together that they could not be separated from one another without *severing* the binding means.”

Mr. Maynard also points out, page 150, and also in answer to XQ. 106, page 147, that the general state of the art shows that there are two classes of books “the bound book and the loose carbon book”; Barlow, Perry and the defendant being in the class of “loose” carbon books; and Abraham, Bengough and Doughty in the class of “bound” carbon manifold books.

Mr. Kitchen, a practical printer and book binder, defines a “bound” carbon, as follows, pages 163-4:

“A. A bound carbon is a carbon *wired* or *sewed* into the book whereby it cannot be removed without being torn out or destroying the elements of the binding.

“Q. 62. Are there any distinctions made in the bookbinding business between bound carbons and loose carbons?”

“A. In the bookbinding art there are two kinds of books, known as a bound book and a loose leaf book.

“Q. 63. What class does your exhibit ‘A’, belong to? A. The loose leaf.”

This idea of “binding” being synonymous with “sewing”, “stitching” and “permanent holding means which must be severed” in order to liberate the parts, is sustained by the lexicographers.

Webster’s International Dictionary defines the verb to “bind” in the printing art:

Bind: “To *sew* or fasten together, and inclose in a cover; as to *bind* a book.”

Binding: “The cover of a book, or the cover with the *sewing*, etc.”

The Century Dictionary and Encyclopedia has the following pertinent definitions:

Binding: “The cover of a book with the *sewing* and accompanying work.”

Book binding: “The process of *sewing* the sheets of a book within a *permanent* casing of book binders board and leather or cloth, or other suitable materials, covering the sides and back, and joint at their juncture.”

“One of the definitions given by Worcester of ‘book’ is ‘a collection of paper leaves *sewed* or *bound*, used for any kind of writing.’”

Tuberville vs. State, 56 Miss. 93, 798.

“A ‘book’ in its popular sense is understood to be a volume, *bound* or *unbound*, written or printed”; *Scoville vs. Toland*, 21 Fed. Cas. 863, 864.

So we see that a clear distinction is made between *bound* and *unbound* volumes.

A “bound” volume is generally spoken of and recognized in all the authorities as a *sewed* volume. Showing a clear distinction between *bound* or *sewed* or *fastened* sheets, and sheets which are *unbound* or *loose*.

The stitching or wiring of Levison is passed through his stubs and *through* his carbon. His carbon cannot be removed without tearing it off and physically dismembering it from the rest of his book. That is what he means by *binding*, or by a *bound* carbon. Such is not the case with Kitchen.

With this distinction between bound and unbound or loose carbons, it seems absolutely conclusive that the defendant under any view of the case, does not infringe.

As to the self-serving “held, restrained” definition of “bound” in the book binding art invented by Levison we might well cite the parallel Thermos Bottle case decided by the Circuit Court of appeals, 2nd Circuit, reported in 178 Fed. 552, where Judge Lacombe said in considering a claim embodying the phrase, “held permanently in position by friction only”:

“The Circuit Court found that in defendant’s structure the supporting blocks are cemented to the outer vertical wall of the inner vessel. The record supports that finding. The blocks are cemented to the outside of the inner vessel, which is thereafter inserted in place, and the adhesion resulting from

this method of applying either alone holds them in place or substantially contributes so to hold them. The theory was advanced in the Court below that when a label is cemented to the outside of a glass bottle it remains in position solely by friction. The expert who so testified admitted on cross-examination that:

“ ‘If the force applied tending to remove the (label) is one parallel to the surface of the bottle (as it would be when the bottle is standing upright), that force will be opposed by friction only. If the force applied tends to remove the label perpendicularly from the bottle (as it would if the bottle were held horizontally with the label down), friction will play no part.’ ”

“Of this the Circuit Court said:

“ ‘This theory may be scientifically correct; but it involves too strained an interpretation of the words ‘frictional contact’ to be adopted in construing the claims. In language in common use, an article cemented to a wall is held in place by the cement, and not by friction.’ ”

“Appellant’s counsel devotes several pages to a criticism of this statement contending that the only ‘language in common use’ which is to be referred to in construing patents is the language in use among persons skilled in the art, and, if the art involves the application of principles of science, the language in use among physicists, ‘should’ he says, ‘the misunderstanding of the man in the street be substituted for the understanding of the person skilled in the art?’ ”

The facts of physical science, even the simplest, may seem 'strained' to people unaccustomed to them.' And he contends that therefore the phrase 'supported wholly by frictional contact' should be construed as his expert defines it. The difficulty with this argument is that we do not know that this definition is part of the language in use among persons skilled in the art and physicists. A physicist from a distinguished university says that it is; but another physicist from another distinguished university says that it is not—that in the case of the bottle and the label it would be 'misleading to describe the effect of cement as increasing friction and as acting by virtue of friction.' When this is all the enlightenment afforded as to the language in common use among 'physicists' and 'persons skilled in the art,' there seems nothing left for a court to do but exercise common sense, even though it be of the commonest kind. So far as anything in this record discloses, we should suppose that a skilled maker of bottles of this sort, who wished to conform his product strictly to the device of the patent, and would be very careful to avoid the use of cement between the blocks and either wall, lest thereby he might produce an adhesion between the two which operate to retain the blocks in place not wholly by frictional contact."

Only the "commonest kind of common sense" is necessary to see that the respondent's carbon is not "bound:" Kitchen's case of "frictional retention" of his carbon is similar to that of the patentee in the Thermos Bottle suit, whilst Levison's "bound" car-

bon is analogous to the *cement* bottle of the defendant in the Thermos Bottle case. In each case the conclusion must be the same.

As to the way words are to be interpreted when used in a claim see *American Steel & Wire Co. vs. Denning Wire & F. Co.*, 176 Fed. 564;

“In *Fay vs. Cordesman*, 109 U. S. 408-420, 3 Sup. Ct. 236, 244 (27 L. Ed. 979), it is said:

“ ‘The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination, and the court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and he be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality.’

“But it is urged with apparent sincerity, and some of complainant’s experts say, that the hoppers are the mechanical equivalent of the mechanism of the Bates patent ‘for cutting off suitable lengths of stay wires to span the space between the strand wires.’ The word ‘cut’ is doubtless used in different senses, but its meaning in a given association with other words must be determined from its connection and

association with such other words. A common, and perhaps its most usual, significance is: 'To make an incision with a sharp instrument; to cut or sever by the application of a sharp knife or edged instrument of some kind.' Century Dictionary. To interpret it as it is used in the Bates patent, as synonymous with *separate*, *divide*, *set apart*, or *segregate* would obviously not be the sense in which it is used in that patent. The specifications and drawings of the patent, as well as a model of the machine prepared by the complainant, show beyond any doubt that the stay wire sections are to be cut from spools of continuous stay wire by knives or cutter blades passing each other in close relation, substantially as the blades of shears pass each other, and the word 'cut,' as used in the patent, is undoubtedly intended to convey that meaning. The conclusion is therefore unavoidable that the cutting mechanism of the Bates machine is wholly omitted from defendant's machine No. 5, and that it contains no substitute therefor which is its mechanical equivalent."

His Honor, Judge Van Fleet, in pointing out what he considered would be an equivalent to *binding* by staples, said:

"Of course the claim uses the term 'bound in,' but the patentee does not undertake to confine himself to the manner in which it shall be bound; it simply provides for the binding of the carbon in the book. Supposing that defendant had had his carbons arranged with this *patent paste* or *mucilage* attachment such as we often see, where you can dampen

or wet it with a sponge and attach it to anything; you could take any book in the world that I have ever seen and if that carbon was so arranged you could lift those leaves and stick or paste it at the inner edge and it would be as perfectly bound in that book as any leaf of the book. The fact is you often see such insertions of illustrations in books; they are not bound or sewed in with the leaves of the book, but they are inserted through the book in their proper places by the use of paste or mucilage or other adhesive material, and they are bound in the book just as effectually as though they were sewed in; and so here it seems to me that it is the purest evasion and attempt to get around the device of the complainant by adopting a means of securing *precisely the same end* by what to my mind must be held as in all material respects an equivalent method; and that cannot be allowed.” (The italics are ours.)

But the thing is the defendant does not use “paste” or “mucilage,” for if he did he would have means which would have to be “severed,” as said by Mr. Maynard, or rendered asunder, which is the very essence of “binding.” His Honor by attempting to find a substitute for “bound in,” as described by Levison, strongly illustrates our point.

Also apparently his Honor considered only the *result* and not the *means* for attaining the result. In finding equivalency and infringement there must be “substantial identity of means,” *Walker*, Sec. 158. There are two

factors in equivalency and Judge Van Fleet considered but one necessary.

Even though it is assumed that the stubs of Kitchen frictionally engage the carbon to hold it temporarily in place, and thereby performs the same function of the stitching or *binding* of Levison, nevertheless the function is not performed in the *same way*. As was said recently by the Circuit Court of Appeals for the 8th Circuit in *Johnson Furnace Co. vs. Western Furnace Co.*, 178 Fed. 819, 825, discussing a bill:

“Complainant’s and defendants’ grates each perform the same functions. While it is necessary to constitute infringement that each should perform the same function, performance of the same function does not alone constitute infringement. *Eames vs. Godfrey*, 1 Wall. 78, 17 L. Ed. 547; *Burr vs. Duryee*, 1 Wall. 531-573, 17 L. Ed. 650; *Westinghouse vs. Boyden Power Brake Co.*, supra, 170 U. S. 568-569, 18 Sup. Ct. 707, 42 L. Ed. 1136.”

To constitute infringement, defendants’ binding means must be the mechanical equivalent of complainant’s; in other words, “it must perform the same function in substantially the same way.” *Walker on Patents*, section 358.

His Honor, Judge Van Fleet, in according Levison a broad application of the doctrine of equivalents appears to have been guided to that conclusion by the mere fact that the defendant produced the same result as complainant, and to have left out of consideration the second factor in the definition of a mechani-

cal equivalent, that is, “the substantial identity of means.”

Here in the present case, the *result* of the binding by Levison is not the production of three carbon copies at once writing; it is merely the retention of the carbon in the book. The *result* in Levison is the permanent retention of the carbon in the book in such manner that it cannot be removed therefrom without partial destruction of the book: That is, the physical tearing out of the carbon so that it cannot be re-placed. In Kitchen that *result* is only imperfectly attained. Hence we have not such identity of result even as required by law.

One thing may accordingly be an equivalent of another, *though it does more than that other*, but it cannot be such an equivalent if it does less. (*Id.*; *Bliss vs. Haight*, 3 *Fisher*, 626; *Engle & C. Co. vs. City of Elwood*, 73 F. R. 486.)

As to the second factor, to-wit: The manner of achieving that result, is entirely different in the two cases.

The result is not achieved in “substantially the same way” by the two patentees, for it is to be born in mind that the defendant is operating under a patent on his carbon holding means. In Levison the result is achieved by *stitching* or *permanent non-severable* means passed through the stubs and carbons. In other words, the result is effected by *binding*; whilst on the other hand in Kitchen the *imperfect result of Levison* is only *partially achieved* by an *entirely different mode of operation*. That is, by the

temporary insertion of the cardboard strip 9 of the patent in between the stubs. So basing the question of infringement on the definition of what constitutes a mechanical equivalent in patent law, the defendant cannot be held liable.

The use by defendant of an “unbound” carbon, and the limitation of the Levison claims to a “bound” carbon, is analogous to the *omission of an element* from the patented combination.

Defendant’s book differs as much from Levison as though he had entirely omitted a physical element of the Levison claim, which indeed, in effect and contemplation of law he has done. As was said by Judge Severens speaking for the Circuit Court of Appeals in *Duner C. vs. Grand Rapids R. Co.*, 171 Fed. 863, 5:

“The patentee nowhere suggests that the partition, 29, between the main and side pockets, shall or may extend all the way between the pockets. He expressly says it shall not, but that an opening shall be left through which the sand may pass through from one to the other. We have therefore no right to assume an entire partition. That a claim which is construed by bringing into it, by reference to the specifications, a feature there found, must be regarded as equivalent to a claim having in itself such feature seems to be a logical deduction, and is in accord with the observation of Mr. Justice Blatchford in *Fay vs. Cordesman*, 109 U. S., at pages 420, 421, 3 Sup. Ct. 236, at page 244, 27 L. Ed. 979, where he said:

“ ‘The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specification as carries such element into the claim, he makes such element material to the combination, and the court cannot declare it to be immaterial. He expressly says the carbon shall be “bound” and he shows it in the drawings as bound by staples or wire stitching and claims it as “bound” “substantially as described.” We cannot therefor say “binding” is immaterial.

As was said in *Acme Truck & Tool Co. vs. Meredith*, C. C. A. 183 Fed. 124, 127:

“In patents for a combination it is well settled that if any essential element of the combination is omitted from an alleged infringing device without substituting therefor its *clear mechanical equivalent*, the charge of infringement is not sustained. *Fay vs. Cordesman*, 109 U. S. 408, 3 Sup. Ct. 236, 27 L. Ed. 979; *Boyd vs. Janesville Tool Co.*, 158 U. S. 260-267, 15 Sup. Ct. 837, 39 L. Ed. 973; *Cimiotti Unhairing Co. vs. American Fur Refining Co.*, 198 U. S. 399-410, 25 Sup. Ct. 697, 49 L. Ed. 1100; *Eames vs. Godfrey*, 1 Wall. 78, 79, 80, 17 L. Ed. 547; *Rowell vs. Lindsay*, 113 U. S. 97, 5 Sup. Ct. 507, 28 L. Ed. 906; *Union Match Co. vs. Diamond Match Co.*, 162 Fed. 148-155, 156, 89 C. C. A. 172.

“In *Fay vs. Cordesman* above it is said, beginning at page 420 of 109 U. S., at page 244 of 3 Sup. Ct. (27 L. Ed. 979) :

“ ‘The claims of the patents sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering into the combination, either directly by the language of the claim, or by such a reference to the descriptive part of the specifications as carries such element into the claim, he makes such element material to the combination, and the court cannot declare it to be immaterial. It is his province to make his own claim and his privilege to restrict it. If it be a claim to a combination, and be restricted to specified elements, all must be regarded as material, leaving open only the question whether an omitted part is supplied by an equivalent device or instrumentality.’ ”

And again the court said in *Acme Truck & Tool Co. vs. Meredith*, C. C. A., 183 Fed. 124, 129:

“In *Eames vs. Godfrey*, 1 Wall. 78, 17 L. Ed. 547, in speaking of a patent for a combination, it is said:

“ ‘The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. The use of any two of these parts only, or of *two combined with a third, which is substantially different in form or in the manner of its arrangement and connection with the others*, is, therefore, not the thing patented. It is not the same combination if it substantially differs from it in any of its parts.’ ”

His Honor Judge Van Fleet, in the Court below, found infringement by, according to Levison, "a substantial application of the doctrine of equivalents," and found his basis for such doctrine in the case of narrow combination patents in the paper bag case reported in 210 U. S. 405. We agree with his Honor that a combination patent is entitled to the application of the doctrine of mechanical equivalents, like any other patent, subject however, to the condition always imposed both in the Paper Bag Case and all other adjudicated cases of authority, that the degree of liberality to be accorded the claims in construing them is proportioned to the position of the patent in the art. That is, a pioneer patent is to be liberally construed, whilst a patent standing at the end of a long line of similar efforts, is limited to its specific construction. As I read the Paper Bag Case and the other cases of similar import, it seems impossible to accede to Judge Van Fleet's broad statement that "the rule is as declared in the paper bag case, that a secondary or improvement patent *equally* with a *primary patent* is to have a fair and reasonable construction, and is entitled to the protection of the doctrine of equivalents to the extent that it shows a substantial improvement in the art; it is not of course entitled to the broad application to the doctrine equally with a pioneer or primary patent, but it is entitled to the application of that doctrine to the extent that its claims fairly and justly construed will so entitle it."

In other words, Judge Van Fleet would extend the doctrine of mechanical equivalents to even the narrowest of patents.

About the latest expression of the Supreme Court that is instructive on this point and others here, is the Acetylene Burner Case reported in Advanced Sheets No. 3, January 1, 1910, U. S. Sup. Ct., page 46, 50, 215 U. S.—opinion by Mr. Justice Holmes. The Court said:

“The patent was held void below on the further ground that it had been anticipated. We turn to this last because the question is complicated with the theory that we have mentioned. If the Dolan patent had unreservedly committed itself to the notion of a cooling envelop with a contrivance made very short for the purpose of securing that result, the argument in defense of it would be that the leading earlier patents proceeded upon the opposite theory of mixture, and admitted, if they did not contemplate, a longer tube, however similar otherwise they might be. They, at least, exhibit the state of the art at the date of the supposed invention, and show *within what narrow and precise limits* Dolan had to move if he was to produce anything new. So much may be said to be undisputed, and we have mentioned some of the facts that cannot be denied. But, on the view that we have taken of Dolan’s specifications, they anticipate all that he can be said to have disclosed to the public.” (The italics are ours.)

So here if Levison is unreservedly committed to the notion of a *bound* carbon, as he admittedly is,

then the prior art shows within what *narrow* and *precise limits* Levison had to move if he was to produce anything new. No more complete refutation seems to be needed' to the novel doctrine advanced by his Honor in the lower Court that "secondary patents equally with pioneer patents" were entitled to a liberal application of the doctrine of equivalents.

At the same term of Court Mr. Justice Holmes delivered another opinion to the same effect: the case of *Brill vs. Washington R. & E. Co.*, reported 215 U. S.—Advanced Sheets No. 6, page 177, February 15, 1910. The Court said:

"It is difficult to put one's finger with certainty upon what the plaintiff claims. It certainly is not the total combination of a successful truck. Mr. Brill, the inventor and the plaintiff's assignor, is pictured as playing a large part in the development of street railway trucks, but whether that be true or not, his share in the invention of the truck that we have described, so far as the present patent, at least, is concerned, must be at best but very small. It is insisted to be sure, that the case is not affected by inventions for use with steam railroad cars, because of the different requirements upon street roads. Cars for the latter use must be low hung to make getting in and out easy, must accomodate the motors hung upon the axles, must be adapted to short curves, and so forth. But these differences are not of universal effect; indeed, this patent is not confined to street cars. The suspension of the car body upon a semi-elliptic spring hung from the side frame of the

truck by a jointed hanger, with most of the characteristics of the present patent, as disclosed in a patent to Thyng in 1845, was obviously as available for street as for steam railways, and the use of these features by Brill was not a patentable invention. The use, on the modern long car, of two four-wheeled pivotal trucks with a short wheel base and wheels of equal diameter, which support the car body by a pivot on a bolster between the axles, resting on semi-elliptic springs, was not peculiar to Brill. It was described in patent to Taylor, October 31, 1895, No. 507,855. Brill's specification disclaims at the outset the general features of the truck it describes. Indeed, it hardly is denied that every element in the combination was well known in the construction of railway cars.

“We are not dealing with a new type of trucks, but with certain features only. At the argument it was admitted that the plaintiff's case must stand or fall on claim 13 of No. 627,989. In that claim the only possible element of novelty is the mode in which the semielliptic springs are suspended from the side frames. In practice the links are elastic and the pins on which the whole combination hangs have a universal ball-and-socket movement, although the claim only says ‘movably and resiliently suspended . . . substantially as described.’ Neither ‘movably’ nor ‘resiliently’ indicates the ball-and-socket arrangement, but it is described in the specification, and we give the plaintiff the benefit of the doubt. We agree, however, with the circuit court of appeals,

that the substitution of all ball-and-socket movement for the movement in one direction of the Thyng link, coupled, as it was, with a slight longitudinal play, required a minimum of invention. A link having universal movement was patented by Beach in 1876. The plaintiff's witness, Akarman, says that there always has been provision made for lateral and longitudinal motion in every well-constructed truck. Spring links to support semielliptic springs were old; it is unnecessary to recite the patents in which they appear. The mention of 'the usual link-hung bolster' in the disclaimer indicates the indisputable fact. We also agree with the other court that the disclaimer in favor of Brill and Curwen is a solemn admission of the priority of the devices claimed by them. It certainly covers the collocation of the spring links and semielliptic springs. One of the claims of Brill and Curwen is: '12. The combination in a car truck of the side frames, the equalizing-bars movably and resiliently suspended from the side frames, and a bolster supported on said equalizing-bars, substantially as described.' It is said that the Brill patent did not follow the Thyng invention for more than fifty years. The answer is that for most of that time it was not wanted. Very soon after the change in street railway travel required it, it came.

"If the plaintiff's claim could be sustained, which we cannot admit, it would be confined to the specific form of link described. There would be little room for the doctrine of equivalents. The defendant's device does not use a ball and socket, but uses a rigid

link supported by a relatively unyielding spiral spring in the frame of the truck, and does not infringe the very narrow claim which is the most that, in any view, could be allowed.”

We have quoted at considerable length from this opinion of Judge Holmes because it is one of the most recent expressions of the Supreme Court on the questions of Invention, Anticipation and the liberality of construction that is to be accorded a combination patent.

The opinion of Judge Holmes in the Brill case above, distinctly states:

“If the plaintiff’s claim could be sustained, which we cannot admit, it would be confined to the specific form of link, described. There would be little room for the doctrine of equivalents.”

We respectfully submit that Levison comes within the category to which the Brill patent belongs. Judge Van Fleet admits that in order to make out infringement Levison must be accorded “a substantial application of the doctrine of equivalents.” This we do not think he is entitled to.

As bearing on our contention that Levison is limited by the claims of his patent to a “bound” carbon “substantially as shown and described” in his specifications, see *Lieberman et al, vs. Ruwell et al.*, 170 Fed. 590 (C. C. A.). The Court said:

“But, without dwelling on a distinction which may be merely verbal, it is only necessary to remark that, where a patent depends for its novelty over *the prior art upon a single limited feature of construction*, the

claims cannot be expanded by any doctrine of equivalents to cover a device which lacks that single essential feature. *Typewriter Co. vs. Wyckoff et al.*, 151 Fed. 585, 81 C. C. A. 129.”

See also *Lewis Co. vs. Semple*, 177 Fed. 407, C. C. A., 9th Circuit, opinion of your Honors.

As further showing that Levison is in no sense a pioneer, is the fact that Levison *infringes the Barlow claim*. The Barlow claim is as follows:

“An improved blank for manifold copying, consisting,

- 1.—of a sheet of paper,
- 2.—divided into three equal sections,
- 3.—by lines of perforations,
- 4.—and printed in the same manner herein shown and described,
- 5.—whereby the sections may be folded upon each other with a single sheet of copying paper,
- 6.—in such manner that matter written upon one section will be reproduced upon the other two, substantially as set forth.”

Obviously, the above exactly describes the Levison device.

It is elementary that, “That which infringes if later would anticipate, if earlier.”

Muller vs. Eagle Mfg. Co., 151 U. S. 186;

Eames vs. Worcest Polytechnic Institute, 123 Fed 67.

This case therefore, is analogous in many respects to the case of the *Holt Mfg. Co. vs. The Best Mfg.* lately before you and reported in 172 Fed. 409. In

that case claim 11 of Berry, an anticipating reference, relied on by defendant below, was pointed out by your Honors to be infringed by Best, plaintiff below, and therefore such broad combination as might have been Best's was anticipated by Berry, and Best was therefore entitled only to a narrow patent for his specific construction.

THE VERY BEST EVIDENCE OF THE LACK OF EQUIVALENCY BETWEEN THE "BOUND CARBON" OF LEVISON AND THE CARBON HOLDING MEANS OF KITCHEN IS THAT THE PATENT OFFICE HAS GRANTED KITCHEN A PATENT ON HIS SPECIFIC CARBON HOLDING MEANS.

The respondent operates under a separate patent which is on the *carbon with its special piece of card board* to permit it to be stuck temporarily in between the leaves at any place in the book. Added to this actual difference between the carbon holding means of the parties, respondent therefor comes before this Court with the presumption that it does not infringe, which presumption it is entitled to as much as is the complainant that the presumption that the patent sued on is valid (especially when we consider the vast number of patents declared invalid by the courts each year).

The grant of the respondent's patent by the Patent Office raises the presumption not only that it is potentially different from complaintant's patented device, but that it does not infringe.

Kokomo Fence Co. vs. Kitselman, 189 U. S. 8,
47 L. Ed. 689;

Union Match Co. vs. Diamond Match Co., 162 Fed. 148, 155 (C. C. A.);

Corning vs. Burden, 15 How. 252, 14 L. Ed. 683;

Boyd vs. Janesville Hay Tool Co., 158 U. S. 261, 39 L. Ed. 973;

Taber vs. Marceau, 87 Fed. 871 (Judge Morrow).

The issuance of the defendant's patent creates a prima facie presumption of a patentable difference from the prior patent of the plaintiff.

Ransome vs. Hyatt, 69 Fed., 148.

“The defendants are manufacturing under and agreeably to two later patents, the mere issuing of which creates a presumption of a patentable difference between the plaintiff's bells and the defendant's bells.”

New Departure Co. vs. Hardware Co., 69 Fed., 152, 156.

“Considering the complainants and Whitney as alike having improved on the prior art, the question is whether the specific improvements of the one actionably invaded the domain of the other. The presumption from the grant of the letters is that there was a substantial difference between the inventions.”

Kokomo Fence Co. vs. Kitselman, 189 U. S., 8, 23; 47 L. Ed.

See, also:

Miller vs. Eagle Manufacturing Co., 151 U. S., 186, 208, 38 L. Ed., 131;

Wilgus vs. Germain, 72 Fed., 773, 776.

In *Illinois Steel Co. vs. Kilmer Co.*, 70 Fed., 1012, 1015, the defendant's machine was built under a patent later than that of the plaintiff. The Court said: "The grant of this later patent for a machine designed to accomplish the same result as that of the patents in suit raises the presumption that there is a substantial difference between them, and that the later is not an infringement of the earlier patents."

Citing:

American Nicholson Pavement Co. vs. City of Eliabeth, 4 Fish. Pat. Cases, 189, Fed. Cas. No. 312;

Ney vs. Manufacturing Co., 69 Fed., 405.

Upon this subject the United States Supreme Court said in *Corning vs. Burden*, 15 How., 252, 14 L. Ed., 683, 691:

"It is evident that a patent, thus issued after an inquisition or examination, made by skillful and sworn public officers, appointed for the purpose of protecting the public against false claims or useless inventions, is entitled to much more respect, as evidence of novelty and utility, than those formerly issued without any such investigation. Consequently such a patent may be, and generally is, received as *prima facie*

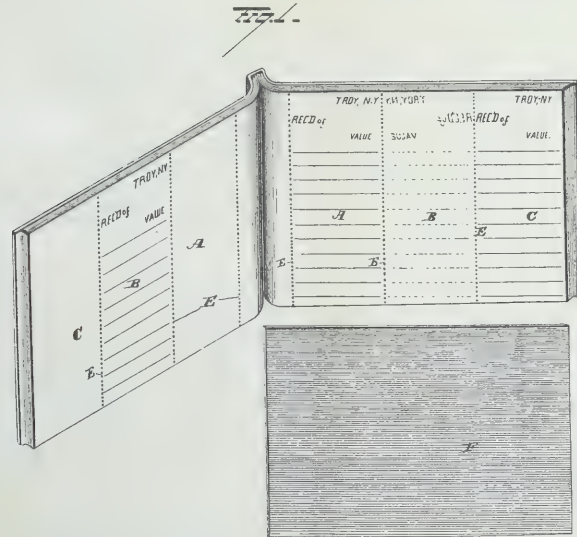
evidence of the truth of the facts asserted in it. And in cases where the evidence is nicely balanced, it may have weight with a jury in making up their decision as to the plaintiff's right; and if so, it is not easy to perceive why the defendant who uses a patented machine should not have the benefit of a like presumption in his favor, arising from a like investigation of the originality of his invention, and the judgment of the public officers, that his machine is new, and not an infringement of the patent previously granted to the plaintiff. It shows, at least, that the defendant has acted in good faith, and is not a wanton infringer of the plaintiff's rights, and ought not, therefore to be subjected to the same stringent and harsh rule of damages which might be justly inflicted on a mere pirate. It is true the mere question of originality or infringement generally turns on the testimony of the witnesses produced on the trial; but if the plaintiff's patent in a doubtful case may have some weight in turning the scale in his favor, it is but just that the defendant should have the same benefit from his; *valeat quantum valeat*."

It is respectfully asked that the decree should be reversed with costs to appellant.

Respectfully submitted.

CHAS. E. TOWNSEND,
Solicitor for Appellant-Respondent.

H. G. & J. B. BARLOW.
 DEVICE FOR MANIFOLD COPYING.
 No. 297,556. Patented Apr. 29, 1884.



The claim of this patent is as follows:

An improved blank for manifold copying, consisting of a sheet of paper divided into three equal sections by lines of perforations, and printed in the same manner herein shown and described, whereby the sections may be folded upon each other with a single sheet of copying-paper, in such manner that matter written upon one section will be reproduced upon the other two, substantially as set forth.

No. 612,197.

G. E. DOUGHTY.
 MANIFOLD BOOK.
 (Application filed Sept. 17, 1897.)

Patented Oct. 11, 1898.

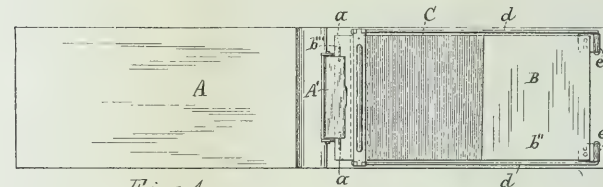


Fig. 1.

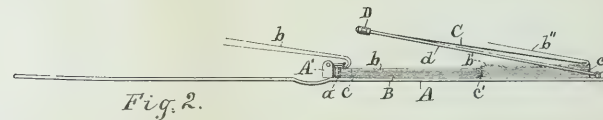


Fig. 2.

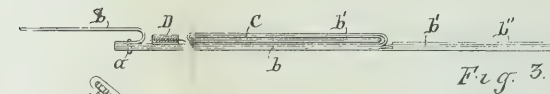


Fig. 3.

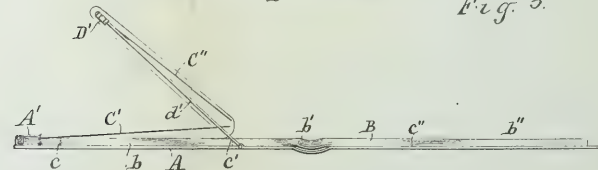


Fig. 4.

634,438.

A. ABRAHAM.
 MANIFOLDING SALES BOOK.
 (Application filed May 4, 1899.)

Patented Oct. 10, 1899.

Fig. 1.

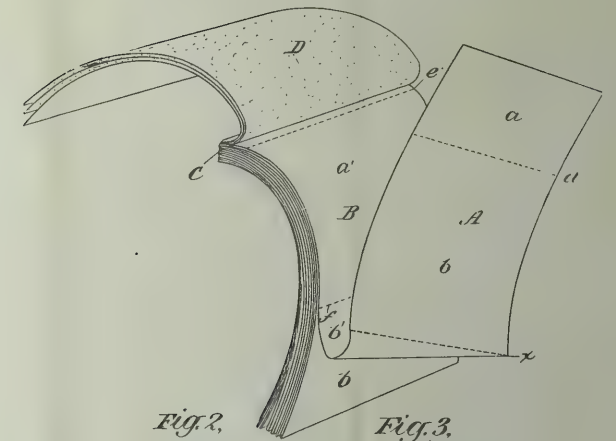
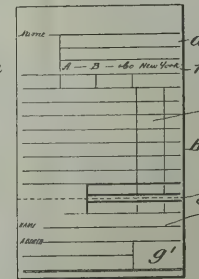
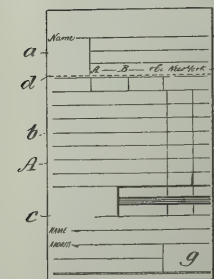


Fig. 2.

Fig. 3.



No. 553,503.

Patented Jan. 28, 1896.

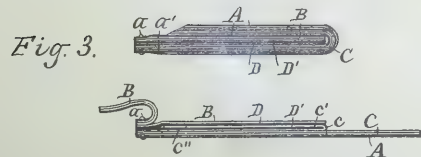
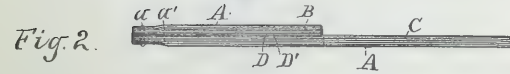
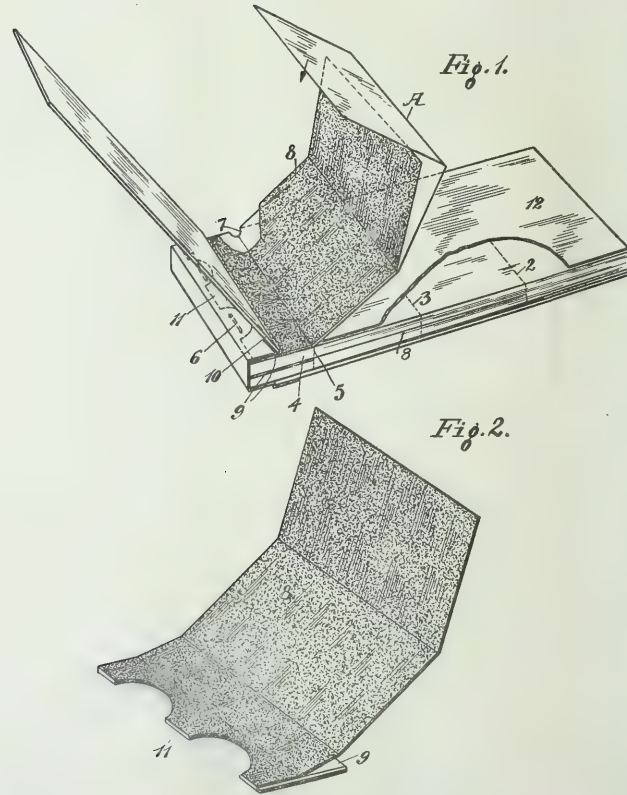


Fig. 4.

911,597.

Patented Feb. 9, 1909.



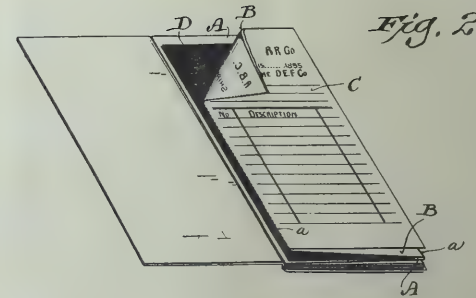
WITNESSES
Evelyn Peterson
B. R. Penfield

E. J. PERRY.
CARBON COPYING MANIFOLD SHEET OR BOOK.
No. 11,547. Reissued June 9, 1896

Fig. 1.

[illegible]

Fig. 2.



No. 1900

IN THE
United States Circuit Court of Appeals

FOR THE
NINTH CIRCUIT

JOHN KITCHEN, JR., CO.
Appellant

vs.

ALEXANDER LEVISON
Appellee

Brief for Appellee

JOHN H. MILLER,
WM. K. WHITE,
For Appellee.

FILED

MAY 2 1901

IN THE

United States Circuit Court of Appeals

FOR THE

NINTH CIRCUIT

JOHN KITCHEN JR. CO., (a corporation,

Appellant,

vs.

ALEXANDER LEVISON,

Appellee.

} No.
1900

APPELLEE'S BRIEF.

This case comes before this Court at this time on an appeal from an interlocutory decree of the Circuit Court of the United States for the Northern District of California, granting a permanent injunction against the further infringement of claims 3, 4 and 5 of United States Reissue Letters Patent, Number 12,005, granted on July 1, 1902, to Alexander Levison (the appellee) for a "Manifold Book."

Fig. 1

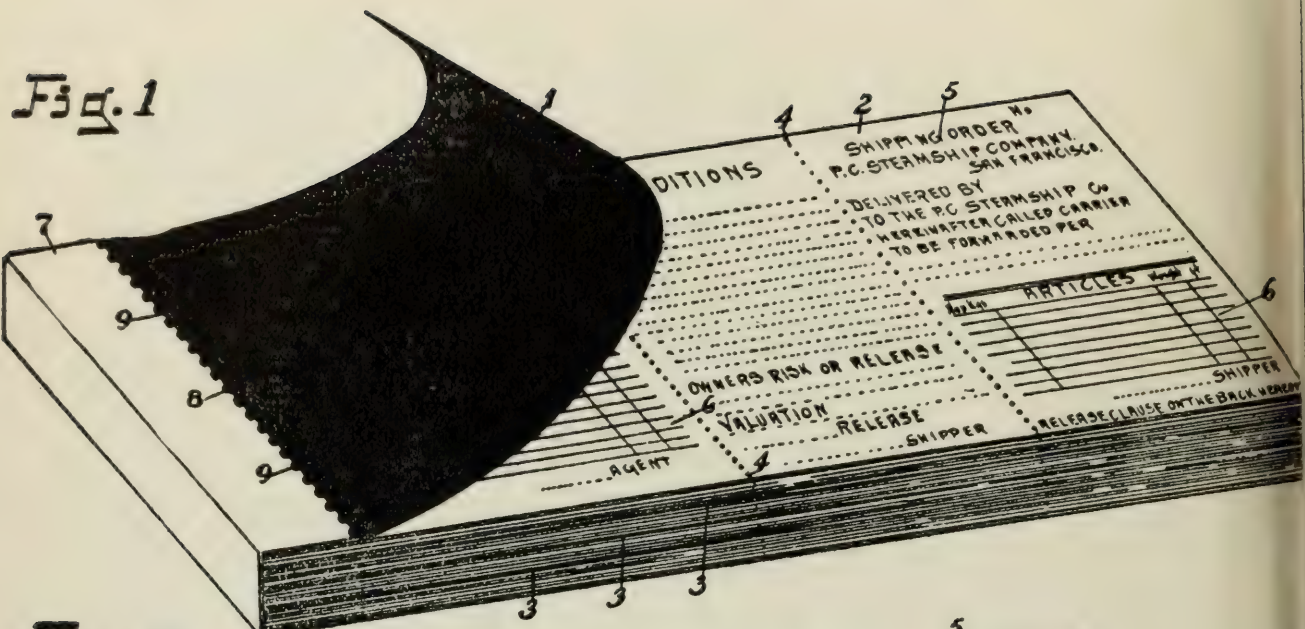


Fig. 2

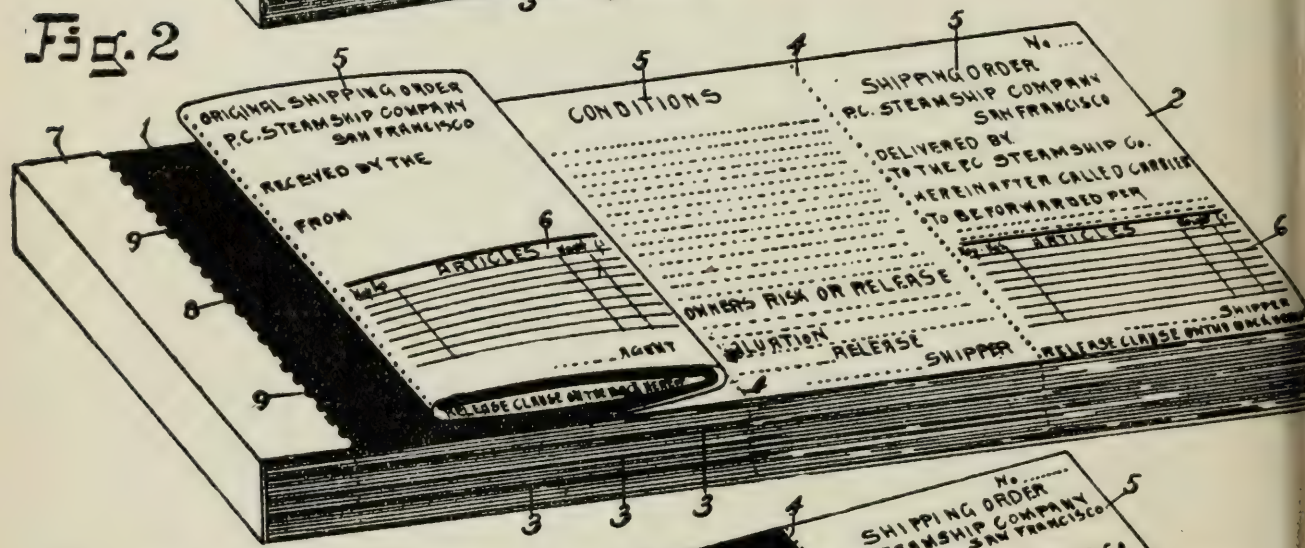
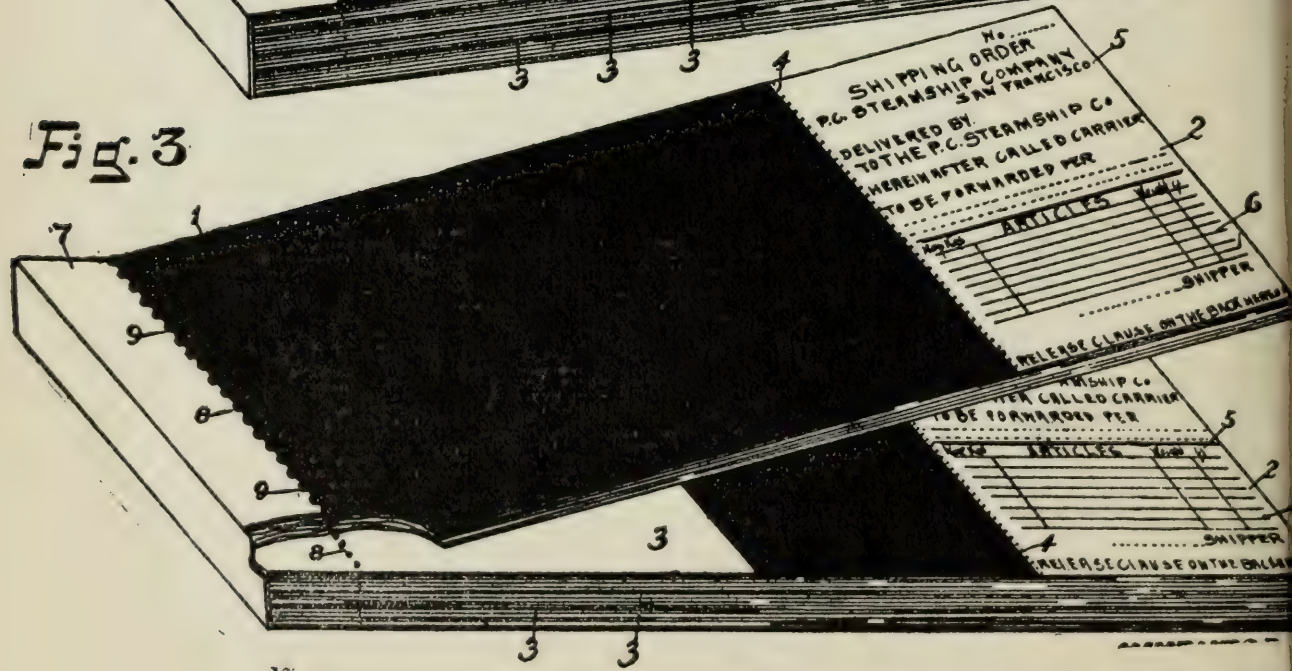


Fig. 3



ARGUMENT.

The defense most relied on is want of invention. It is contended that the change made by Mr. Levison in prior devices was so simple that it was an obvious thing to do. The old answer to this argument is the best answer: "No one did it before."

The invention disclosed in the patent in suit relates to an improved manifold receipt book for mercantile, railway, express, or other uses.

As said by Mr. Levison in the patent:

"The object of my invention is to provide a book of this character which shall be convenient in use, economical in the number of carbons required, which shall give secure protection against alterations and forgeries, and the sheets of which can be readily and conveniently placed on record after the impression has been taken."

On the opposite page are reproduced the three figures of the patent.

Referring to these figures of the patent, it is said therein:

"In the accompanying drawings, Figure 1 is a perspective view of one of my improved manifold-books before use. Fig. 2 is a similar view showing the position when folded for use; and Fig. 3 is a perspective view of the book, a number of sheets being turned up and the book being broken away to show a cardboard backing and carbon-paper.

“Referring to the drawings, it will be seen that my improved manifold-book is formed in sections, each section comprising in order, first, a carbon-sheet 1, of about two-thirds the width of the book, then below said carbon-sheet 1 a number of sheets 2, of ordinary paper, the full width of the book, then a sheet 3 of hard thick cardboard. Each record-sheet outside the stub 7 is divided into three substantially equal parts by vertical lines of perforations 4, said parts having suitable printed matter 5 and blank lines 6, whereon to inscribe the desired record. The carbon-sheets 1 are of sufficient width to extend over two of said parts, while the cardboard backing 3 occupies the width of the inner parts only of the sheets above it. The record-sheets and the cardboard backings are attached to stubs 7 along lines of perforations 8, so that they can be readily detached from said stubs, and said stubs and one side of each carbon-sheet are all bound together to form a book.

“In use the record-sheet is first folded on the outer line of perforations 4, so as to cover about one-half of the carbon-sheet, and it is then folded in the same direction on the second line of perforations, so that the carbon is now folded inside of the record-sheet, as shown in Fig. 2. The record will now be written upon what was the back of the middle portion of the sheet when it was flat and unfolded, which will now, however, have come to the top. The carbon-sheet is double or carbonized on both sides, so that a copy of the record will be made upon each of the two terminal parts of the sheet. Also an inverted or backhanded copy of the writing will be formed upon the back of each part except the inner

one. This latter feature gives additional security against subsequent alteration of the record, since it is difficult to erase and rewrite both the original and the reverse copy.

“The advantages of the above construction are that any kind of paper can be used for the record-sheets, and the construction does not require any transparent paper. The carbon naturally falls into the position for use for the next record-sheet when one record-sheet has been removed and the record-sheet is very readily folded in the desired manner, the fold being twice in the same direction. The device is economical of carbon paper.”

The claims, held by the lower court to have been infringed, read as follows:

“3. A manifold book comprising in order a double carbon-sheet, and a plurality of recording-sheets, the record-sheets outside the stubs being divided into three substantially equal separable parts, and the carbon-sheet extending the width of two of said parts, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon sheet being all bound together to form a book, substantially as described.

“4. A manifold-book comprising in order a double carbon-sheet, and a plurality of recording-sheets, each of said sheets outside the stubs being divided into a plurality, not less than three, of substantially equal separable parts, and the carbon-sheet extending the width of said parts except the

outermost, said recording-sheets having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.

“5. A manifold-book comprising in order a double carbon-sheet, and a plurality of recording-sheets, each recording-sheet outside the stub being divided into a plurality not less than three of separable parts joined along lines of perforations, each part being not greater than the part next it on the side toward the stub, and the carbon-sheet extending the width of the whole of said parts except the outermost, said recording-sheet having stubs to which they are attached along lines of perforations, said stubs and one side of the carbon-sheet being all bound together to form a book, substantially as described.”

It will be noted that claims 4 and 5 are not limited to record sheets divided into three parts. Such claims are broader than claim 3. If the defendant infringes claim 3, it necessarily infringes claims 4 and 5. We, therefore, shall discuss only claim 3.

The Levison invention is a simple one, and as with many valid patents, the construction may seem to some persons obvious after it has been disclosed by the patentee; but as stated by the Court of Appeals for the Second Circuit, in *United Fastener Co. vs. Bradley*, 149 Fed., 222:

“This Court has repeatedly upheld patents for similar improvements, *the test being not the simplicity of the device, but the difficulties overcome and the results accomplished.*”

“The invention belongs to that large class which has ever been treated with liberality by the courts, when the inventor by an apparently simple change, addition or transposition of parts, has converted imperfection into completeness.”

Wagner Co. vs. Wychoff, 151 Fed., 590.

“It may seem a small thing, involving no great ingenuity, in ordinary pipe coupling to merely make the spud of brass, leaving the other parts unchanged; but considering the efforts of others in the same direction, and the various expedients resorted to, to obtain an easily detachable, and at the same time a steam and water tight joint, *the simplicity of the device confirms rather than detracts from the invention, something more than ordinary mechanical skill being required to go so directly to the mark.* Nor is it of any consequence that the well known principle is made use of, that iron against brass will not rust. It is not necessary in order to make out invention that new qualities shall be evolved. It is sufficient if old ones are novelly and inventively applied.”

Western Tube Co. vs. Rainear, 156 Fed., 52.

“Slight changes in appearance, may bring about radical changes in results. Invention is not to be slighted because the changes are slight.”

National M. Casting Co. vs. American Steel Foundries, 182 Fed., 636.

The Court of Appeals for the First Circuit, in *Decoco Co. vs. Gilchrist*, 125 Fed., 298, said:

“To obtain absolute simplicity is the highest trait of genius.”

THE PRIOR ART.

In considering the prior art, it should ever be borne in mind that the test of invention is “not the simplicity of the device, but the difficulties overcome and the results accomplished.”

The progress in this art is illustrated by Complainant's Exhibits D to R, inclusive. By tracing the development in the art by means of these exhibits, it will be seen that many inventors were endeavoring to reach the goal finally won by Mr. Levison. He took the last step and “converted imperfection into completeness.”

Exhibit D (Rec., 210) is a receipt book consisting of a number of leaves, each of which is divided into three sections. Upon each section of the leaf is the same printed form. To obtain three copies of the receipt it is necessary, in using this book, to fill in the blanks in each section of the leaf. In this book no carbon is used for the purpose of doing away with the labor of writing the entries three times to secure the original receipt and two copies thereof.

Exhibit E (Rec., 211) is a receipt book consisting of a number of series of leaves. Each series consists of three sheets of different colors, one above the other, and each having the same form of receipt printed thereon. To secure three copies of the receipt by the use of this book, two loose sheets of semi-carbon are used. One semi-carbon is placed between the first and second sheets of the series and the other semi-carbon sheet is placed between the second and third sheets of the series. The entries made upon the first sheet of the series is transmitted by the two semi-carbons to the second and third sheets of the series. It is apparent that this book is a great improvement on Exhibit D, as three copies of the receipt are obtained by one writing of the entries. The various sheets of the series are of different colors to aid the user of the book in placing the loose carbon sheets between the sheets with the printed forms thereon. There are, however, many objections to this book. In using it, one is required to handle the loose semi-carbon sheets, which are smutty. It is difficult to quickly insert said loose carbon sheets in the proper place in the book and the same are always apt to be mislaid or lost. These carbon sheets are also apt to become folded or creased by constant handling and this destroys their efficiency.

This form of book is also objectionable for the reason that the manufacturer thereof is unable to predetermine and limit the use of the carbon sheets. For instance, if the carbon sheets used with the book are capable of

transmitting fifty impressions and the book contains one hundred original receipt forms, the user of the book may attempt to make more than fifty triplicate receipts by use of the same carbon sheets, thus obtaining indistinct copies. (Rec., 212).

Exhibit F (Rec., 213) is similar to Exhibit E, but in order to facilitate the handling of the loose carbon sheets, one corner of the original and one corner of the duplicate receipt sheet is cut off, so that the corner of the original receipt sheet does not extend as far as that of the duplicate receipt sheet and the corner of the duplicate sheet does not extend as far as that of the triplicate receipt sheet. By this construction, the user of the book can more readily distinguish between the original and duplicate sheets and between the duplicate and triplicate sheets. This was an advantage, as it facilitated the placing of the semi-carbon sheets between the proper receipt sheets. *This book, Exhibit F, shows that the necessity of handling the loose carbon sheets in Exhibit E was an objectionable feature thereof, and that this book was made for the purpose of eliminating, to some extent, such objectionable feature, by making it easier for the user to insert the two semi-carbons in their proper places.*

Exhibit G (Rec., 215) is a book consisting of a sheet of yellow paper followed by a sheet of thin transparent paper and then by a sheet of pink paper. On each of these sheets is printed the same form. The use of the transparent paper is to eliminate the necessity of hand-

ling *two* loose semi-carbons, which must be done in using the books above referred to.

In using Exhibit G, a double carbon, or sheet carbonized on both sides, is inserted between the transparent sheet and the third sheet of the series. An entry on the first sheet of the series is transmitted by the carbon to the under side of the transparent sheet and to the upper face of the third sheet of the series. The second sheet of the series being transparent, the entry transmitted by the carbon to its under side can be seen and read.

This book, Exhibit G, is an improvement on the previous books of the art, as only one sheet of carbon is required in making the original and two copies of the receipt. The necessity of using only one double carbon sheet is a great advantage over the use of two semi-carbons, as thereby the user of the book is saved a great deal of time and labor in handling and inserting the carbon sheets between the proper recording sheets preparatory to making out a receipt.

Exhibit H (Rec., 216) is a book made in accordance with the specification and drawings of the Barlow patent, Defendant's Exhibit No. 1. Said patent was issued in 1884. This book consists of a series of leaves, each divided, by lines of perforations, into three sections. Upon each section is printed the same form. A loose double carbon of the length of two of the sections of the printed sheet is used with this book, so that

three copies of the receipt are obtained with one writing of the entries.

In the Barlow patent it is said:

“In using the paper having both faces carbonized, a sheet of sufficient size to cover two of the three sections of each blank is employed. Such a sheet is laid over the printed side of section A and the unprinted side of section B. The section C is now folded to the left and laid upon the copying-paper covering the unprinted side of the section B. Then the two sections B and C with the interposed copying-paper are folded to the left and laid upon the copying-paper covering the section A. The printed surface of the section B becomes the uppermost, as the result of folding the blank in the manner described, and this section is accordingly written upon with a pencil and the matter written is duplicated upon each of the sections A and C.”

That the patentee Barlow appreciated the defects in the books of the prior art and was endeavoring to remedy such defects is seen from the following quotation from his patent:

“It will be seen that with one blank sheet, and with *a single sheet of carbon-paper*, two duplicates of the written matter are produced, whereas *two* detached sheets of copying-paper have heretofore been necessary to get the same number of copies. *The old method is objectionable on account of the number of sheets to be adjusted and cared for, and to the shipping clerk, who carries the sheets from*

place to place, the handling and care of the sheets is a source of great annoyance."

That Barlow almost did what Levison, years later, did, cannot be denied. Barlow, however, failed to take "the last step," the step necessary to convert "imperfection into completeness." Although Barlow reduced the number of carbon sheets theretofore required to make three copies, he failed to eliminate entirely the use of loose carbons, which, he admits, "are a source of great annoyance." He perceived the objections to the use of loose carbon sheets but was unable to perceive a way of eliminating the same in a tripling book.

Levison perceived the possibility of binding the carbon sheets with the stubs of the record sheets of the book, so that the carbon sheets would always be in their proper place and the user of the book would thereby be relieved of the annoyance of handling and inserting the same. He not only perceived the possibility and feasibility of providing means for holding the carbon sheets in their proper place in the book, but he also perceived the possibility of the manufacturer of the book determining the life of the carbon sheets and inserting the same in the book at such intervals that the user thereof could not make more copies with a single carbon than such carbon was adapted to make.

The change made in the imperfect Barlow book by Mr. Levison was a simple one, but it could not have

been an obvious change for otherwise Barlow would have made it. We know by his expressed statement that Barlow appreciated the objections to the use of loose carbons in triplicating books, and we know he was unable to provide a means for *entirely* eliminating the use of the same. His efforts only resulted in reducing the number of such loose carbons used in such books. Barlow, by his own admissions, was seeking the same results finally secured by Levison some fifteen years later. In view of Barlow's unsuccessful efforts to secure such results, can it possibly be held that the means of securing such results were obvious?

"It is easy after the event to see how simple an act turned failure into success," says the Court of Appeals for the Seventh Circuit in *Streator Cathedral Glass Co. vs. Wire Glass Co.*, 97 Fed., 957.

"It is this capacity for accomplishing results, this faculty of seeing what others fail to see and hearing what others fail to hear, which has always distinguished success from failure and the inventor from the mechanic."

Frost Co. vs. Cohn, 119 Fed., 505.

As said by the Supreme Court:

". . . the invention consists rather in the idea that such change could be made, than in making the necessary mechanical alterations."

Hobbs vs. Beach, 180 U. S., 393.

Exhibit I (Rec., 220) consists of a series of leaves, the first sheet of each series being of thin, transparent paper. The second sheet of the series is of yellow paper and twice the length of the transparent sheet. The yellow sheet is divided into two sections. In using this book, a double carbon is placed between the transparent sheet and the inner section of the yellow sheet. The outer section of the yellow sheet is then folded to the left over the transparent sheet. The entries written upon the outer section of the yellow sheet are transmitted to the under side of the transparent sheet and to the upper side of the inner section of the yellow sheet. This book was supposed to be an improvement on the Barlow book by reason of the carbon sheet being smaller and of the length of only one section of the printed sheet. Of course, a small loose carbon sheet is more easily handled than a larger one and is less apt to become creased or crumpled. Exhibit I came on the market after the date of the Barlow patent, so it will be seen that the "simple change" made by Levison in the Barlow book was not obvious to the creator of this exhibit book. Levison "*succeeded where others failed.*"

Exhibit K (Rec., 221) consists of a number of series of leaves, the first sheet of each series being smaller than the second sheet thereof and the second sheet being smaller than the third sheet thereof. The second sheet is transparent and a double carbon is placed between the second and third sheets for transmitting the entries

made on the first sheet. The sheets are of different sizes to enable the user to more readily insert the carbon at the proper place. This book also shows the efforts of others to remedy the defects in the Barlow book due to the difficulty of handling and inserting at the proper place the large, loose carbon sheet used therewith. Regarding this matter, the witness Harry Levison said:

“A. . . . In fact, the thing strived at in all these books was to facilitate the handling of the carbons” (Rec., 222).

Exhibit L is a book made in accordance with the Bengough patent, defendant's Exhibit 7 (Rec., 222). This patent was issued in 1896 and, in our judgment, conclusively shows that the step, taken by Mr. Levison, was not an obvious one. This patent discloses an obviously impractical construction designed to remedy the same defects in the books of the prior art, which defects were subsequently eliminated by Mr. Levison. *To maintain that the step taken by Mr. Levison was an obvious one is also to maintain that Bengough deliberately took out a patent on an impractical book, notwithstanding it was obvious how to construct a practical one.*

As said by the Court of Appeals for the Third Circuit in *Edison Electrical L. Co. vs. Novelty Incandescent Lamp Co.*, 167 Fed., 982:

“Not a few inventors, including Mr. Edison himself, had for some time been busied in the effort to

secure a satisfactory arrangement of leading-in wires, and the different means taken for doing so, better than anything else, shows the complexity of the problem involved, and that in order to meet it something more than ordinary skill was required. To deny its successful solution the merit of invention upon the contrary idea *is to declare that these efforts were needless, and that there was already disclosed in the art an easy and obvious way out, which ought to have been, but somehow was not seen.* We are not, however, to be persuaded to that view."

Regarding Exhibit L, and comparing it with Exhibit 14, a book made in accordance with the patent sued on, Mr. Harry Levison said:

"A. *The thing aimed at in all the previous books was the purpose of getting a triplicate copy with the least amount of handling carbons.* This particular book here is made up with two pieces of carbon bound in the center of the book or between a series of sheets that extend one-half the length of a series of sheets following. The long sheets are folded in the center and placed between the two pieces of carbon, and by writing upon the short sheet you obtain a carbon impression on the two other sheets. The book is worked from the center. After the impression is made you tear out the two sheets in the center of the book and leave the carbon in place for the writing on the other sheets. I have never seen this book on the market, no doubt because it was an awkward book to handle. The

handling of the two carbons in the book appear to me to be even more awkward than handling loose carbons. In Exhibit 14 there is one carbon attached to the book, where in this book here there are two pieces of carbon attached to the book. The fact that the carbon is bound in the center of the book and that you work from the center to the outside of the book makes it obvious that when you reach the outside edge, the sheets, through being such a thickness of stubs between the sheet that you write on and the sheet upon which the impression is to be taken, that the register is not perfect; and furthermore, the thickness of the stubs at the binding space makes a hollow surface upon which to write; therefore the writing would not be as clear; one is apt to punch a hole through the sheets with his pencil. The register is not likely to be perfect, and the fact of binding, confining these two pieces of carbon and separating them in order to place your sheets in proper position is just as awkward to handle as to place two pieces of loose carbon. In defendant's Exhibit 14 of the Peerless book the carbon is always in the proper place and need not be handled. Another thing about this book is that there is just this one set of carbons to bind in the book, and if the book is made of any particular thickness, why, the carbons are apt to be worn out before you reach the end of the book; where, in the book defendant's Exhibit 14, the Peerless book, by interspersing the carbons you can make the book of any thickness you want. In this book it is impossible to get a good book and make the book as thick as it might be required" (Rec., 222-224).

Exhibit M is a book made in accordance with the Perry patent, defendant's Exhibit 6 (Rec., 224). This patent was also issued in 1896.

Regarding Exhibit M, and comparing it with the Levison book, Exhibit 14, Mr. Levison testified as follows:

"A. This particular book is also contrived with the idea of making the handling of carbon easier than the previous patents. While this patent—that is, the Perry patent—is not on the book, the patent is on the manner in which the sheets are printed, and it does not provide in the patent that the sheets be bound in any particular way. The patent merely calls for the transverse printing on the middle copy. In order to do this it is necessary to use a transparent sheet of paper or a very thin sheet of paper, which is not a practical sheet of paper to be used in the business world; and you use it by folding the middle section over the inner section and then reversing the fold and folding the outer section over the middle section. By placing one piece of carbon paper which is carbonized on both sides between the middle and inner section, you get your three copies with the one writing. As I said before, this here requires the use of thin paper, which cannot always be used in business. The carbon is loose and cannot be attached to the book owing to the fact that the third copy remains in the book, and it is impossible to bind or attach a piece of carbon to that book. To my knowledge I have never seen this book on the market, and probably for the

reason that it can only be used with this thin paper. The defendant's Exhibit 14 can be used with any kind of paper of reasonable thickness, and therefore is adaptable to all business purposes. Defendant's Exhibit 14 provides for a book with the carbon held in place or attached to the book. This is with the loose carbon, but this merely shows an effort on the part of the inventor to provide some means of doing away with the handling of several sheets of carbon, but it has never been used to my knowledge.

"Q. 35. In using a single loose sheet of carbon with this book just referred to, and folding the three sections of paper in the manner shown in this book, why is it necessary to have the paper so thin?

"A. Because they use but one piece of carbon, and they place that between the second and third fold. The carbon impression is taken on the back of the second fold or middle sheet, and the impression must be seen through the sheet in order to be read properly and read on the right side of the sheet. The papers merely call for the printing, call for the taking of an impression of the printing on the back of the sheet so that it will be seen through on the front" (Rec., 225-226).

The Brown patent, issued in 1897, is in evidence as defendant's Exhibit No. 4 (Rec., 317). This patent illustrates still another expedient resorted to for the purpose of remedying the defects in the books of the prior art by eliminating the use of loose carbons. The book is made up of a series of leaves, there being in each series three sheets. It is said in the Brown patent:

“In the method now generally employed for making duplicate or triplicate receipts, cash or memorandum tags, where more than one copy is desired, it is customary to employ independent sheets of carbon-paper, which are laid between the upper and lower sheets, so that when a mark or entry is made upon the upper sheet it will be transferred by means of the carbon surface of the next sheet below and this again to a third sheet by the use of a second sheet of carbon. *These carbon sheets are necessarily loose and changeable from one part to another of the book, pad or other record for the purpose of each new entry* and are somewhat expensive to produce.

“In my invention I print or apply upon the back of a sheet by means of any printing-press or other suitable means a surface of non-drying and transparent ink, which when superposed over another sheet will transfer any entries or marks made upon the front side of said sheet or upon any sheet anterior thereto to a subsequent sheet, which may be placed below the one having the above-described surface.”

It will be noted that in this Brown book, the backs of the sheets, having the printed receipt forms thereon, are carbonized, so that the entries made on a sheet are transmitted to the sheet below. Regarding this feature of the Brown book, the witness Levison said:

“This book has not taken very favorably, inasmuch as the back of the paper, being made of thin non-drying ink, was smutty and dirty, and filthy to

everything that it came in contact with, and not only smutty and dirty, but it smutted and dirtied the book in which it was bound and also smutted and dirtied the papers or anything that might be lying about it, after it had been detached from the book" (Rec., 227).

The Brown book is practically an abandoned construction and is no longer on the market (Rec., 229-230).

This Brown patent clearly demonstrates that the step taken by Levison was not an obvious step. As seen from the above quotation from the Brown patent, he appreciated the defects in the triplicating books of the prior art, due to the use of loose carbons therein, and was endeavoring to correct such defects. His efforts in this direction only resulted in an obviously impractical book. Can it be successfully maintained that the step, subsequently taken by Levison, was obvious to Brown? If it was obvious to him, why did he not take it instead of securing a patent on such an impractical construction?

Exhibit P is made in accordance with Fig. 2 of the Doughty patent, defendant's Exhibit No. 2 (Rec., 235). This patent was issued in 1898. The complicated construction of this Doughty book clearly shows that "*the simplicity of the Levison book confirms rather than detracts from the invention, something more than ordinary mechanical skill being required to go so directly to the mark.*"

Regarding the Doughty book, and comparing it with the Levison book, the witness Harry Levison testified as follows:

"This book is made of a series of sheets which are printed so as to permit the folding over of the sheet on the arm, the metal arm. *A metal arm of some kind is attached to the outer edge of the book, and the carbon is attached to the outside or the end of the arm.* In order to use this book, it is necessary to take this carbon or this arm upon which lies a piece of carbon and to lay this arm over the two innerside portions of the sheet, fold the outside portion of the sheet over the middle portion, and the middle portion over the inner portion, folding the carbon with it at the same time. After having written upon it it is necessary to unfold the sheet, throw the arm out of the way which holds the carbon, detach your sheets, the two outer sheets from the inner sheet, lay the inner sheet out of the way, unfold the outer edge of the next succeeding sheet, fold your arm back again into position and place your carbon in its proper position, then refold the sheet as described before. This is a laborious task, entirely impracticable, and to my knowledge I have never seen this book on the market. It is very evident that to use this book would require more trouble and more work than it would to use or insert a dozen pieces of carbon in the entire book. Defendant's Exhibit 14 does away with this mechanical work, does away with this arm and all this extensive and extravagant manner with which to hold the carbon to the book. In handling this book

of Doughty you are required to handle the carbon even more than you are required in any of the other books, while in defendant's Exhibit 14 you do not handle the carbon at all. *In this particular book it is shown that there has been an effort made on the part of the inventor to do away with the handling of the carbon, but it is very evident that he did not succeed*" (Rec., 234-235).

Figure 4 of the Doughty patent discloses another construction, even more complicated than that of figure 2. This modified construction is shown in the book marked "Complainant's Exhibit Q" (Rec., 236). No book of this type is on the market.

Exhibit R (Rec., 238) is made in accordance with the Abraham patent, defendant's Exhibit No. 3. This patent, issued in 1899, discloses a duplicating book in which a single carbon, attached to the book, is inserted between the folds of a leaf for the purpose of making an original and one copy of the receipt. It is not a triplicating book and a sheet carbonized only on one side is used with it. This book, therefore, does not contain the elements of the Levison claims charged to be infringed.

ANTICIPATION.

It is apparent that no patent of the prior art discloses the combination of elements set forth in any one of the claims charged to be infringed. It is true that one or more of the elements of said claims may be

found in one prior patent, and other elements in another prior patent, and still others in a third. It is indispensable, however, that all the elements of a claim be found in the same prior patent in order for such patent to operate as an anticipation. If opposing counsel had been able to find one such prior patent disclosing all the elements of the Levison claims, he would not have encumbered the record with so many patent exhibits only remotely relevant to the issues herein.

“ . . . It is no defense to a claim of infringement that one or more elements of a patented combination, or one or more parts of a patented improvement, may be found in one old patent or publication, and others in another, and still others in a third. It is indispensable that all of them, or their mechanical equivalents, be found in the same description or machine, where they do the same work by substantially the same means. *Imhaeuser vs. Buerk*, 101 U. S., 647, 660, 25 L. Ed., 945; *Bates vs. Goe*, 98 U. S., 31, 48, 25 L. Ed., 68; . . . ”

J. L. Owens Co. vs. Twin City Separator Co.,
168 Fed., 265.

In *Yesbera vs. Hardesty Mfg. Co.*, 166 Fed., 125, it is said:

“The point to be emphasized is that the law looks not at the elements or factors of an invented combination as a subject for a patent, but only to the combination itself as a unit distinct from its parts”

To the same effect is the case of *Gormully & J. Manufacturing Co. vs. Stanley Cycle Manufacturing Co. et al.*, 90 Fed., 280:

“Of course the claim cannot be defeated by showing that each of its elements, separately considered, was old. The defendants must prove that the combination was old. If they fail in this, they fail irretrievably.”

COMMERCIAL SUCCESS.

The merits of the Levison book are shown by its rapid introduction into commercial use.

To ascertain the general use of this book, the witness H. F. Williams made a house to house canvass, and the results of his investigations are disclosed in complainant's Exhibit C, which contains a statement of the various business houses in this city using the Levison book. The manner in which the witness collected the data set forth in Exhibit C is thus described by him:

“A. In order to be thorough I started on one street, say Pacific street, and I would go up one side and down the other. I would go into every house, irrespective of the fact whether I knew they used our book or not; and I continued on all the streets parallel with Market, down to Market, then I crossed over and went along every street parallel with Market, south of Market, and I stopped at every business house on the streets that run parallel with Market, down to 9th and 10th and Brannan; in fact, to the water front, Channel street, I think

they call it, parallel with Brannan; then I took in all the Mission district; then I took a scattering list, wherever I could rake up any commercial houses on any of the streets, any houses of any kind or shape at all, and this is the result of my work. In addition to that I took all the streets from East street, Davis and Drumm and Front and Battery, clear up to Market, on the north of Market; then on the south of Market I took in East street and every street running up to East and covered every house that I could possibly find that did any shipment or occupied any position in the commercial world" (Rec., 121-122).

Exhibit C discloses the fact that over 90 per cent. of the business houses in the districts covered by the witness use the Levison book exclusively. This is conclusive proof of the superiority of the Levison book over books of the prior art.

"In determining this question [of invention], the fact that the article produced supersedes all other appliances, or that a useful and commercially successful result has been attained, or that the value of the thing patented has been recognized by the public in extensive use, has a controlling, if not conclusive, effect, and it should have, upon obvious principles of justice to one who sees that which he suggests constantly appropriated and used by others. Such is the proof in this case."

Wilkins Shoe-Button Fastener Co. vs. Webb, 89 Fed., 997.

Such is the proof in the case at bar.

The decision above referred to was cited with approval by this Court in its decision in the case of *Morton vs. Llewellyn et al.*, 164 Fed., 693. The Court, through Judge Ross, said:

“Apart from the presumption of novelty that always attends the grant of a patent, the law is that when it is shown that a patented device has gone into general use and has superseded prior devices having the same purpose, it is sufficient evidence of invention in a doubtful case. *The Barbed Wire patent*, 143 U. S., 275, 292, 12 Sup. Ct., 443, 36 L. Ed., 154; *Keystone Manufacturing Company vs. Adams*, 151 U. S., 139, 143, 14 Sup. Ct., 295, 38 L. Ed., 103; *Irvine vs. Hasselman*, 97 Fed., 964, 38 C. C. A., 587; *Wilkins Shoe Button Co. vs. Webb* (C. C.), 587, 89 Fed., 982; *National Hollow B. B. Co. vs. Interchangeable B. B. Co.*, 106 Fed., 693, 707, 45 C. C. A., 544.”

PATENTABLE INVENTION.

The novelty of the Levison book must be admitted. Whether or not it required the exercise of the inventive faculties to devise, originate and construct such novel book is a question of fact capable of determination by evidence. The appellee comes into court with the presumption of law that his patent is good and valid and covers patentable subject matter over everything theretofore known. This presumption arises from the grant and issuance of the patent and is a statutory presump-

tion. In any case, where the question of patentable novelty is close and in doubt, this presumption is controlling.

Morgan vs. Daniels, 153 U. S., 120;
Cantrell vs. Wallick, 117 U. S., 679.

And this presumption is of such legal effect that "evidence to overcome the presumption of invention arising from the issuance of the patent *must be conclusive* on the question."

Requia Co. vs. New Century Box Co., 138 Fed., 903.

However, appellee has not relied upon such presumption alone. He has proved, by uncontradicted evidence, that there was a long felt want in the art for just such a book as is disclosed in his patent; he has proved that the books of the prior art contained certain well-known defects, which were, from time to time, attempted to be eliminated by prior inventors; he has proved that said attempts were not successful; he has proved that his own attempts to eliminate such defects were successful and that his patented book met with immediate and general favor. In view of these facts, can it be said that the step taken by appellee was an obvious step?

His Honor, Judge Van Fleet, held that appellee *did* exercise his inventive faculties in originating the book disclosed in the patent in suit. In view of such find-

ing, can it now be held that the evidence herein proves, *beyond a reasonable doubt*, that appellee did *not* exercise his inventive faculties? Does not the decision of the lower court to the contrary necessarily preclude a finding by this Court that the evidence herein proves, *beyond a reasonable doubt*, that the step taken by Levison did *not* amount to invention?

“This was the conclusion reached by the court below after a careful consideration of all this evidence. It is settled by the repeated decisions of the Supreme Court and of this Court that where the Chancellor has considered conflicting evidence and made his finding and decree thereon, they must be taken to be presumptively correct and unless an obvious error has intervened in the application of the law or some serious or important mistake has been made in the consideration of the evidence, the findings should not be disturbed.”

North American Explorative Co. vs. Adams,
104 Fed., 404;

Tilghmann vs. Proctor, 125 U. S., 136;

Furrer vs. Ferris, 145 U. S., 132.

The Barlow patent, issued as early as 1884, discloses a book, which, in our judgment, most nearly approaches the construction of the Levison book. The defects in the Barlow book, although apparent, and although attempted to be remedied by many others, were not eliminated until Levison, over fifteen years after the Barlow book first came on the market, invented the book covered by the patent in suit.

Since the advent of the Levison book, the Barlow book has practically disappeared from the market. Certainly the simple modification made in the Barlow book by Mr. Levison was not an obvious change or it would have been made years before. Whether a change in a device, which greatly improves it, is an obvious change or not, can be judged only by the conduct of those familiar with the art. Where a device is on the market for many years and it is generally appreciated that the device contains certain defects which from time to time are unsuccessfully attempted to be remedied, and finally such defects are remedied, it is safe to say that the man who makes the necessary change in the device to eliminate such defects is an inventor.

“One criterion of invention is that others have sought and failed, even when the process is so simple, when discovered, that many believe they could have produced it if required. *Walk. Pats.*, Sec. 26.”

Hanifen vs. Armitage, 117 Fed., 849.

“The English patent shows a clumsy device which apparently never went into successful operation. It seems to be conceded that the English structure can not be used as the Jeffrey structure is used without first making several important changes. The proof leaves no doubt on that subject. It is argued that these changes might have occurred to the skilled artisan. That they did not occur to any one until Jeffrey made the invention is evident. They seem simple enough now, but in-

vention depended upon their being successfully wrought out. *In short, in these changes lies the difference between the commercial failure of the English patent and the widely recognized success of the patent at bar."*

Gormully & J. Mfg. Co. vs. Stanley Cycle Mfg. Co. et al., 90 Fed., 280.

In the case of *Expanded Metal Co. vs. Bradford*, 214 U. S., 381, the Supreme Court, speaking through Mr. Justice Day, recently said:

"It is often difficult to determine whether a given improvement is a mere mechanical advance, or the result of the exercise of the creative faculty amounting to a meritorious invention. *The fact that the invention seems simple after it is made does not determine the question*; if this were the rule many of the most beneficial patents would be stricken down. It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor."

As to the significance to be attached to a simple modification that changes failure into success, Judge Coxe, in *George Frost Co. vs. Cohn*, 112 Fed., 1009, affirmed (C. C. A.), 119 Fed., 505, says:

“Here was a situation, say the defendants, where a hard unyielding substance had been tried and found wanting, and where a soft and gripping substance was needed in its place. Rubber possessed all the required qualities and everyone knew it. What was then more natural than to use rubber? This argument has been so often considered by the courts that little of value can be added to the discussion, and, after all, the old answer is the best answer, ‘No one did it before.’ The record shows that for at least ten years prior to Gorton’s invention men skilled in the art were endeavoring to make an operative supporter and several had so far succeeded as to secure patents, but always along the same lines. There were always the metal button, there was always the fabric clamped between two metallic surfaces. Rubber, in almost every conceivable shape and form, was everywhere in use, but no one thought of it. Like a jewel lost in a crowded thoroughfare, multitudes pass it unnoticed, some actually tread upon it, others stop and gaze for a moment, but hurry on, deeming it some worthless tinsel; at last comes one who recognizes its value and picks it up. Others might have done this it is true, but they did not; he did, and is entitled to the prize which he has rescued from the mire. If one should attempt to snatch the gem from the finder on the ground that he passed it frequently and could have picked it up as well as not, he would in all probability be promptly turned over to the police as a thief or a lunatic. It is this capacity for accomplishing results, this faculty of seeing what others fail to see, and hearing what others fail to hear,

which has always distinguished success from failure and the inventor from the mechanic. 'In the law of patents it is the last step that wins,' says the Supreme Court. This is the step which Gorton took."

In *Hancock vs. Boyd & Getly*, 170 Fed., 600, it is said:

"Was the conception of Hardy to incline the plow disc or discs out of a vertical plane invention? . . . It must be and is conceded, all the other elements of the claim in controversy were old and well known prior to the date of the Hardy patent. . . .

"As has been seen, at this late day, with the completed implement before us, with a practical test made demonstrating the ease with which the work is performed by such implement, with a thorough knowledge of the ultimate end sought to be accomplished, the resistance which must be overcome in the doing of the work, and all the knowledge now at hand, it is almost inconceivable why in the experimental stage of designing and manufacturing rotary disc plows the advisability, or, I may say, the absolute necessity, for inclining the plow disc out of the vertical plane was not thought of by some one and employed before the Hardy idea was conceived. But, admitting the simplicity of the idea employed, its almost apparent necessity to accomplish the end sought, and the fact that the change made might have been discovered by mere accident, yet, if it be conceded the idea was new when first employed by Hardy, do these facts detract from its character as invention? . . .

“Mr. Justice Blatchford, delivering the opinion of the Court in *Consolidated Valve Co. vs. Crosby Valve Co.*, 113 U. S., 157, 5 Sup. Ct., 513, 28 L. Ed., 939, said:

“ ‘Richardson’s invention brought to success what prior inventors had essayed and partly accomplished. He used some things which had been used before, but he added just that which was necessary to make the whole a practically valuable and economical apparatus. The fact that the known valves were not used, and the speedy and extensive adoption of Richardson’s valves are facts in harmony with the evidence that his valves contain just what the prior valves lack, and go to support the conclusion at which we have arrived on the question of novelty. When the ideas necessary to success are made known and a structure embodying those ideas is given to the world, it is easy for the skillful mechanic to vary the form by mechanism which is equivalent, and is therefore in a case of this kind an infringement.’ ”

“In the *Barbed Wire Patent Cases*, 143 U. S., 275, 12 Sup. Ct., 443, 36 L. Ed., 154, Mr. Justice Brown, delivering the opinion of the Court, after detailing the steps taken in the manufacture of barbed-wire fence, said:

“ ‘Under such circumstances, courts have not been reluctant to sustain a patent to the man who has taken the final step which has turned a failure into a success. In the law of patents it is the last step that wins. It may be strange that, considering the important results obtained by Kelley in his patent,

it did not occur to him to substitute a coiled wire in place of the diamond-shaped prong, but evidently it did not; and to the man to whom it did ought not to be denied the quality of inventor. There are many instances in the reported decisions of this court where a monopoly has been sustained in favor of the last of the series of inventors, all of whom were groping to attain a certain result, which only the last one of the number seemed able to grasp.'

"Judge Wallace, delivering the opinion of the court in *International Tooth Crown Co. vs. Richmond* (C. C.), 30 Fed., 775, said:

"*'It is not difficult, after the fact, to show by argument how simple the accomplishment was, and by aggregating all the failures of others to point out the plain and easy road to success. This is the wisdom after the event that often forfeits invention, and levels it to the plane of mere mechanical skill. The ingenious argument in this case has not satisfied us that there was no invention in the improvement of Low.'*

"From a consideration of the proofs, exhibits, models, briefs, and arguments in this case in the light afforded by the foregoing authorities, and many others that may be cited, I am clearly of the opinion the conception formed in the mind of Hardy to incline the plow discs out of a vertical plane, as carried out by him in his combination of parts, judged from the results accomplished thereby, was invention, and the claim of the patent in controversy must be upheld unless anticipated in the prior state of the art."

In the case of *Peters vs. Union Biscuit Co.*, 120 Fed., 679, it was said:

“This conclusion leads next to a consideration of the essential nature, in and of itself considered, of the device of the patent, with a view of determining *whether it discloses such inherent simplicity as to be classified as a development of ordinary mechanical skill, or as the result of inventive faculty.* It is true, the paper box in question belongs to a comparatively humble and lowly art. The two elements which compose it are simple and well known, but the union of these two elements in the way and manner and for the purpose disclosed by the patent was obviously not well known at the time of complainant’s invention. The large number of patents and exhibits found in this record looking towards the result achieved by the patentee disclose an unsatisfied need. The art had been diligently practiced for many decades, and divers devices for packing crackers, candy, and other like products had been resorted to, but none of them accomplished the desired purpose. Such being the case, when a patent is finally granted for a device which does accomplish the desired result, the court should not look with disfavor upon it. *Keystone Manufacturing Co. vs. Adams*, 151 U. S., 139, 14 Sup. Ct., 295, 38 L. Ed., 103. The simple scheme of subjecting the two elements before then each separately well known, to a process of unification, consisting of so folding and interfolding them as to create a hitherto unknown unitary structure, was left to the complainant. The argument that this

new and peculiar combination was a mere aggregation of old elements, and a mere product of ordinary mechanical skill, so obvious as to be readily perceived and taken advantage of by those skilled in the art, is, in my opinion, fully answered by the fact that none of the numerous inventors in defendants' line of industry, and none of the skilled artisans engaged for years in that industry, with the problem urgently confronting them, ever did discover its solution. As said in *Loom Co. vs. Higgins*, 105 U. S., 580, 26 L. Ed., 1177, 'It may have been under their very eyes; they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and bring it into notice.' It seems to me that the step taken by complainant in uniting and unifying the two old elements in question in the way and manner already disclosed was the final step in the line of invention in the industry in question, which turned failure into success, within the true meaning of the doctrine announced in *Barb Wire Patent*, 143 U. S., 275, 12 Sup. Ct., 443, 36 L. Ed., 154. The treatment of the two elements in question, in my opinion, produced a new and useful result. It certainly disclosed a method of producing an old result in a 'more facile, economical and efficient' way; and the case is brought directly within the doctrine announced by the Court of Appeals of the Eighth Circuit in divers cases, and particularly the case of *National Hollow Brake Beam Co. vs. Interchangeable Brake Beam Co.*, 45 C. C. A., 544, 106 Fed., 693. The 'barb' of the *Barb Wire Patent*, *supra*, the 'collar button' of *Krementz vs. S. Cottle Co.*, 148

U. S., 556, 13 Sup. Ct., 719, 37 L. Ed., 558, and the 'dam' of *DuBois vs. Kirk*, 158 U. S., 58, 15 Sup. Ct., 729, 39 L. Ed., 895, are each and all of them very simple devices; but they served a new and useful purpose, and were held by the Supreme Court of the United States to involve patentable invention."

In the case of *Albright vs. Langfeld*, 131 Fed., 473, it is said:

"When the Patent Office has granted a patent to an inventor, the court should not be ready to adopt a narrow or astute construction fatal to the grant, and in cases where there is any doubt the test of practical success is always persuasive evidence of novelty and has great weight in solving the question favorable to the invention. *Keystone Mfg. Co. vs. Adams*, 151 U. S., 145, 14 Sup. Ct., 295, 38 L. Ed., 103. It is always possible, where an inventor has made an improvement upon the familiar article of simple mechanism, and the improvement only involves changes and additions, which afterwards seem simple and unimportant, to allege want of invention, or the result only that which the ordinary mechanic skilled in that particular art could have seen; yet where the difficulties and objections overcome by this improvement, however slight, have been endured by the public for a long time, and numerous efforts have been made to overcome them, without complete success, when a patent is granted for an improvement in that particular article which does overcome such former difficulties and objections, and it has immediately gone into use, the courts have,

as a rule, found in favor of the inventor, and sustained the patent. Examples of patented inventions which have been upheld by the courts, although they differed very little in form, mechanism, or operation from other appliances, are numerous."

To the same effect is the case of *Hutter vs. De Q. Bottle Stopper Co.*, 128 Fed., 284, where it is said:

"In short, the Hutter device seems to have remedied former defects and supplied what was needed, namely a simple, cleanly, durable, cheap and easily manipulated bottle stopper. *The fact that this result was accomplished by a simple change does not detract from its patentability.*"

In the case of *Curtis vs. Atlas Co.*, 136 Fed., 222, Judge Archbald used the following language:

"It is somewhat remarkable that with all the ingenuity and skill, inventive as well as mechanical, which has been brought to bear upon the manufacture of bicycles, so simple and convenient an appliance as the detachable rubber foot-rest devised by the complainant should not have been thought of before. The fact that it had not, and that it has gone into such extended use as was shown, not only proves that it has met a popular and hitherto unfilled demand, but is also persuasive that its discovery involved the exercise of real invention, and not simply the handy skill of the ordinary mechanic, as one might at first be inclined to believe. The invention displayed may not be of a high order, but it was, at

least, sufficient to appreciate the need, and the means for meeting it acceptably, where others had failed, a circumstance which always has weight."

In the case of *Brunswick-Balke Collender Co. vs. Thum et al.*, 111 Fed., 904, Judge Lacombe, speaking for the Circuit Court of Appeals for the Second Circuit, said:

"The improvement of the patent relates to the part of a bowling alley known as the ball returnway or runway, which returns the balls from the pit end of the alley to the players' end. The old style of runway consisted of a track or trough which inclined downwardly all the way from the pit end to the players' end, down which the balls rolled with a speed increasing all the way, and dependent upon the degree of inclination given to the track. . . .

"The facts in the case at bar are closely analogous to those which were before this court in *Schenck vs. Singer Mfg. Co.*, 23 C. C. A., 494, 77 Fed., 841. *The improvement consists in an extremely simple, and, it would seem, perfectly obvious, application of common knowledge as to the law of gravitation.* Were there nothing in the record but the bare statement of facts above set forth, we would be inclined to concur with the court below in the proposition that:

" 'Had any skilled mechanic been asked to perfect a structure that should gradually arrest the momentum of the returning ball, an ascent would obviously have been the structure needed.'

"But in this case, as in the *Singer* case, the evi-

dence shows conclusively, and, indeed, without contradiction, that this very demand for an arrester of the returning ball was before skilled mechanics for many years, and yet no one before Reisky hit upon the device which now seems so obvious. . . .

“So many of these devices are shown that it is apparent that the skilled mechanics were for years trying to find some way properly to retard the ball, and the proof conclusively shows that all of them were unsatisfactory. Not one of them secured retardation by a change of grade of the trough itself, until the patentee disclosed his simple method, which has so commended itself that now, within three years after the issuance of the patent, 90 per cent. of the existing bowling alleys have the new style, or Reisky, returnways. In the face of this evidence, we cannot hold that his improvement is devoid of patentable invention.”

We desire to call particular attention to the foregoing opinion, because it is therein recognized that the question whether or not the inventive faculties have been exercised in the creation of a novel device is a question of fact and not of arbitrary opinion. It will be noted that in this Brunswick case, the lower court treated the question as one of opinion, and held that the inventive faculties had not been exercised in creating the patented device, notwithstanding the proofs clearly showed that many prior inventors had unsuccessfully endeavored to solve the same problem. By reason of the simplicity of the device, the lower court

held that the step taken by the inventor was obvious, although the proofs showed the contrary.

In the case at bar, opposing counsel would have the court hold, as a matter of opinion, that the step taken by Levison was obvious, although the proofs conclusively demonstrate the contrary. We respectfully submit that this question of invention herein should be determined in the light of the proofs, even though, when considered retrospectively, the change made by Mr. Levison, appears very simple.

In the case of *Bowers vs. San Francisco Bridge Co.*, 91 Fed., 381, Judge Morrow says:

“Before taking up these objections to the Schwartzkopff patent, it is proper to state that the burden of proof to show that the Bowers patents and inventions for dredging have been anticipated by prior patents is upon the defendant, who alleges such anticipation, and that the proof in support of the prior patents must be clear and convincing and place the matter beyond a reasonable doubt. As was aptly said in *Vulcanite Co. vs. American Co.*, 34 Fed., 320, where the defense relied on was anticipation and want of patentable novelty:

“ ‘The evidence does not satisfy us that the complainant’s contrivance to avoid the danger of slipping on smooth-surfaced composite pavements was anticipated, nor that it lacked patentable novelty. In this respect the case is doubtless near the line, and calculated to inspire doubt. To create doubt, however, is not sufficient to overthrow the presumption.

arising from the patent. The evidence should be satisfactorily convincing.'

"In *American Bell Tel. Co. vs. People's Tel. Co.*, 22 Fed., 313, where it was alleged by the defendant that one Drawbaugh was the prior inventor of Bell's telephone, Judge Wheeler said:

" 'The complainant starts with the presumption of law that Bell, the patentee, was the inventor. . . . Whoever alleges the contrary must assume the burden of proof. Evidence of doubtful probative force will not overthrow the presumption of novelty and originality arising from the grant of letters patent for an invention. It has been frequently held that the defense of want of novelty or originality must be made out by proof so clear and satisfactory as to remove all reasonable doubt.'

"This case was subsequently affirmed by the Supreme Court of the United States in the Telephone Cases, 126 U. S., 2, 8 Sup. Ct., 778.

"In *Philadelphia Trust, Safe Deposit & Insurance Co. vs. Edison Electric Light Co.*, 13 C. C. A., 43, 65 Fed., 554, Judge Wales, speaking of a defendant who sets up new matter, said:

" 'The uniform practice has been to require the defendant to place himself within the exception requiring him to prove his defense beyond a reasonable doubt.'

"In *Manufacturing Co. vs. Lynch*, 71 Fed., 410, Judge Townsend uses the following language:

" 'The burden is upon the defendants to support this affirmative defense by such cogent and conclusive proof as to convince this Court that, if it had

been presented upon the former hearing, it probably would have led to a different conclusion. In several cases the courts have held that such defense must be established beyond a reasonable doubt.'

"In *Electric Mfg. Co. vs. Edison Electric Light Co.*, 10 C. C. A., 106, 61 Fed., 834, Judge Jenkins said:

" 'In the consideration of such new defense of anticipation, regard should be had to the rule that such a defense is an affirmative one, that the burden of proof is upon him who asserts it, and that the grant of letters patent is *prima facie* evidence that the patentee is the first inventor of the device described therein, and of its novelty.'

"The Supreme Court has stated the rule in terms not less strong. In *Coffin vs. Ogden*, 18 Wall., 124, Mr. Justice Swayne, speaking of an asserted prior inventor, says:

" 'The burden of proof rests upon him, and every reasonable doubt should be resolved against him. . . . The law requires, not conjecture, but certainty.'

"This rule of evidence is approved in later cases in the Supreme Court. See *Cantrell vs. Wallick*, 117 U. S., 689, 695, 6 Sup. Ct., 970; *Barbed Wire Case*, 143 U. S., 275, 12 Sup. Ct., 443, 450. See also *Bresnahan vs. Leveller Co.*, 19 C. C. A., 237, 72 Fed., 920; *Patent Co. vs. Donnallan*, 75 Fed., 287."

VALIDITY OF PATENT AS A REISSUE.

The validity of the Levison patent is attacked upon the ground that the same was improperly reissued.

The rules governing the reissues of patents, and which are applicable to the facts of this case may be briefly stated as follows:

I. The law does not allow a patentee, by reissue, to expand *the invention* described and intended to be protected in the original patent, because that would be allowing him a patent for more than he invented.

II. The law does allow a patentee, by reissue, to expand *the claims* of his original patent, if such expansion is commensurate with the actual invention described in the original patent.

In the case of *Topliff vs. Topliff*, 145 U. S., 156, we find a thorough and exhaustive examination of this whole subject by Mr. Justice Brown, in which he says:

“The second claim is to some extent a change of the claim of the first reissue. It omits the requirement that the connecting rod shall be secured directly to the axle and bolster so as to cause both ends of the side springs to yield simultaneously, and introduced the half-elliptic springs AA¹ as a new element of the combination. Whether this be an enlargement of the original claim or not, it is for substantially the same invention, and in view of the fact that a reissue was applied for as soon as the mistake was discovered and *before any rights in favor of third parties could be reasonably expected to have attached, or had in fact attached*, we think this reissue is not open to objections which have

proved fatal to so many since the case of *Miller vs. Brass Company* (104 U. S., 350). *It is a mistake to suppose that that case was intended to settle the principle that under no circumstances would a re-issue containing a broader claim than the original be supported.*"

The learned justice then proceeds to review all the principal cases on the subject of reissues that had theretofore been rendered. After such review he concludes as follows:

"From this summary of the authorities it may be regarded as the *settled rule of this Court* that the power to reissue may be exercised when the patent is inoperative by reason of the fact that the specification as originally drawn was defective or insufficient *or the claims were narrower than the actual invention of the patentee*, provided the error has arisen from inadvertence or mistake, and the patentee is guilty of no fraud or deception; but that such reissues are subject to the following qualifications:

"First: That it shall be for the *same invention* as the original patent, as such invention appears from the specifications and claims of such original patent.

"Second: That *due diligence* must be exercised in discovering the mistake in the original patent, and that if it be sought for the purpose of enlarging the claim the lapse of two years will ordinarily, though not always, be treated as evidence of an abandonment of the new matter to the public to the

same extent that a failure by the inventor to apply for a patent within two years from the public use or sale of his invention is regarded by the statute as conclusive evidence of an abandonment of the patent to the public.

“Third: That *this Court will not review the decision of the commissioner upon the question of inadvertence, accident or mistake, unless the matter is manifest from the record*, but that the question whether the application was made within a reasonable time is, in most, if not all such cases, a question of law for the Court. *To hold that a patent can never be reissued for an enlarged claim would not only be to override the obvious intent of the statute, but would operate in many cases with great hardship upon the patentee.* The specifications and claims of a patent, particularly if the invention be at all complicated, constitute one of the most difficult legal instruments to draw with accuracy, and in view of the fact that valuable inventions are often placed in the hands of inexperienced persons to prepare such specifications and claims, it is no matter of surprise that the latter frequently fail to describe with requisite certainty the exact invention of the patentee, and err either in claiming that which the patentee had not in fact invented, or in omitting some element which was a valuable or essential part of his actual invention. Under such circumstances, it would be manifestly unjust to deny him the benefit of a reissue to secure to him his actual invention provided it is evident that there has been a mistake and he has been guilty of no want of reasonable diligence in discovering it, and no third persons

have in the meantime acquired the right to manufacture or sell what he had failed to claim. *The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by a too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation."*

This case has since been cited with approval in *Freeman vs. Asmus* (145 U. S., 241), *Huber vs. Nelson Manufacturing Co.* (148 U. S., 292), *Corbin Cabinet Lock Co. vs. Eagle Lock Co.* (150 U. S., 43), and *Dunham vs. Dennison Manufacturing Co.* (154 U. S., 111).

The question at issue is whether the reissued claims are an expansion or enlargement of the original invention. It can not be seriously contended that the invention described in the Levison reissue is not the same as that disclosed in the original patent. *The respective drawings appearing in said patents are substantially identical and in the specification of each patent, only that which appears in the drawings is described.* Opposing counsel apparently contends that the words "substantially equal," appearing in the claims of the reissue are not justified by the description of the Levison book contained in the original patent, and for that reason said claims call for a different invention. This contention is puerile.

The three drawings of the original patent are per-

spective views of the Levison book. By actual measurement, the three parts of the respective record sheets are illustrated therein as being substantially equal. By reason of the drawings being perspective views, the second and third parts of the record sheets are shown slightly narrower than the first part for the reason that said parts are supposed to be more distant from the person looking at the book. That said parts are substantially equal is seen from the specification of the original patent.

It is said therein that the "record sheet is first folded " on the outer line of perforations 4, so as to cover about " one-half of the carbon sheet." From this statement, it is seen that the third part of the record sheet is one-half the width of the carbon sheet. It is also said in lines 36 and 37, page 1, that the carbon sheets are about two-thirds the width of the book. It is further said: "The carbon-sheets are of sufficient width to extend over two of said parts."

If the third part of the record sheet is one-half the width of the carbon sheet and the carbon sheet covers the first two parts of the record sheet, and the third part, when folded over, only covers the second part, the three parts are necessarily substantially equal. We, therefore, see that the three parts of the record sheet are not only shown in the drawings of the original patent as being substantially equal, but *are actually described in said patent as being substantially equal.*

It will be noted that in the original patent, the two features of the Levison invention are very clearly described. One of said features is the use of the card-board backings. It is stated in said patent that: "The "card-board backings are an important feature of my "invention," etc. The other feature is set forth as residing in the novel arrangement of the record sheets and carbons. Both of these features combined together are covered by the single claim of the original patent. Said patent does not, however, cover each of these features, when not combined with the other. In this respect, the said patent was inoperative as either one of said two features could be used by any one without infringing the patent.

The law applicable to the reissue of a patent by reason of the claims thereof being inoperative is thus stated in Sec. 219 of *Walker on Patents*:

"Sec. 219. Claims are the only operative parts of specifications. If an inventor has produced two or more inventions so allied that they may properly be secured to him in one letters patent, and if he fully describes all of those inventions in the descriptive part of his specification, but covers only one of them by his claims, then his patent is operative as to one of those inventions, and inoperative as to the others. Inoperativeness of that kind is sufficient to lay the foundation of a right to a reissue. And where an inventor claims his invention only in combination with something else, his patent is inopera-

tive as to that invention alone. Reissues granted in these classes of cases are called broadened reissues. Though the statute does not, under that name, authorize reissues of that kind, they are authorized by the general terms of the law, and have been upheld by the Supreme Court in many cases; and have been expressly approved by that tribunal."

The single claim of Levison's original patent covered the two sub-combinations constituting his invention. As we have seen, neither of said sub-combinations or features of his invention, when not combined with the other, was covered by a claim. Such being the fact, the recent case of *Universal Caster & Foundry Co. vs. Schenck Co.*, 165 Fed., 344, is particularly applicable in reference to Levison's right to a reissue.

In that case it is said:

"Taking another view of the case, the same result is reached. The reissue claims may be considered as covering a sub-combination of the means for restricting the movements of the spring frame and as not embracing the lug-centering means. Such a sub-combination may be covered by a reissue, although embraced in the original patent only as part of the larger combination. In this respect, also, the reissue was valid."

The fact that both of the said features, when combined together, were covered by the single claim of the original Levison patent, clearly shows that Levison in-

tended to and attempted to secure the same as his invention in the original patent.

Levison certainly was diligent in applying for his reissue. The original patent was issued on February 25, 1902. Sixteen days later, Levison's application for the reissue was on file in the Patent Office at Washington. Considering the time it takes for mail to travel from Washington to San Francisco, Levison must have requested his patent solicitor to prepare the application for the reissue almost immediately upon the receipt of the original patent.

Opposing counsel questioned his expert witness as follows:

“Q. 176. Do you find any inadvertence, accident or mistake in these specifications and drawings appearing in the original patent?

“A. None, whatever.”

We are not surprised that the witness found no accident or inadvertence in the Levison patent. We are somewhat curious to know how an accident could ever be found in a patent.

The Revised Statutes provide that “Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification . . . if the error has arisen by inadvertence, accident or mistake . . . the Commissioner shall, on surrender of such patent . . . cause a new patent for the same invention

“and in accordance with the corrected specification to
“be issued to the patentee . . .”

The original Levison patent was inoperative because it failed to cover separately the sub-combinations or features constituting the invention. In applying for the reissue, Levison in his affidavit, accompanying the petition for a reissue, set forth the facts constituting the accident and inadvertence by reason of which said original patent failed to contain claims commensurate with the scope of his invention.

In the case of *Coeffield & Son vs. Spears & Riddle*, 169 Fed., 641, it is said:

“As to the technical defenses touching alleged irregularities in the Patent Office in the issuing of the original and reissue patents without proper affidavits and evidence of inadvertence, accident, or mistake, it is to be remembered that no such irregularities will be assumed to have occurred, but, on the contrary, the granting of the patent is *prima facie* evidence that the law has been complied with, and fatal irregularities in the Patent Office must not only be aptly pleaded but shown by full and satisfactory proof. In case the original patent has been surrendered and a reissued one has been granted, it has been held that such office proceedings can only be impeached for fraud. *Stimpson vs. Railroad Co.*, 4 How., 380, 11 L. Ed., 1020; *Battin vs. Taggart*, 17 How., 77, 15 L. Ed., 37; *Seymour vs. Osborne*, 11 Wall., 516, 20 L. Ed., 33.”

INFRINGEMENT.

The appellant's book is made in accordance with United States letters patent, granted on February 9, 1909, to Mr. John Kitchen, Jr., president of the appellant corporation. The Kitchen patent is in evidence as defendant's Exhibit 12.

This book is made up of recording leaves, each divided into three sections by vertical lines of perforations. The leaves and cover of the book are bound together by staples. The double carbon sheets used with the book are each secured at one end to a strip of cardboard notched along its back edge to form points. These points of the cardboard are pushed in underneath the cover of the book and between and on either side of the staples. In his patent, Mr. Kitchen says:

“ . . . the pressure on the points 11 of the stub strip, after the latter has been inserted, *will hold the carbon permanently in position.*”

Regarding these carbon sheets, he also says:

“they are held *firmly* in place just as though they had been *bound* in the book originally.”

The contention of opposing counsel is that in view of the fact that the carbon sheets in appellant's books can be removed without tearing them, they are not bound with the recording sheets. The claims of the Levison patent call for a book having the stubs of the

recording leaves and one side of the carbon sheet bound together.

The determination of the question of infringement depends solely upon the meaning to be attached to the word "bound" in the Levison claims. If the "carbon sheets" of appellant's book are "bound" in the book, the book infringes the Levison patent sued on.

In the Levison patent, *the specific means for binding or holding together the recording sheets and carbon sheets are not described*. The Levison invention does not reside in the particular means used for holding the said sheets together. The claims, therefore, should not be limited to any particular means used for that purpose. All "binding means" are included within the scope of the Levison claims.

Regarding this matter, the witness, Harry Levison, testified:

"Q. 57. What is meant by the words or expression 'to bind'? Or the word 'bound' in the art of which the various exhibits form a part?

"A. Do you mean to use the word 'bind' in the art of making these books. I would say that the word 'bind' means anything that is attached to, that is held; in other words, if you would take a dictionary you would find that the definition of the word 'bind' is to confine or restrain or hold by physical force or influence of any kind; to be restrained from motion or from customary or natural action. Therefore anything that is restrained in any manner or by any influence is bound.

“Q. 58. Are there various means used in the art for binding the leaves of a book or loose leaves, together? And if so, state some of those various means?

“A. There are, yes. They can be bound either by glue, paste, sewing, stitching, by clamping, by friction, or by pressure. Any of those things would bind” (Rec., 238).

“Q. 62. (By Mr. White.) I hand you a catalogue of the Barrett Bindery Co. and ask you to state whether or not the same discloses various and sundry means of binding objects together other than by stitching?

“A. It does. In the very first page of this book it heads off with large letters, ‘Binders that Bind.’ And the first one that is put in there is the Torsion, the one that is marked ‘Exhibit T.’ And as you go through the book you will find that he shows a binder on page 7 which is held by cords, string, through the holes in the sheet; while on page 13 he describes a book or shows a picture of a book, and on the top of it it is called a spring back binder. This is evidently according to the description, simply a binder which holds sheets in place by a spring, clamping at the binding place. In other words, the sheets of the books are held in place by friction created by a spring clamp” (Rec., 240).

It will be noted that in this art the word “bound” is not used to signify any particular means employed to hold together sheets of paper. The term is a compre-

hensive one and includes any and all means used to hold together sheets of paper.

Regarding the significance of the word "bound" in this art, the appellant's witness Crandall testified:

"XQ. 14. Is it not a fact that in your stock you have binders, what are called binders in catalogues, which bind the leaves together simply by friction or pressure?

"A. Yes" (Rec., 64).

The Doughty patent discloses a spring clamp used for holding the carbon sheet. Regarding the Doughty book, Mr. Kitchen testified as follows:

"XQ. 1. How is the carbon bound in the Doughty book, Mr. Kitchen? By what means?

"A. It is fastened, clamped to the rim by a spring. . . .

"XQ. 4. You say it is bound in the book?

"A. Bound by a spring, yes" (Rec., 175).

It will be recalled that in this Doughty book, the carbon and stubs of the recording sheets are not bound together, as called for in the Levison claims. The Doughty carbon is held in a wire frame which is attached to the cover of the book.

In appellant's book, the carbon sheets are securely bound in place by the spring action of the stubs of the recording sheets. These stubs are pressed together by the staples and, after being pried apart for the purpose

of inserting one end of the carbon sheet, immediately come together again and clamp or bind the carbon sheets firmly in position. The carbon sheets are, in this manner, says Mr. Kitchen, "held firmly in place just as though they had been *bound* in the book *originally*." Of course it is immaterial whether the carbon sheets in defendant's book are bound in the book after it is made or during the making thereof. The Levison claims simply call for carbons bound in the book. The time of binding them is immaterial.

The appellant's expert witness Maynard testified that appellant's book did not infringe for the sole and only reason that the carbon is not permanently bound therein. In answer to opposing counsel's question he said:

"Q. 46. In what respect do you find that it has not the combination of elements of claim 3?

"A. For the reason that the carbon is not *permanently* bound at any point in the book" (Rec., 53).

This witness therefore admits that the carbon is bound in the Kitchen book, but he says it is not *permanently* bound therein. The Levison claims, however, are not limited to carbons *permanently* bound therein. Nothing is said in the patent about the necessity of the carbons being permanently bound in the book. The claims simply call for carbons bound in the book and the carbons are bound in the defendant's book. It will also be recalled that Kitchen says in his patent that his

carbons are held *permanently* in position. His book therefore infringes the Levison claims.

It is contended by opposing counsel that the appellant's book is an improvement on the Levison book. It is admitted that all the benefits of holding or binding the carbon sheets in place are secured by appellant's construction as well as by the Levison construction, but it is contended that it is of value to be able to remove the carbon sheets and insert others in their place. It is immaterial if the appellant's book is an improvement. We are alone concerned with the fact that it contains all the features of the Levison book.

In *Thomson-Houston Electric Co. vs. Ohio Brass Co.*, 130 Fed., 548, it is said:

"In the case at bar, if the construction with reference to the wires running over the plate should be held to be an improvement on complainant's device, this fact of improvement does not permit the defendants to appropriate the invention of the patents in suit. In *Electric Smelting Co. vs. Reduction Co.*, 125 Fed., 927, the Court say:

"'He (the defendant) does not acquire the right to use the Bradley process, simply because he has improved that process. He is entitled to enjoy what is his, but in so doing he cannot appropriate the property of another . . .'"

CONCLUSION.

We submit that the patent in suit discloses a patentable invention. Mr. Levison "converted imperfection

into completeness" and is entitled to his reward. He remedied the defects in the books of the prior art and "the fact that this result was accomplished by a simple change does not detract from its patentability."

The appellant has undoubtedly embodied the Levi-son invention in its books and has infringed upon claims 3, 4 and 5 of the patent sued on.

Respectfully submitted.

JOHN H. MILLER,
WILLIAM K. WHITE,
Counsel for Appellee.

1900
No, 12005.

FEBRUARY TERM, 1911.

IN THE

UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE NINTH CIRCUIT

JOHN KITCHEN JR. CO.,
(A Corporation)

Appellant,

vs.

ALEXANDER LEVISON,

Appellee.

In Equity,
On Reissue Patent
No. 12005.

PETITION FOR RE-HEARING ON BEHALF
OF APPELLANT.

CHARLES E. TOWNSEND
Solicitor for Complainant

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PETITION FOR RE-HEARING ON BEHALF
OF APPELLANT.

Your petitioner feeling aggrieved by the decision of this Honorable Court in the above-entitled cause, hereby respectfully requests a re-hearing of said cause and that the decree may be modified at least with respect to the conclusion of infringement for the reasons hereinafter stated.

Counsel for appellant is not unmindful that this Honorable Court is regularly besieged with petitions of this character by disappointed litigants and that such petitions are with rare exceptions, as regularly denied. Hence in bringing this petition it is most earnestly urged that it may be considered as directed not in criticism of any course of reasoning followed by the Court, nor of any collateral matters previously considered, leading up to the Court's final decision, nor as attempting to revamp old arguments, but sim-

ply to call the Court's attention to certain rules of construction not heretofore brought to the Court's attention in this case, nor as far as your humble petitioner knows, in any previous case. It is not our desire nor intention to attempt to reargue the case, but to accept at the outset for the purpose of this motion:

(1) The conclusions of the Court that the Levison patent is not anticipated, but is a valid combination; and

(2) The conclusion of the Court that the appellant's carbon is in effect a "bound" carbon.

The point which we wish to present to your Honors pertains solely to the deduction as to *infringement* or *non-infringement* following the finding that the appellee's patent is valid, and that the appellant's carbon is a "bound" carbon, and is based on the rule of law laid down by the Supreme Court of the United States in *Westinghouse v. Boyden Power Brame Co.* 170 U. S. 537, 42 L. Ed. 1136, and other leading cases that:

"RESPONDENT'S DEVICE MAY BE LITERALLY WITHIN THE CLAIMS OF THE PATENT SUED ON, BUT IT DOES NOT NECESSARILY PROVE INFRINGEMENT."

It would seem that your Honors having decided that appellant's carbon was a "bound" carbon, felt necessarily obliged in view of the *validity* of the Levison patent and the *terms* of the Levison claims, to conclude that the appellant's device was an *infringement*.

It is on this one point alone that error is urged and it is urged not alone on behalf of appellant, but as a duty to this Court and to the public.

I.

ALTHOUGH APPELLANT'S DEVICE IS LITERALLY WITHIN THE TERMS OF THE LEVISON PATENT, THE COURT IS NOT NECESSARILY BOUND TO HOLD THERE IS INFRINGEMENT.

Elec. Signal Co. vs. Hall Signal Co., 114 U. S., 87; 29 L. Ed. 96;

Westinghouse vs. Boyden P. B. Co., 170 U. S. 537; 42 L. Ed. 1136;

Cushman Paper Box Co. vs. Goddard, 95 Fed. 664;

Goodyear Shoe Co. vs. Spalding, 101 Fed. 990;

Edison vs. American Mutoscope & Biograph Co., 151 Fed. 767;

Page Mach. Co. vs. Dow Co., 166 Fed. 473, 476 C. C. A.;

Herzog vs. N. Y. Tel. Co., 172 Fed. 425; Affirmed. 176 Fed. 349;

Columbia Motor Car Co. vs. Duerr Co., 184 Fed. 893; C. C. A. (Selden Automobile Patent).

Infringement is not made out merely by showing that the defendant's device comes within the terms of complainant's patent.

"Infringement should not be determined by a mere decision that the terms of a claim of a valid patent are applicable to the defendant's device. *Two things are not precisely similar because the same words are applicable to each.* The question of infringement involves considerations of practical utility and of substantial identity, and therefore must be quantitative as well as qualitative." (Goodyear Shoe Mach. Co. v. Spalding (C. C.) 101 Fed. 990). Edison v. American Mutoscope & Biograph Co., 151 F. 767, 773 (2nd Cir., 1907).

IF THE LEVISON PATENT IS NOT A PIONEER BUT REPRESENTS MERELY AN IMPROVEMENT ON THE PRIOR ART, THOUGH A MERITORIOUS ONE, THEN THE FACT THAT APPELLANT'S DEVICE IS LIKEWISE PATENTED BECOMES IMPORTANT IN VIEW OF THE CASES NOW REFERRED TO.

In Electric Signal Co. v. Hall Signal Co., 114 U. S. 87, 29 L. Ed. 96, the Supreme Court laid down the proposition that the defendant's device might be literally within the words of the claims of a patent and yet not infringe. In that case the patent sued on concerned a safety railway signal device in which the claims were for "positive and negative conductors," *shown as two wires stretched on poles extending along the railway track.* The defendants accomplished the same result by *grounding* one of the conductors, and although the Court held the patent valid and from the opinion it appears that the defendants were liter-

ally within the claims sued on, yet on the question of infringement the Court held for the defendants. In the course of the opinion the Court said:

“The object of the patent combination was the accomplishment of a particular result, that is, to work electric signals on what was known as the ‘block’ system, by means of circuits, operated by a single battery instead of many. But this result or idea is not monopolized by the patent. The thing patented is the particular means devised by the inventor by which that result is attained, *leaving it open to any other inventor to accomplish the same result by other means*. To constitute identity of invention, and therefore infringement, not only must the result attained be the ‘same,’ but in case the means used for its attainment is a combination of known elements, the elements combined in both cases must be the same, and combined in the same way, so that each element shall perform the same function, provided, however, that the differences alleged are not merely *colorable*, according to the rule forbidding the use of *known equivalents*.”

In view of the Patent Office having granted Kitchen a separate patent on his very *friction binding* means here involved, it cannot be said that the differences are merely “colorable.” Nor can it be said that the “friction binding” means of Kitchen was such a “known equivalent” as to make it a mere obvious substitute for the *stitching* of Levison.

In *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 42 L. Ed. 1136, the general proposition is laid down that:

“A respondent’s device may be literally within the claims of the patent sued on, but it does not necessarily prove infringement.”

In that case the Court said:

“But even if it be conceded that the Boyden device corresponds with the letter of the Westinghouse’s claims that does not settle conclusively the question of infringement. * * * *

“The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent. ‘An infringement’ says Mr. Justice Grier in *Burr v. Duryee*, 68 U. S., 1 Wall. 531, 572 (17: 650,658), ‘involves substantial identity whether that identity be described by the terms “same principle”’, same “modus operandi”’, or any other * * * The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the same effect is necessarily an equivalent for any other combination used for the same purpose. This is a flagrant abuse of the term “equivalent”’.

“We have no desire to qualify the repeated expression of this Court to the effect that where the invention is functional, and the defendant’s device differs from that of the patentee only in form, or in a rearrangement of the same elements of a combination, he would be adjudged an infringer, even if, in certain particulars, his device be an improvement upon that of the patentee. But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means, or the rule that the function of a machine cannot be patented is of no practical value. To say that the patentee of a pioneer invention for a new mechanism is entitled to every mechanical device which produces the same result is to hold, in other language, that he is entitled to patent his function. Mere variations of form may be disregarded, but the substance of the invention must be there. * * *

“That two machines produce the same effect will not justify the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other.”

In that case, famous as one of the leading cases in patent law, the defendant operated under a patent, just as the appellant here operates under a subsequent patent, and the Court found that while the patent there in suit was valid and the functions of the two devices practically the same, the means used in ac-

completing this function was so different that they were held not to be mechanical equivalents.

The very fact that *Kitchen* was granted a patent for his *specific binding means* is repugnant to the idea that his *frictional* binding means are the mechanical equivalent of the *stitching binding* of Levison. If so Kitchen could have had no patent. And if so again, Levison would include Doughty who precedes Levison; or the use of a *rubber band* to hold the Barlow carbon in Barlow.

The Court in the Westinghouse case further said:

“The claim in question is, to a certain extent, for a function, viz: the admission of air directly from the train pipe to the brake cylinder, and is only limited to such function when performed by the further traverse of the piston of the triple valve. This limitation, however, does not obviate the objection that *the means are not fully and specifically set forth for the performance of the function in question.* * * *

“The difficulty we have found with this claim is this: That, if it be interpreted simply as a claim for the function of admitting air to the brake cylinder directly from the train pipe, it is open to the objection, held in several cases to be fatal, that the mere function of a machine cannot be patented.”

But in that case the Court was able to hold the patent as being saved from the charge of invalidity by determining that the claim was limited to the *special means* shown and described in the patent for performing the function. The Court said:

“There are two other facts which have a strong bearing in the same connection, and preclude the idea that this can be interpreted as a claim for a function, without reading into it the particular device described in the specification.

“One of these is that the claim is for a triple-valve device, etc., for admitting air from the main air pipe to the brake cylinder, ‘*substantially as set forth.*’ *These words have been uniformly held by us to import into the claim the particulars of the specification,* or, as was said in *Seymour v. Osborne*, 78 U. S. 11 Wall. 516, 547 (20: 33, 40) ‘where the claim immediately follows the description of the invention it may be construed in connection with the explanations contained in the specifications, and where it contains words referring back to the specification it cannot properly be construed in any other way.’ In that case it was held that a claim which might otherwise be bad, as covering a function or result, when containing the words ‘substantially as described,’ should be construed in connection with the specification, and when so construed was held to be valid. To the same effect is *The Corn Planter Patent* (*Brown v. Guild*), 90 U. S., 23 Wall, 181, 218 (23: 161, 168).”

On the question of infringement the words of the Court in the *Westinghouse Case* are directly applicable:

“Under the very terms of the first and fourth claims of the *Westinghouse patent*, the infringing device must not only contain an auxiliary valve, or its mechanical equivalent, but it must contain the ele-

ments of the combination, 'substantially as set forth.' In other words, there must not only be an auxiliary valve, but substantially such a one as is described in the patent i. e. independent of the triple valve.

"Not only has the Boyden patent a poppet instead of a slide valve—a matter of minor importance—but it performs a somewhat different function. In the Westinghouse patent the valve is not in the line of travel between the auxiliary reservoir and the brake cylinder, and admits train pipe air only. In the Boyden patent, it is in the line of travel, both from the auxiliary reservoir and from the train pipe, and admits both currents of air to the brake cylinder. The by-passage, to which the auxiliary reservoir is merely an adit, is wholly wanting in the Boyden device, both currents of air uniting in chamber C and passing to the brake cylinder together, through the poppet valve." We see here that there were two air currents, but controlled in different ways; still both devices were literally readable on the claims sued on. Yet there was no infringement.

THE WORD "BOUND" AS USED IN THE CLAIMS OF LEVISON IS DISTINCTIVELY FUNCTIONAL; AND THE CO-RELATION, AND AT THE SAME TIME THE DISTINCTION BETWEEN THIS EXPRESSION OF "FUNCTION" AND THE IDEA OF "MEANS" FOR ACCOMPLISHING THIS FUNCTION MUST BE CLEARLY BORNE IN MIND, AS LIKEWISE MUST THE PHRASE "SUBSTANTIALLY AS DESCRIBED," WITH WHICH EACH OF THE LEVISON CLAIMS SUED ON CONCLUDES.

It is not trespassing on the time and patience of this Court to say that if this idea of *function* conveyed by the word “bound” should be considered to extend to cover *all* means for accomplishing the desired result that such a claim would necessarily be void as an attempt to patent a principle. If it includes all *binding* means it includes Doughty’s means and a *rubber band*.

In Cimiotti Unhairing Company v. American Fur Refining Co., 198 U. S. 399, 49 L. Ed. 1100; the Court held the patent valid because “Sutton has taken the step which marks the difference between a successfully operating machine and one which stops short of that point and that advance entitles him to the protection of a patent”; yet the Court further held that the defendant’s invention was not infringed, saying:

“And see Kokomo Fence Co. v. Kitselman, 189 U. S. 8, 47 L. Ed. 689, 23 Sup. Ct. Rep. 521, in which case it was held that where the patent does not embody a primary invention, but only an *improvement* on the prior art, and the *defendant’s machines can be differentiated*, the charge of infringement is not sustained.

“In the case under consideration the respondents have dispensed with the *fixed stretcher bar* and have adopted a *movable one*, operated by an entirely different mechanism, capable of *accomplishing a much larger amount of work within a given time*. In the Circuit Court of Appeals it was said to result in a double working capacity and product. It does not seem to us to be a mere transposition or substitution of parts; in the Sutton patent, the *Stretcher bar being*

stationary, there are several mechanisms used for operating the movable brushes and the clipping knives; a different mechanism is used for operating the different parts which are to be brought to the *fixed stretcher bar* in carrying out the operation intended. In the respondents' machine the same application of power *moves the stretcher bar* and, by the co-operation of the feeding apparatus as above outlined, feeds the machine by bringing the pelt forward, at the same time actuating the knives, in practically one operation. This seems to us to be a distinct mechanical departure, as well as an advance upon the Sutton machine, when considered in view of the results accomplished."

Note here: Levison used a carbon bound in by staples so that his carbon is *stationary*. Kitchen uses a carbon bound in by *friction* so that his carbon is *movable*; Kitchen can place his carbon *anywhere* in the book; when he has used a certain number of record leaves he can *change the position* of his carbon in the stubs; when his carbon shows signs of wear and begins to copy dimly, he can *renew* his carbon; if he wants to use his book as a loose leaf carbon book or leave some of the written-on sections of the leaves in the book and detach others, he can entirely *omit* his carbon. He binds his books up without carbons and keeps them in stock and inserts one or more carbons as desired. Levison must bind his carbon up with his book. In appellant's device Kitchen gets a bound carbon or a loose carbon book as required. As said in the Cimiotti case: "This seems to be a distinct mechanical *departure* as well as an *advance* upon the

Levison machine when considered in view of the *result* accomplished.”

II.

THE LEVISON PATENT IS IN NO SENSE A PIONEER AND ITS CLAIMS ARE TO BE NARROWLY CONSTRUED.

In applying the rule “that although the Levison claims are in fact broad enough to include appellant’s structure nevertheless there is no infringement,” it is of course necessary to determine from the record and your Honor’s opinion what degree of liberality of construction is accorded the Levison claims in suit.

The recent case of Autopiano Co. vs. Amphion Piano Player Co., 186 Fed. 159, 163 C. C. A., 2nd Cir., is directly in point:

“The question is whether this constituted a ‘pioneer invention.’ That phrase does not admit of exact definition, but perhaps as good as any is that of Mr. Justice Brown in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 561, 562, 18 Sup. Ct. 707, 718, 42 L. Ed. 1136, where he says that a pioneer patent must be one ‘covering a function never before performed, a wholly novel device, or one of such novelty and importance as to mark a distinct step in the progress of the art, as distinguished from a mere improvement or perfection of what had gone before.’

“In this case the function had been performed before. It was performed, though not automatically,

by Clarke in the patent which has been mentioned, and it was performed from the outset automatically, though imperfectly and inadequately, by the rollers of automatic musical instruments. * * *

“Nor is it true that O’Connor’s was a wholly novel device, which is the second suggestion of Mr. Justice Brown. Perhaps surface control was a new device at least when used to control lateral deviations, but edge control was not a new device to control such deviations, at least as shown in Cottrell. * * *

“Finally, not only was the device not wholly new, but it was not one of such novelty or importance as to mark a distinct step in the progress of the art as distinguished from a mere improvement or perfection of what had gone before, because the result was precisely an improvement or perfection upon the flange control, as I have said. * * * I do not mean to suggest that to combine together these elements was not a meritorious and excellent invention, for I think it was, nor that it did not require real inventive skill, and was not patentably novel. All that, however, does not make it a ‘pioneer,’ unless it takes its place at the head of the art in means or result, which this patent does not. In one sense, it is, of course, true that any invention must be a distinct step in the progress of the art, but the pioneer step must be in a new direction, not along the path already indicated by what has gone before.”

It seems unnecessary to more than state the rule governing the liberality of construction of pioneer and secondary patents. Judge Ross, of this Honor-

able Court in the case of *Cummings v. Baker*, 144 Fed. 395, says:

“It must be remembered that the patent sued on is in no sense a pioneer one, but a mere improvement on prior portable forges. In such cases the patentee is limited to the precise device, and combinations shown and claimed in his patent.”

Your Honors in *Hardison v. Brinkman*, 156 Fed. 962 where the defendant justified under subsequent patent stated: “The issuance of a patent to a respondent creates a *prima facie* presumption of the patentable difference from the invention of the patent sued on.”

It is not now contended that a subsequent patent is in every case a defense, because such is not the general rule; but it is *evidence*, as your Honors above stated, of a “patentable difference,” and therefore of a *substantial difference*, and not a mere colorable one from the patented invention, but sufficient under certain circumstances to relieve a respondent of the charge of infringement.

Furthermore *infringement* is never *presumed*; and in case of any *doubt* the finding must be against the complainant.

As said by the Supreme Court in *Burr v. Duryea*, 1 Wall. 574:

“Every man has a right to make an improvement in a machine, or evade a previous patent, provided he does not invade the rights of the patentee.”

In determining invention in Levison your Honors find that the Barlow patent “anticipates the appellee’s patent in every feature except one. Instead of having their carbon sheet bound in the book as in the appellee’s patent, it was loose. * * * Eight (18?) years after the issuance of the Barlow patent the appellee conceived the idea of binding carbon sheets with the stubs of the record sheets of the book, so that the carbon sheets would always be in their place.”

(Permit us to call the Court’s attention that with respect to the claims sued on, appellee conceived the idea of binding *a single carbon sheet* (not *sheets*) with the stubs of the record sheets, because these claims are not for the *built-up* sections).

Continuing, your Honors says:

“The patent to James Bengough of January 28, 1896 shows a bound, manifold salesbook” using two bound carbons; and that “the patent to G. E. Doughty of October 11, 1898 is similar to the Bengough device excepting that the carbon sheet instead of being *bound by stitching* in the book, is held therein by a clamp.” (We may again be pardoned for calling attention to the Honorable Court’s error as to the facts of *similarity* between Bengough and Doughty, because the two books are absolutely dissimilar as pointed out at the argument and in appellant’s brief, and as shown by the cuts in appellant’s brief; Doughty having leaves with three separable sections of equal size, similar to Barlow and Levison, only the end sections are turned over to shorten the length of the book, and the two-piece carbon which is the length

of two of the sections, and is held or bound as Levison said, in the book. It was pointed out in the argument how the appellee had introduced a “bogus” copy of Doughty bound in the middle and had apparently succeeded in misleading Judge Van Fleet).

Your Honors further say:

“In addition to the presumption which arises from the issuance of the patent to the appellee, there are to be taken into consideration as sustaining his patent, the further facts that when his invention was made, there was a want in the art for such a device, that in the prior art there were well recognized and admitted defects, and that the appellee’s device eliminated those defects and went into general and successful use. In view of all these considerations, we find the evidence insufficient to overturn the finding of the Court below that the appellee did exercise inventive faculty in devising the book for which he obtained his patent.”

A careful reading of the Opinion shows that your Honors do not invest the Levison patent with the attributes of a pioneer, but as being simply an “improvement” on what had gone before.

McCormick vs. Talcott, 20 How. 402.

Of course it is elementary that “extent of use” or “general or successful use” (to use the words of your Honors) of a patented article is no measure of the *quantum* of invention, and evidence to that effect is receivable only where the question of novelty is in

grave doubt. As said by the Supreme Court in *McLain v. Ortmeier*, 141 U. S. 420, 35 L. Ed. 800, it was held that while “in a *doubtful case* the fact that the patented article had gone into general use is evidence of its *utility* it is not conclusive even of that, much less of its patentable novelty.”

There are scores of cases which go to show that “popularity,” “large sales,” “extent of use,” are evidence *only in very doubtful cases*.

Voightmann vs. Weis, 148 Fed. 848;

Adams vs. Ballaire, 141 U. S. 529; 35 L. Ed. 849;

Grant vs. Walter, 148 U. S. 547; 37 L. Ed. 552;

Duer vs. Corbin, 149 U. S. 216;

Union vs. Peters, 125 Fed. 601;

Mast vs. Stover, 177 U. S., 493;

Rose vs. Dowden, 157 Fed. 681;

Lehigh vs. Kearney, 158 U. S. 461; 39 L. Ed. 1055;

Olin vs. Timken, 155 U. S. 141; 39 L. Ed. 100;

Hotel Security Checking Co. vs. Lorraine Co., 155 Fed. 298;

Tubelt Co. vs. Friedman, 158 F. R. 430, 439;

Richards vs. Elevator, 159 U. S. 477, 40 L. Ed. 225;

American vs. Bullivant, 117 Fed. 225; 54 C. C. A. 287;

McClain vs. Ortmeyer, 141 U. S. 419, 35 L. Ed. 800;

Falk vs. Missouri, 103 Fed. 295; 43 C. C. A. 240;

New vs. Bevin, 73 Fed. 469; 19 C. C. A. 534;

Dodge vs. N. Y., 150 Fed. 738; 80 C. C. A. 404.

These cases might be multiplied indefinitely.

Again your Honors state "the presumption which arises from the issuance of the patent"? but that is measure of the *quantum* of invention: in fact the value of such a presumption is growing less each year with the vast increase in the number of patents and the inadequate facilities of the Patent Office for handling and properly examining all the applications that come before the Examiners. Thus to illustrate: the Commissioner of Patents himself conceded, before the Committee on Patents of the House of Representatives in the hearings given to House Bills 12,368, 18,884 and 18,885, to revise and amend the statutes relating to patents, on the 23rd and 24th days of February, 1910, that a majority of the patents issued were not worth the paper on which they were written. The statement of the Commissioner will be found at

pages 44 and 45 of the Official publication. On page 44, the Honorable Commissioner said: "I have said time and time again that these patents issued—the majority of them, I mean—by the United States Government are not worth the paper they are written on, and the inventors are driven into all sorts of litigation." Again, on page 45, in speaking of the conditions that now exist in the Patent Office, the Honorable Commissioner said: "We are handing out to-day 60 per cent, of the cases, patents that are almost worthless, in whole or in part."

To show that this complaint is not of recent date, is seen by reference to the Opinion of Judge Butler in *Haughey v. Lee*, 48 Fed. 384, (when all patents went on appeal direct to the Supreme Court); Judge Butler pointing out that Vol. 132 of the United States Supreme Court Reports contained no less than *eight* cases of patents overturned for want of invention. An examination of the Federal Reporters will prove equally instructive as to this matter. Counsel for appellant knows from his personal experience as a Patent Solicitor, and in his experience in prosecuting thousands of applications before the Patent Office, that the methods in the Patent Office were extremely lax at the time Levsion's application for patent was pending.

As to the degree of liberality to be accorded Levison's claims you are to take into account the *claim of the Barlow patent*, and apply the same rule which you applied in the case of *Best v. Holt Mfg. Co.*, 172 Fed. 409, in construing the Best patent there sued on

in the light of the *claim of the prior Berry patent*. In that case Best infringed claim 11 of Berry, and your Honors held that the Best patent, although for a very meritorious invention and one which had gone into successful and extensive use, was nevertheless only an *improvement* patent. So here *Levison infringes the Barlow claims* and why should not the same rule apply.

From a careful perusal of your Honor's opinion in the case at bar there seems to be nothing to indicate that Levison is held to be a *pioneer*, or that he made anything more than a step forward in the art. In fact appellee has never claimed more for the patent than that; but has relied to sustain infringement, upon the *literal* application of the word "bound," as found in Levison's claims to the appellant's device.

LEVISON'S INTENTION AS SHOWN BY HIS TESTIMONY AND HIS PATENT.

The *drawings* of the Levison patent show the carbon bound permanently into a stub by wire stitching or staples.

LEVISON THE PATENTEE TESTIFIES, REC. 49 THAT HE HAS NEVER BOUND HIS CARBON INTO HIS BOOK IN ANY OTHER WAY THAN BY STITCHING "AS DESCRIBED IN THE CLAIM IN HIS PATENT"!

Thus he says:

“X. Q. 20. That plurality of sections is what you are using, and you are *stitching* your carbons into books of that sort, and always have?

“A. I am *stitching* my carbons into books *as described in this claim in this patent.*”

“X. Q. 24. You do that when you make up your book?

“MR. WHITE: We object to that as immaterial.

“A. Yes, we bind it into the stub when we made up the book.

“X. Q. 25. (By MR. TOWNSEND): Your carbon cannot be removed without tearing it out, either can it?

“MR. WHITE: We object to that as immaterial.

“A. In the particular book that we are manufacturing, extensively, they cannot be taken out, and *that is the selling of it. That is the reason that they sell, because the carbons cannot be taken out.*”

Thus, we see the full meaning of the words, “substantially as described” as used in Levison’s patent.

We may be pardoned for referring to the significant inquiry of his Honor, Judge Wolverton, (or possibly it was Judge Morrow), at the hearing and addressed to Mr. White, Counsel for appellee, if he, Mr. White, contended that the term “bound” in the Levison claims covered the use of a *rubber band* around the Barlow book to hold the loose Barlow carbon in place; and Mr. White stated that the claims were broad enough to include such binding means.

Your Honors may take judicial notice of the effect of a “rubber band” so applied in determining the present question which is as follows: The *quantum* of invention in Levison for the purpose of determining infringement.

As a “rubber band” would only hold the carbon in place by *friction* surely your Honors will not say that Kitchen’s *patented* removable *frictionally*-held carbon although a “bound” carbon, is bound in the sense as to make appellant an infringer?

In *Eames v. Godfrey*, 1 Wall. 78-79, 17 L. Ed. 547, the Supreme Court said in speaking of a combination patent:

“The end in view is proposed to be accomplished by the union of all, arranged and combined together in the manner described. The use of any two of these parts only, or of two combined with a third, which is substantially different in form or in the manner of its arrangement and connection with the others, is therefore not the thing patented. *It is not the same combination if it substantially differs from it in any of its parts.*”

Consequently the term “bound” in the Levison claims must of very necessity be read “substantially as described” in the Levison specifications or *shown in his drawings*, since drawings and specifications are to be read each by the other.

“When the nature of the case admits of drawings, the applicant shall furnish one copy, signed by the inventor or his attorney in fact, and attested by two

witnesses, which shall be filed in the Patent Office, and a *copy of the drawing*, to be furnished by the Patent Office, *shall be attached to the patent as a part of the specification.*” Sec. 4889 U. S. Revised Statutes.

“While the invention of a patent must be measured by the claims, yet they cannot be considered to the exclusion of the specifications, but *claims, specifications, and drawings showing the particular apparatus must be considered together*, and must point out the principle by which the invention is practically operated, and, to make out a case of infringement, the apparatus of the defendant must embody such principle of operation.”

Herzog vs. N. Y. Tel. Co., 172 Fed. 425, (1st syllabus) ; affirmed 176 Fed. 349.

The true rule is laid down in *Amer. Bank Protection Co. vs. City Nat. Bank*, 181 Fed. 373, 378:

“It is furthermore settled that a patent is to be liberally construed, so far as is consistent with the language used, so as to sustain the just claims of the inventors (*Rubber Co. v. Goodyear Co.*, 9 Wall. 788, 19 L. Ed. 566; *Klein v. Russell*, 19 Wall. 433, 22 L. Ed. 116), and that for such purpose each claim of the patent is not to be construed as though it was complete in itself, separate and apart from the specifications, but that the claims of the patent are to be read in the light of the specifications *and drawings* which accompany them, for the purpose of arriving at their just construction, although not to vary or change them, *especially where the claims themselves contain the*

words, ‘*substantially as described,*’ or ‘*substantially as set forth,*’ or equivalent phrases, which import into the claims the particulars of the specifications and carry into the claims the description of the specifications. Seymour v. Osborne, 11 Wall, 516, 20 L. Ed. 33; Corn Planter Patent, 23 Wall. 181, 218, 23 L. Ed. 161; Westinghouse v. Brake Co., 170 U. S. 537, 558, 18 Sup. Ct. 707, 42 L. Ed. 1136; Stilwell-Bierce Co. v. Cotton Oil Co., 117 Fed. 410, 54 C. C. A. 584 (C. C. A., Sixth Circuit); Sanders v. Hancock, 128 Fed. 424, 63 C. C. A. 166 (C. C. A., Sixth Circuit); Maunula v. Sunell (C. C.) 155 Fed. 535, 542; Anderson v. Collins, 122 Fed. 451, 458, 58 C. C. A. 669 (C. C. A., Eighth Circuit); Mossberg v. Nutter, 135 Fed. 95, 99, 68 C. C. A. 257.”

Of course it is not maintained that the words “substantially as described” as used in a claim will always limit a patentee; due regard being given to the place of the patent in the art, whether it is the first or last, or intermediate of a large line of endeavors in the same field.

But here we have an express statement of intention of the patentee himself on the witness stand; we have the holding of the Court in the Westinghouse case; and we have the state of the art as applied to Levison.

As was said in Autopiano Co. vs. Piano Player Co., 186 Fed. 159, 165 C. C. A., 2nd Circuit, where, just as here the appellant justified under a subsequent patent: (and the *Levison patent was cited* against the Kitchen patent as a reference while Kitchen’s was

pending in the Patent Office ; although this latter does not appear in the Record, yet it is the fact) :

“Moreover, there is a strong presumption that there is patentable novelty between the two, one not being an improvement upon the other (Kokomo Co. v. Kitselman, 189 U. S. 8, 23, 23 Sup. Ct. 521, 47 L. Ed. 689), *and this is especially the case when the earlier patent is repeatedly cited against the subsequent patent*, as was the case (New Jersey Wire Co. v. Buffalo Metal Co., 135 Fed. 1021, 68 C. C. A. 672, and (C. C.) 131 Fed. 265, 268).”

As was also said in the same case :

“No fair intendment of any of the claims in question can be held to include Exhibit 4, unless I should treat them like the ‘nose of wax, which may be turned and twisted in any direction,’ and into which Mr. Justice Bradley says that courts must not permit claims to be transfigured. *White v. Dunbar*, 119 U. S. 47, 51, 7 Sup. Ct. 72, 30 L. Ed. 303. *It is no hardship to O’Connor to be limited to the invention which he so specifically defined and which he obviously alone intended.*”

So here unless your Honors expand the “binding” means of Levison so broad as to “cover all binding means” as you state in your opinion and so include *Doughty* (and please note *Doughty* has precisely the same *three-equal-division* sheet arrangement as Levison and Barlow and *double-face bound* carbon two-thirds the length of the sheet)—the *patented friction binding means of Kitchen* cannot under the law as

above pointed out be an infringement. Neither, in your Honors sustaining the Levison patent, is it any hardship on Levison "to be limited to the invention which he so specifically defines and which he obviously alone intended."

As pointed out to your Honors who heard the argument, the loose *leaf carbon of Barlow* can easily be slipped into the stub and will be held tight enough by friction so that it will not fall out. Your Honors are invited to try the experiment with the Barlow book, Complainant's Exhibits 9 and 13. In fact it would be most extraordinary if hundreds of users of Barlow books long before Levison's advent into the field had not done that very thing of sticking the end of the carbon into the stub to hold it, when they found the carbon had a tendency to blow away. Consequently it seems absolutely essential both from the point of view of the facts and the law and the justice of the matter to say that Levison is limited to his precise binding means "show and described," and that they do not cover *friction* binding as practised and *patented* by appellant.

THE SELDEN AUTOMOBILE CASE AND ITS APPLICATION TO THE QUESTION OF CONSTRUCTION.

One of the most recent and remarkable examples of strict construction of patent claims, even in a *pioneer patent*, by a Court noted for its liberality in upholding and in construing patents, is seen in the Opinion of the Circuit Court of Appeals for the Second

Circuit in Columbia Motor Car Co. vs. Duerr Co., 184 Fed. 893; the suit being on the Selden automobile patent, which was applied for in 1879 and issued in 1895.

We trust that a somewhat extended reference to this case may not be considered out of place, nor trespassing upon your Honors' patience and time, because it bears directly on the point in issue and is the mature and well considered opinion of a Court of co-ordinate jurisdiction.

The Court in referring to the importance of the Selden invention said:

“This patent, even if it be useful only for tribute, must be viewed without prejudice and with absolute judicial impartiality.

“But, while we should be careful to avoid viewing the patent with disfavor, we should be equally careful to avoid considering it with too much favor on account of its subject-matter. Fifteen years ago hardly any one had seen an automobile. Ten years ago they were rare. Today they are in use by tens of thousands, and tens of millions of dollars are invested in them and in their manufacture. The development of the automobile has been nothing short of phenomenal, and every one is inevitably impressed with its importance. *Consequently, when we see that 30 years ago an application for a patent was filed which even pointed the way to the modern automobile, we can hardly fail to receive the impression that an idea of great importance must have been embodied in it.*”

The broad claim of the Selden patent included as an element, “a liquid hydro-carbon gas engine of the *compression* type”; but despite the novelty of the idea of the combination, and the broad language used both in the Selden claim and in the Selden specifications, the Court proceeded to limit the claim to *one of two* “liquid hydrocarbon gas engines of the *compression* type” *known at the time of Selden’s application*.

The Court said (page 898) :

“Liquid hydro-carbon engines were in use, both of the compression and non-compression types. The phrase in the claim, ‘a liquid hydro-carbon engine of the compression type,’ *is descriptive of the Brayton engine, which came into use about 1873, and of the Otto compression engine, which came into use a little later but still was in the antecedent art.* The Brayton was undoubtedly the leading compression engine at the time of this application, but it was later superseded by the Otto.

“These two engines—the Brayton and the Otto—play important parts in this case. We shall later have occasion to examine them at length and to compare them as belonging to two well-defined types of *compression gas engines*—the ‘constant pressure’ type and the ‘constant volume’ type. But it is unnecessary to describe them at this time nor to define the terms which we have just employed. It is sufficient now to state the fact that the engine element of the claim—considered as an engine and not neces-

sarily as a part of a combination—was in existence at the date of the alleged invention.”

(The foregoing is apt with respect to Levison where your Honors have found that there are *two kinds* of “binding” means; the “permanent” or non-removable binding means and the “temporary” or *removable* binding means. Both these binding means were in the “antecedent art.”)

The Court found that Selden had reorganized the “Brayton” engine and at page 908 said:

“We have nearly broken established rules by looking at the drawings by themselves to ascertain the changes made in that engine. There is little enough to be found about the improvements to it and nothing at all about the alterations of other engines. The patent does not pretend or attempt to lay down any rule for reorganizing compression engines to fit them for vehicular purposes.”

(Levison shows in his *drawings* the “permanent” binding means and his testimony quoted above, expressly states that that is of the essence of his invention.)

In determining the breadth of construction to be accorded the Selden patent, the Court said at page 901-902:

“Taking the patent according to its terms, the case apparently presented is the ordinary one in which a patentee claims a broad invention and describes what he considers to be the best mode of applying it, but is

not confined to that method. And if the prior art permitted such a patent in this case it might well be that it would be valid. But the prior art did not permit such a patent. Every element in the claim was old, and the combination itself was not new. Combinations of non-compression gas engines with the other elements had been in use, and Brayton had employed a 'liquid hydro-carbon engine of the compression type' in a vehicle.

“Even if the Brayton uses were not precisely anticipatory, we can reach no other conclusion than that with them in the prior art the claim in question must be held invalid for want of invention if it be given the broad construction the language apparently calls for. Moreover, if we give it a slightly narrower construction and treat it as covering the selection of the Brayton type of compression engine, the same conclusion must be reached. Invention would not be involved in the mere choice of that type of engine, for Brayton had previously made the same selection for his street car and boats. And, even if the Brayton engine had been used only for stationary purposes, it is by no means certain that its mere selection for incorporation in a motor vehicle without adaptation would have involved invention.

“In *re Faure's Appeal*, 52 Off. Gaz. 754 (Supreme Court, District of Columbia), is in point. In that case Faure claimed a patent for the combination of an electric motor with a vehicle. It appeared in that case, as in this, that boats had been propelled by the same kind of motor. The Court said (page 756):

“ ‘It is made evident that the mechanical arrangements for applying the power are not new, being familiar to all experts; and that the result is not new, viz., the movement of vehicles by electrical storage batteries. It is admitted that Trouve had propelled boats in this way. The contention that such a use did not anticipate this application because that experiment was on water and this invention is designed for use on land seems untenable. The propulsion of vessels through water by such batteries is within the same principle as locomotion on land.’

“ ‘In *Shaw Electric Co. v. Worthington* (C. C.) 77 Fed. 992, 993, the patent was for an improvement in traveling cranes through the substitution of independent electric motors for the power previously furnished by steam power. Judge Acheson said:

“ ‘The facts, then, being as above stated, what element of invention is to be found in the patent here in suit? In view of the previous employment of electric motors in propelling street cars, driving machinery in mills, working elevators, etc., the mere application of electric motors to traveling cranes certainly did not involve invention, even had Shaw been the first to operate cranes electrically. The inventive faculty was no more exercised here than in a multitude of other instances in every branch of industry where the electric motor has been substituted for the steam engine or other source of power.’

“ ‘But we are reluctant to so construe the claim that it must be held invalid for want of invention. *We*

are of the opinion that the patentee had ideas ahead of the times and appreciated many aspects of the problem to be solved in creating a practical motor vehicle. Reading his statement of the difficulties encountered, his manner of meeting them, and the advantages of his discovery, we think it evident that he understood that an engine suitable for a light vehicle could not be taken bodily from the prior art and used without change, but that modification and adaptation were required. In our opinion *the statement in the patent that any form of compression engine may be employed is inconsistent with the intention disclosed by the patentee in the patent as a whole* and should not have too much stress laid upon it. We also think that we should examine the specification, including the *drawings and the model*, to determine whether the patentee in addition to expressing the need of adapting an engine to the purposes of a motor vehicle shows that he actually adapted one. It may well be that the claim is limited by the specification should be held to be valid.”

(This is applicable to the question of *construction* of the three Levison claims sued on in view of the prior art.)

Coming to the conclusion of infringement and construction the Court said in the Selden case:

“We thus find that the defendants use an improved Otto engine which retains the principle of that type and is, in its essentials, a four-cycle constant volume (or explosion) *compression* gas engine. Obviously it is not *identical* with Selden’s improved

Brayton engine, which is a two-cycle constant pressure, or slow combustion) *compressed* gas engine; and so the final question is whether they are, under the patent, equivalents.”

In the conclusion the Court said in finding for the defendants:

“The Brayton engine was the leading engine at the time, and his attention was naturally drawn to its supposed advantages. He chose that type. In the light of events we can see that had he appreciated the superiority of the Otto engine and adapted that type for his combination his patent would cover the modern automobile. He did not do so. He made the wrong choice, and we cannot, by placing any forced construction upon the patent or by straining the doctrine of equivalents, make another choice for him at the expense of these defendants who neither legally nor morally owe him anything.”

It is the earnest contention of your petitioner that the Levison claims sued on should be construed to cover the particular binding means elected by him, and not the particular *patented friction binding means* of the appellant; because to do otherwise is to “make another choice” for Levison “at the expense of this defendant who neither legally nor morally owes him anything.”

In *Cushman Paper Box Co. v. Goddard*, 95 Fed. 644, 669, C. C. A., Judge Putnam said in holding the patent valid, but not infringed and where the facts were not dissimilar to those in the present case:

“It is apparent from the proofs that *the respondents honestly regarded their method of construction in these particulars as preferable to that of the complainant*. Whether or not they were correct in this, it would seem, to use the language of the opinion in *Westinghouse v. Brake Co.*, 170 U. S. 537, 573, 18 Sup. Ct. 707, that *the complainant’s method* for overcoming the difficulties in delivering the box-ends to the box-body after they are in position one over the other *would not naturally have suggested the device adopted by the respondents*. We conclude that, on the proofs in this record, we cannot find that the respondents have infringed.”

Under the above doctrine, and of *Electric Signal Case* and others, is not the question of equivalency in this case dependent on whether the means used by the respondent for “binding” his carbon in the book would “naturally have suggested itself” to any skilled mechanic in lieu of the staple or stitched binding of *Levison*? The answer must be in the affirmative in order to hold appellant an infringer; and that it cannot be answered in the affirmative is conclusively shown by the fact that the special *friction binding means* of the appellant has been held to be patentable to Mr. Kitchen, by the same tribunal that granted *Levison* a patent, and long subsequent to *Levison*; and being *patentable* it *per se* is not a mechanical equivalent of *stitching* or “permanent” binding.

SUMMARY.

Applying the principles of the foregoing cases to the question of infringement in the case at bar, we have:

First;—That although the Kitchen device corresponds with the letter of the Levison claims that does not settle conclusively the question of infringement. (Westinghouse Case). In determining this question it is proper to consider: first, the patentable distinction between the two; and second, the different modes of operation; three, the practical advantages of one over the other. The Kitchen device responds to all these tests as disproving infringement in view of the limited scope of the Levison patent *with respect to the particular claims sued on*.

Second;—The word “bound” in the claims is functional. Being functional the “binding means” of the patent must be “substantially as shown and described” in the patent. The only thing “shown and described” in Levison are *wire staples* passing through the stubs and leaves of carbons; otherwise, the patent is void. (Westinghouse v. Boyden.)

Third;—The *frictional* binding means of appellant is, by the authority of the Patent Office in granting the Kitchen patent over both the Barlow patent and the Levison patent, not included among the “known” equivalents of Levison’s binding means; Electric Signal Co. vs. Hall Signal Co., 114 U. S. 87, 96; and the fact that this *frictional* binding means of appellant has been held patentable over the binding means of

Levison, *differentiates* the appellant's device from that of the appellee, so that the charge of infringement is not sustained. *Cimiotti Unhairing Co. v. American Fur Refining Co.*, 198 U. S. 399; *Kokomo Fence Co. v. Kitselman*, 189 U. S. 8, 47, L. Ed. 689. Such differences could not be *patentable* if they were merely "colorable."

Fourth;—For inasmuch as we understand your Honors to hold the Levison patent "lies in a narrow compass," (as indeed it must in view of the prior art), then it is most respectfully submitted that defendant's *patented frictional* binding means cannot be held to be the equivalent of the binding means "substantially as described" in Levison.

Fifth;—This Court is as much bound to protect the appellant from the charge of infringement and to allow the public to profit by his competition if the law does not make him an infringer, though his patented device be literally within the terms of Levison's claim, as it is bound on the other hand, to see that Levison's patent is entitled to be *liberally* construed. Any doubt on the question of *infringement* must be determined in favor of the defendant-appellant just as any doubt affecting the *validity* of the patent sued on must be decided in favor of the complainant appellee.

Sixth;—The claims do not of themselves, nor does the patent, indicate that the patentee intended to embody within his invention any such ingenious *friction* binding means as employed by appellant. Levison too, distinctly testified he *intended* the stitching bind-

ing shown in his drawings. Rec. 49-50 quoted supra. For the Court to expand appellee's claim is not only in contravention of the doctrine laid down in numerous cases, but it operates to work an unnecessary hardship on appellant and on the public; it being shown that the City and County of San Francisco if forced to buy the Levison book must pay from 50% to 60% more than ordinary customers pay Levison for the same book. (Rec. 156-7). The equities are strongly with the appellant and the public.

CONCLUSION.

The question presented by this petition was not treated or raised in any way before the lower Court, nor in the brief of appellant nor on the argument; the point naturally not being raised by the complainant and the respondent having been of the opinion that the Kitchen device was *not* within the claims sued on.

There are no large interests here at stake; the defendant has ceased all infringement pending the outcome of this litigation; yet these facts do not militate against the importance of the principle involved. The reason for praying the granting of this motion lies more in the fact of the importance of this Honorable Court's decisions in patent matters especially, as determining the law of patents for this Circuit; and the further fact that those of us who are engaged almost exclusively in patent practise, are particularly desirous that this Court may not be committed to any

erroneous or incomplete view as to the established law governing the construction of patents.

It is the desire of all inventors and all honest business enterprises to see patents liberally and fairly construed; and this Court's favorable attitude towards patents, as evidenced in various instances in sustaining patents of great practical value, is and should be a matter of profound satisfaction both to patent attorneys and the commercial world.

Counsel knows of no case in which your Honors have ever passed upon the question herein presented, and therefore it is most earnestly urged that the conclusion reached as to infringement may be reconsidered. A decree of non-infringement would in no way operate as a reversal or modification of this Court's attitude as to liberality of construction, because after all each patent case must be decided on the particularly circumstances surrounding it; and the circumstances and the law in our humble opinion justify if not demand that the appellant's device be considered *outside* the *spirit* of the claims sued on, even though it is within their *letter*.

It is therefore respectfully asked that the decree may be modified to the extent of holding non-infringement by appellant.

Respectfully submitted,

CHAS. E. TOWNSEND,

Counsel for Petitioner.

CERTIFICATE OF COUNSEL.

I, the undersigned, Counsel for Petitioner, hereby certify that the foregoing petition is not interposed for delay and in my judgment is well founded.

CHAS. E. TOWNSEND,

Counsel for Petitioner.

